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TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1893.

No. ~~1184~~. 687

THE BATE REFRIGERATING COMPANY, APPELLANT,

vs.

FERDINAND SULZBERGER, SAMUEL WEIL, AND FREDERICK JOSEPH, DOING BUSINESS UNDER THE FIRM NAME OF SCHWARZCHILD & SULZBERGER.

ON A CERTIFICATE FROM THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT.

FILED APRIL 6, 1894.

(15,568.)

LAW ASSOCIATION
OF
PHILADELPHIA

(15,568.)

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1893.

No. 1184.

THE BATE REFRIGERATING COMPANY, APPELLANT,

vs.

FERDINAND SULZBERGER, SAMUEL WEIL, AND FREDERICK JOSEPH, DOING BUSINESS UNDER THE FIRM NAME OF SCHWARZCHILD & SULZBERGER.

ON A CERTIFICATE FROM THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT.

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JUDD & DETWEILER, PRINTERS, WASHINGTON, D. C., APRIL 16, 1894.

1 United States Circuit Court of Appeals for the Second Circuit.

MONDAY, *March 26th*, 1894.

Present: Hon. William J. Wallace, Hon. E. Henry Lacombe, and Hon. Nathaniel Shipman, circuit judges, holding said court.

THE BATE REFRIGERATING COMPANY, Complainant and Appellant, *vs.* FERDINAND SULZBERGER, SAMUEL WEIL, and Frederick Joseph, Doing Business under the Firm Name of Schwarzchild & Sulzberger, Defendants and Appellees.	No. 82. Equity. Appeal from the Circuit Court of the United States for the Southern District of New York.

A decree dismissing the bill in this cause after a hearing upon the setting down of pleas thereto having been made in the circuit court for the southern district of New York, and an appeal having been taken therefrom to this court, and the cause having come on for final hearing, certain questions of law arose concerning which this court desires the instruction of the Supreme Court of the United States for its proper decision. The facts out of which the questions arose appear from the bill and pleas thereto on file in the cause and are as follows:

2 On the first day of December, 1876, John J. Bate applied for letters patent for an improvement in processes for preserving meats, etc., and after sundry proceedings in the United States Patent Office, including an appeal to the examiners-in-chief, as well as a subsequent contested interference with a patent to one Ezekial S. Halsted, a patent was issued to said Bate on the 20th day of November, A. D. 1877, the grant being in terms for seventeen years. Afterwards, on the 22nd day of November, 1877, said John J. Bate assigned said patent to the Bate Refrigerating Company, the assignment being duly recorded on the 23rd day of November, 1877.

After the application had been filed in the United States Patent Office and before the patent was issued two foreign patents were granted for the same invention, to wit, one patent granted by the British government to William Robert Lake on a communication from said Bate dated January 29th, 1877, for the term of fourteen years from said date, said patent being sealed July 13th, 1877, and the complete specification being filed July 26th, 1877, and the said invention was patented or caused to be patented by the said Bate; the other of said patents granted by the government of the Dominion of Canada to the same John J. Bate under date of January 9th, 1877, for five years. Both foreign patents expired before the expiration of the seventeen years specified in the grant of the United States patent to Bate. The bill was filed July 25th, 1892, and prayed for an injunction against infringement and for an account.

3 Upon these facts this court desires instruction upon questions of law for the proper decision of said cause, namely, whether the invention for which the United States patent aforesaid was issued to said John J. Bate had been "previously patented in a foreign country" within the meaning of those words in section 4887 of the Revised Statutes, and whether the said patent expired under the terms of said section before the expiration of the term of seventeen years from its date, and to that end hereby certifies said questions to the Supreme Court.

WM. J. WALLACE,
E. HENRY LACOMBE,
N. SHIPMAN,
Judges of U. S. Circuit Court of Appeals, Second Circuit.

[Endorsed:] United States circuit court of appeals, second circuit. Filed Mar. 28, 1894. John A. Shields, clerk.

4 UNITED STATES OF AMERICA, } ss:
Second Circuit, }

I, John A. Shields, clerk of the United States circuit court of appeals for the second circuit, do hereby certify that the foregoing certificate in the cause entitled The Bate Refrigerating Company, complainant and appellant, *vs.* Ferdinand Sulzberger, Samuel Weil, and Frederick Josèph, doing business under the firm name of Schwarzchild & Sulzberger, defendants and appellees, was duly filed and entered of record in my office by order of said court on the twenty-eighth day of March, 1894, and, as directed by said court, the said certificate is by me forwarded to the Supreme Court of the United States for its action thereon.

In testimony whereof I have hereunto subscribed my name and affixed the seal of the said United States circuit court of appeals for the second circuit, at the city of New York, in the southern district of the State of New York, this third day of April, in the year of our Lord one thousand eight hundred and ninety-four, and of the Independence of the United States the one hundred and eighteenth.

Seal United States Circuit Court of Appeals, Second Circuit.

JOHN A. SHIELDS,
Clerk United States Circuit Court of Appeals for the Second Circuit.

Endorsed on cover: Case No. 15,568. U. S. circuit court of appeals, second circuit. Term No., 1184. The Bate Refrigerating Company, appellant, *vs.* Ferdinand Sulzberger, Samuel Weil, & Frederick Joseph, doing business under the firm name of Schwarzchild & Sulzberger. Filed April 6th, 1894. (Certificate.)

EXTRACTS FROM THE PATENT STATUTES.

Law of 1836.

SEC. 6. "That any person or persons having discovered or invented any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement on any art, machine, manufacture, or composition of matter, not known or used by others before his or their discovery or invention thereof, and not, at the time of his application for a patent, in public use or on sale, with his consent or allowance, as the inventor or discoverer; and shall desire to obtain an exclusive property therein, may make application in writing to the Commissioner of Patents, expressing such desire, and the Commissioner, on due proceedings had, may grant a patent therefor. But before any inventor shall receive a patent for any such new invention or discovery, he shall deliver a written description of his invention or discovery, and of the manner and process of making, constructing, using, and compounding the same * * * He shall, furthermore, accompany the whole with a drawing, or drawings. * * * "

SEC. 7. "That, on the filing of any such application, description, and specification, and the payment of the duty hereinafter provided, the Commissioner shall make or cause to be made, an examination of the alleged new invention or discovery; and if, on any such examination, it shall not appear to the Commissioner that the same had been invented or discovered

by any other person in this country prior to the alleged invention or discovery thereof by the applicant, or that it had been patented or described in any printed publication in this or any foreign country, or had been in public use or on sale with the applicant's consent or allowance prior to the application, if the Commissioner shall deem it to be sufficiently useful and important, it shall be his duty to issue a patent therefor. But whenever, on such examination, it shall appear to the Commissioner that the applicant was not the original and first inventor or discoverer thereof, or that any part of that which is claimed as new had before been invented or discovered, or patented, or described in any printed publication in this or any foreign country, as aforesaid, or that the description is defective and insufficient, he shall notify the applicant thereof, giving him, briefly, such information and references as may be useful in judging of the propriety of renewing his application, or of altering his specification to embrace only that part of the invention or discovery which is new. * * * "

Law of 1836, Sec. 8.

After providing for interfering applications and appeal from the decision thereof, the section further provided as follows:

"But nothing in this act contained shall be construed to deprive an original and true inventor of the right to a patent for his invention, by reason of his having previously taken out letters patent therefor in a foreign country, and the same having been published, at any time within six months next preceding the filing of his specification and drawings. And whenever the applicant shall request it, the patent shall take date from the time of the filing of the specification and drawings, not however exceeding six months prior to the actual issuing of the patent. * * * "

Law of 1839.

SEC. 6. "That no person shall be debarred from receiving a patent for any invention or discovery, as provided in the act approved on the fourth day of July, one thousand eight hundred and thirty-six, to which this is additional, by reason of the same having been patented in a foreign country [more than six months]* prior to his application: *Provided*, that the same shall not have been introduced into public and common use in the United States, prior to the application for such patent: *And provided, also*, That in all cases every such patent shall be limited to the term of fourteen years from the date or publication of such foreign letters patent."

* *Brackets ours.*

Law of 1870.

SEC. 25. "That no person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, by reason of its having been first patented or caused to be patented in a foreign country; *provided* [the same shall not have been introduced into public use in the United States for more than two years prior to the application, and]* that the patent shall expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term; but in no case shall it be in force more than seventeen years."

* *Brackets ours.*

Revised Statutes.

SEC. 4887. "No person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, by reason of its having been first patented or caused to be patented in a foreign country, [unless the same has been introduced into public use in the United States for more than two years prior to the application].* But every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term, and in no case shall it be in force more than seventeen years."

Brackets ours.

The printed bill (House 1714) was as follows:

No person shall be debarred from receiving a patent for his invention or discovery by reason of his having first patented it in a foreign country; provided the same shall not have been introduced into public (and common) use in the United States prior to the application, and that the patent shall (be limited to seventeen years from the date of the publication of the foreign patent) *expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term, but in no case shall be in force more than seventeen years.*"

"Foreign (patents) *inventions* may be patented. 4 July, 1836, c. 357, sec. 8. 3 March, 1839, c. 88, sec. 6. 5 McLean, 78, 80. 15 How., 112.

Office Supreme Court, U. S.
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CLERK.

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Supreme Court of the United States.

OCTOBER TERM, 1894.

No. 987.

BATE REFRIGERATING COMPANY,

COMPLAINANT AND APPELLANT,

v.

FERDINAND SULZBERGER ET AL.,

DEFENDANTS AND APPELLEES.

BRIEF FOR BATE REFRIGERATING CO.

JAMES C. CARTER,
CHAS. E. MITCHELL,
JAMES J. STORROW,
of Counsel.

Construction of Revised Statutes, § 4887.

ST. 1836, § 8.	ST. 1839, § 6.	REVISION OF 1870, § 25.	R. S. 4887.
But nothing in this act contained shall be construed to deprive an original and true inventor of the right to a patent for his invention, by reason of his having previously taken out letters patent therefor in a foreign country, and the same having been published, at any time within six months next preceding the filing of his specification and drawings.	No person shall be debarred from receiving a patent for any invention or discovery, as provided in act, July 4, 1836, to which this is additional, by reason of the same having been patented in a foreign country more than six months prior to his application: *Provided*, That the same shall not have been introduced into public and common use in the U. S., prior to the application for such patent; *And provided, also*, That in all cases every such patent shall be limited to the term of fourteen years from the date or publication of such foreign letters patent.	No person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, by reason of its having been first patented or caused to be patented in a foreign country; *provided* the same shall not have been introduced into public use in the U. S. for more than two years prior to the application, and that the patent shall expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term; but in no case shall it be in force more than seventeen years.	No person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, by reason of its having been first patented or caused to be patented in a foreign country, unless the same has been introduced into public use in the U. S. for more than two years prior to the application. But every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term, and in no case shall it be in force more than seventeen years.

The section drawn by the Revising Commissioners in 1870, and reported by the Committees of Congress to be a reproduction of Sts. 1836 and 1839, as modified by the seventeen-year clause of St. 1861, was :

No person shall be debarred from receiving a patent for his invention or discovery by reason of his having first patented it in a foreign country; provided the same shall not have been introduced into public and common use in the United States prior to the application, and that the patent shall be limited to seventeen years from the date or publication of the foreign patent. [See Brief, p. 70.]

Foreign patents may be patented. July, 1836, s. 8; v. 5 pp. 3 March, 1839, s. 6; v. 5 p. McLean, 78, 15 How. 112.

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Supreme Court of the United States,

OCTOBER TERM, 1894.

No. 687.

THE BATE REFRIGERATING CO., Plaintiff and Appellant,

v.

FERDINAND SULZBERGER, SAMUEL WEIL and FREDERICK JOSEPH, doing business under the firm name of SCHWARZCHILD & SULZBERGER.

ON A CERTIFICATE FROM THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT.

BRIEF FOR THE BATE REFRIGERATING CO.

Statement of the Case.

This is a bill in equity, filed July 25, 1892, on the *Bate refrigerating patent* of Nov. 20, 1877. The case stands on bill and pleas which raise and turn upon the following question:

The patent in suit is expressed on its face to be for seventeen years, which have not yet expired. The Revised Statutes, 4887, provide that in the cases to which that section applies, a domestic patent for an invention which the same inventor has patented abroad shall expire at the same time with the foreign patent. Now Mr. Bate patented his invention in England and in Canada by patents which "expired," within the meaning of the statute, before this suit was brought. If, therefore, his patent is one of those to which the statute applies, it had expired before the suit was brought, and under *Root* v. *Ry Co.*, 105 U. S. 189, the bill must be dismissed; but otherwise the pleas, one of which sets up the English, and the other the Canadian patent, must be overruled, and the bill retained.

The case turns on the legal effect of the following dates (record, p. 1):

United States patent, applied for Dec. 1, 1876; issued Nov. 20, 1877, in terms for seventeen years, which expire Nov. 20, 1894.

English patent, applied for Jan. 29, 1877; sealed July 13, 1877; complete specification filed July 26, 1877; dated Jan. 29, 1877, and in terms for fourteen years from that date, expiring Jan. 29, 1891, which was before this suit was brought.

Canadian Patent, dated Jan. 9, 1877, in terms for five years; afterwards extended; date of application not given.

The foreign patents were thus granted after the United States patent was *applied for*, but before it actually *issued*. The patentee insists that R. S. 4887 causes a curtailment when the foreign grant precedes the American *application*, which is *not* the case here. The infringers contend that it applies whenever the foreign grant precedes the American *issue*, which is the case here. If their view is right, our bill cannot be maintained; if their view is wrong, the pleas are bad.

The Error.

The circuit court adopted the defendants' view; held the date of American *issue*, and not the date of American *application*, to be the critical date contemplated by the statute; and therefore sustained the pleas and dismissed the bill. The Circuit Court of Appeals has certified up this question of law.

The circuit court was wrong in its construction of the statute. The Circuit Court of Appeals should be instructed that the date of American *application* governs in determining whether R. S. 4887 applies.

I. Judicial standing and history of the question.

The section of the Revised Statutes now to be construed is only the present form of a provision first found in St. 1836, added to by St. 1839, modified in one respect by St. 1861, reproduced, or at least purporting to be reproduced, by the revision of the patent law enacted in 1870, and by the Revised Statutes. As it stood before the "revisions," it indisputably made the right to the American patent depend upon the condition of things which existed at the date of *application*. The contention of the defendants is that certain changes in the wording, found in the revision of 1870 (of which the Revised Statutes are substantially though not literally a copy), made the date

of American *issue* the criterion for determining whether the curtailment of the section applies.

A number of questions have arisen under this section and have been passed upon by the courts. The decisions have shown that the section is, as a whole, ill-drawn, and calls for judicial interpretation; and every circuit court decision under it unfavorable to the patentee has, so far, been reversed by this court.

The precise question here at bar first came before the circuit courts in 1882 in a suit on this same patent, and was decided against us upon what was evidently very little consideration. Later it came before Justice BRADLEY, who declared that it was at least doubtful, and indicated a strong impression in our favor, but did not pass upon it. It has long been known as important, because it affects very many patents. But it has never been passed upon by this court. Its judicial history leaves it an undecided question, particularly calling for a decision here.

That history is as follows:

Judicial history of the question. This same patent was before the court in *Bate* v. *Hammond*, 129 U. S. 151 (1889). The infringers there insisted (p. 157), (1), that the statute applied; (2), that the Canadian patent was for five years; and therefore (3), that the American patent had expired before suit brought. This court held that the Canadian patent, though in terms for five years, was, by reason of a right of extension duly exercised, to be deemed a patent for fourteen years, and consequently, whether the statute applied or not, the American patent had not expired when the suit was brought; it sustained the bill upon that ground, and declined to express any opinion upon the question on which the present case must turn. The opinion (*per* BLATCHFORD, J.) thus stated the proposition for which we now contend, but which the court then refrained from passing upon (p. 164):

"That the words 'first patented or caused to be patented in a foreign country' do not mean 'first patented or caused to be patented' before the issuing, or granting, or date, of the United States patent, but mean 'first patented or caused to be patented' before the date of the application for the United States patent."

The question stands as entirely new and open before this court, because decisions at the circuit upon such a question are of no value here. Upon a rehearing in the *Driven Well Case* (*Andrews* v. *Hovey*, 124 U. S. 694, 716, 717), a long line of decisions at the circuit was urged against the decision of this court; but it declared that the construction of the patent act "cannot be regarded as judicially settled"; cannot "be regarded as finally settled so as to establish the law for like cases, until it has been determined by *this* court." In *Wilson* v. *Rousseau* (*quoted* p. 28, *infra*), in construing a clause of the patent act, this court recognized the peculiar importance of its own office in shaping "the operation of the system,"—"a general system of great practical interest to the country."

The circuit decisions themselves upon the question at bar are not, however, of a nature to afford any embarrassment; and they give no weight to the infringers' contention.

The precise question first came before a circuit court in 1882, in New Jersey, in *Bate Co.* v. *Gillett*, 13 Fed. R. 553. Judge NIXON, evidently without any appreciation of the question, or rather without appreciating that there even was a question, said that he was "at a loss to understand what the time of filing the application has to do with the matter."

In *Gramme* v. *Arnoux*, 21 Bl. 450; 17 Fed. R. 838, BLATCHFORD, circuit judge, simply cited and followed that ruling without reasoning or discussion in his opinion.

Edison Electric Light Co. v. *U. S. El. L. Co.*, 35 Fed. R. 134 [WALLACE, J.], simply stated the two foregoing cases, said that "Judge Blatchford adopted the views of Judge Nixon" and followed them without discussion.

In *Bate Co.* v. *Hammond*, COLT, J. merely adopted Judge Nixon's rulings under the same patent, without argument, and *pro forma*, in order that the parties might take a speedy appeal.

In the same *New Jersey Bate case*, however, at a later stage (31 Fed. Rep. 809), BRADLEY, J., in 1887, in spite of these decisions, indicated the opposite view, saying that this question was at least "**of considerable doubt**," "**quite a doubtful one**," and pointing out (p. 36, *infra*) that the effort of the revisers to condense had led them

to use general phrases ambiguous as to the date, and thus calling for judicial interpretation. His decision was that (according to his well known practice at the circuit), he felt bound *in that case* to conform to the decision already made in *it*.

On the appeal, taken in Judge Colt's case (*Bate* v. *Hammond*, 129 U. S. 151), the Supreme Court allowed twelve counsel to intervene and argue this and one other question. As the Edison incandescent lamp patent (as well as many others) is affected by this question, the Edison Co.'s counsel were employed on one side, and counsel of other electric light companies on the other, as the report shows. A similar course is pursued in this case.

The Judicial History of R. S. 4887 shows that it especially calls for Judicial Interpretation. The principal clauses of this statute have been the subject of frequent circuit court decisions, reversed by this court.

Thus upon the questions whether the provision that "the patent shall be limited to the term of" the foreign patent requires it to be limited on its face, or merely makes it expire with the foreign patent; whether the provision that the American patent shall "expire at the same time with the foreign patent" makes it expire when the term specifically named in the foreign patent expires, although that patent itself, by reason of an extension does not expire; whether the American patent expires only with the term so named, although the foreign patent itself expires long before by reason of failure to pay the fees required by a foreign law to keep it alive, — upon all these questions various circuit courts have decided adversely to the patentee; but upon every one the views so taken at the circuit have been reversed by *decisions in favor of the patentee in this court.*

At the circuit:

Morse's Case, 5 McLean, 76 and opinion of GRIER, J. in 15 How. 125.

Henry v. *Prov. Tool Co.*, 3 B. & A. 501 [1878, CLIFFORD, J.]

Reissner v. *Sharp*, 16 Bl. 383; 4 B. & A. 366 [1879, BLATCHFORD, J.]

Pailliard v. *Gautschi*, C. D. 1881, p. 491 [MCKENNAN, J.]

Bate v. *Gillett*, 13 Fed. R. 553 [1882, NIXON, J.]

Huber v. *Nelson Mf'g. Co.*, 38 Fed. R. 830 [1889, THAYER, J.]
Pohl v. *Brewing Co.*, 39 Fed. R. 782 [1889, WALLACE, J.]

Those views reversed by this court in:

O'Reilly v. *Morse*, 15 How. 62;
Bate v. *Hammond*, 129 U. S. 151, 167 [1889];
Pohl v. *Brewing Co.*, 134 U. S. 381.

Finally: does the date of American issue or the date of American application govern? — the question at bar.

This did not seem to Judge NIXON even to rise to the dignity of a question, but Justice BRADLEY found it very doubtful, and left it for this court. Judge NIXON, in this same opinion, decided that Mr. Bate's Canadian extensions were not to be regarded, speaking of this as being "*the plain and obvious meaning*" of the statute, and Judge BLATCHFORD had made the same decision, using the same language. Nevertheless, in *Bate* v. *Hammond*, this court reversed the decision on that point, and Justice BLATCHFORD wrote the opinion.

Pohl v. *Brewing Co.* and *Huber* v. *Nelson* (148 U. S. 270) did not raise our question, for, in each, the United States *application* was after the foreign grant.

It is thus clear that the whole section is an ill-drawn law, of which the surface reading is by no means the true one; and that it is the subject of great judicial differences, calling for judicial interpretation. For the rulings of the circuit courts, which were mostly rested upon the supposed literal meaning of its words and upon technical reasoning, have had to yield to the broader considerations by which this court has given it a sensible and just meaning and effect. And every decision adverse to the patentee which has reached this court has been reversed.

Of another case under a related section (*Siemens* v. *Sellers*, 123 U. S. 276, p. 25, *infra*), it is not too much to say that the decision disregarded the mere verbal force of the language, and set up a higher canon, declaring "No doubt, the words of a law are *generally* to have a controlling effect upon its construction; but the interpretation of those words is often to be sought from the surrounding circumstances and preceding history."

II. Outline of the Argument.

Root v. *Railway Co.*, 105 U. S. 189, 191, a case turning upon the construction of a provision in the patent act, expresses in admirable language the high duty of this court in this case, and the means for performing it.

"An examination of the practice and opinions of the circuit courts undoubtedly shows much diversity, incapable of reconciliation, and makes it necessary, as far as it can be done, by a deliberate judgment of this court, to remove the question out of its present uncertainty by a settlement upon *some basis of principle*, in *harmony with our system* of equity jurisprudence, developed and modified by legislation. To effect this satisfactorily and intelligently, it will be necessary to *review the course of legislation, and judicial decision* in this court, so far as it bears upon the question, from the beginning.'

Butterworth v. *Hoe*, 112 U. S. 50, 58. "We are led, therefore, immediately to inquire whether such a construction of phrases . . . *is justified by a view of the whole legislation in pari materia*, and *consistent with the integrity of the system* of the statutes in relation to letters patent for new and useful inventions."

We are to construe a section which constitutes a small part of a long statute. It touches a minor feature of a great system, the leading characteristics of which have not been changed in substance since congress inaugurated it a hundred years ago. That system, as we now have it, is the result of nearly a hundred years of legislation, in which, at every step (unless the one we are dealing with is to be so construed as to make it an exception), we can see a development of the original and central purpose which, as defined by this court through Chief Justice MARSHALL, was to give to every inventor a valid patent for that which he had himself created, unless he had forfeited his right by doing some act which the law regarded as mischievous.

The section itself is only the present form of legislation which began in 1836 on the exact subject here touched upon.

This section, like the rest of the present statute, is, moreover, a "revision."*

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* There have been two revisions of the patent law, both made by the revising commissioners: that of 1870 and that of the Revised Statutes. They differ in language, but it is settled that their meaning is the same.

We shall, therefore, take a review of the history of the whole legislation and the judicial decisions which expound it or illustrate it; and when we have found what was the law, and what was the reason of the law, immediately before the "revision," we shall inquire whether, while purporting to consolidate and reproduce the law of the old enactments, congress has, instead of that, overturned it.

The law as it existed up to and in 1836, under the construction which this court had put upon it, enabled inventors to patent both in this country and abroad, provided they *applied* here before their foreign patent issued. The deficiency in that law was that if they took a foreign patent *before they applied here*, their right to an American patent was barred. Congress, therefore, by Sts. 1836 and 1839 enacted that a foreign patent should *no longer be a bar* to receiving a patent *on an American application filed* after the foreign grant. To this a proviso was appended, that patents granted *by virtue of this new right* should be curtailed in proportion to the delay in applying here after the foreign grant.

Such was, and such was by the courts declared to be, the law down to the time of the revision. The courts pointed out that the limitation of the curtailing proviso to patents *applied* for here after the foreign grant, did not depend upon the *words* of the statute alone, but upon a higher consideration: this *enabling* legislation touched only patents applied for here after the foreign grant, because those *applied* for here *before* the foreign grant were already provided for; and, by a universal rule of construction, a proviso, said the court, cannot touch anything outside of the main clause to which it is appended.

Mr. Bate applied here on Dec. 1, 1876. Two months afterwards he sent a copy of his application to England, and filed it there. The English patent office issued his patent in July, 1877, taking the time their law and practice habitually require. In *our* office he was held back by an "interference," and his American patent issued in November, 1877. If the law be to-day as it was from 1790 to the revision of 1870, that is, if date of American *application* fixes the right (as *we* say), his patent is not curtailed. But if, as the defendants say, the revision made the American *issue*-date the criterion, then Mr. Bate's patent is curtailed; and it is curtailed precisely because,

though Mr. Bate was so vigilant as to apply here before he applied in England, our officials took longer than the English officials to perform their duties.

In the Morse telegraph cases, in 1850–53, it was pointed out that our examination system usually required a long pendency in the office, and that, if congress had taken the date of American *issue* as the criterion of curtailment, it would have committed the injustice and wrong of punishing the inventor for delays which the law imposed upon him. Yet the defendants insist that, under guise of a revision, congress has now done that *recognized* injustice which, before, it carefully framed its plan to avoid. They wish to impose their reading upon this provision *precisely in order to produce that result.*

Such an enactment by congress would be something more than mere injustice.

The patent act has been declared by this court to be a promise made by the public to the inventor, to be performed in good faith. But if the public, having received the invention, can find in *its own delay* in making the promised grant a ground for confiscating a large part of it, *to its own use*, there is no promise and no good faith.

If this statute has the effect attributed to it, it offers the only instance ever existing or hinted at in the patent law, where the filing of an application, duly prosecuted, fails to protect the right as it existed on the day of application.

Under the rule which governs the construction of revisions, it is certain that the most explicit and cogent language is required to produce such an effect; and here there is nothing of the sort.

The revising commissioners, the revision committee of congress, and the patent committees of congress, reported that the work of the commissioners (the clauses we have to construe are the commissioners' draft) was *an exact reproduction of the old law;* and congress so accepted and enacted it.

All the *phrases* of the section are copied from the old law. It copies *that framework* of the old law — enabling clause and appended proviso — which was declared sufficient of itself to give the old law its meaning. But, in the effort to condense two old statutes into one sentence, some transpositions and omissions occurred.

The present language is not, in terms, explicit as to what date

is to be the criterion of curtailment. The court learns it without difficulty by simply applying the familiar rule of law that a proviso finds its subject-matter in the subject-matter of the main, or enabling, clause; and we know that that consists only of patents *applied* for here after the foreign grant, because patents applied for here *before* the foreign grant had always been allowed under the general sections. But, by discarding that rule of *law*, and adopting in place of it a rule of grammar found in the *Century Dictionary*, the defendants declare that the words "*previously patented abroad*," in the proviso must be referred to a certain *particular* preceding *word* to find what the foreign patent is to be prior to.

They then allege that that preceding word, which does not *state* and, in the sentence in which it stands, does not signify issue-date, has, taken by itself, a literal meaning which *implies* issue-date. If that meaning be read into the curtailing proviso, that proviso will be made to go outside of the scope of the main clause to which it is an appendage, and thus lay hold of patents granted under the older and *general* sections.

To attempt thus to carry a proviso outside of the main clause to which it is the appendage, is, in the language of Judge COWEN (p. 89, *infra*), a contention that the court shall "follow the rules furnished by Johnson and Murray, instead of the rules of law; shall rest upon a verbal or grammatical construction instead of a legal one."

But the words relied on do not require the meaning on the establishment of which by force of them the defendants' case turns. They have been repeatedly used by this court, by other courts and by congress itself, as general words, *when the user meant date of application*.

They are so used in this very section. The main or enabling clause in which they are found has for its sole subject-matter patents *applied for* here after the foreign grant. The defendants' case, therefore, depends upon using those words to *give to the relative clause which refers to them, a signification not possessed by the clause of which they form a part.*

It is absurd to say that such words *compel* a court to put into this legislation a meaning which carries such consequences.

Another settled rule is that each subordinate or subsidiary feature, especially when introduced by supplementary legislation engrafted upon an older system, is to be interpreted in harmony with that system taken in its integrity; and, however general its words might be by themselves, it is limited in its scope to the defect it undertook to cure. This is a cardinal rule.

That rule ought to be, as it always has been, applied with great freedom to patent legislation. The patent system is the most philosophical and the most harmonious legal system we possess. It is such because it is *court-made law*. For most of the statutes have been merely the enactment of what the courts had already declared was or ought to be the law. This court, realizing its important share in this work, has always construed the statutes as it has construed its own opinions, in the light of principles and in conformity to them; and has never made itself the slave of words. The law will be preserved by the same method which has created it.

But, upon comparison, while our interpretation gives exactly the meaning which was praised forty years ago as sensible and just, the defendants' version is so utterly discordant, both with the general tenor of the system and with various specific leading features of it, that it is unthinkable by any one imbued with the spirit of our patent law.

Such is the outline of the case. But when we fully pursue the history of this legislation and the surrounding circumstances, and apply to them the rules of interpretation which innumerable decisions have established, and see how those rules have been applied in other cases, our view ripens into a positive conviction which an outline gives little idea of.

III. Judicial Interpretation; its function; and that this case calls for it.

The Judicial Interpretation of Writings is an ancient and a very high branch of the law. Its existence is a legal recognition of the fact that papers prepared by careful men to communicate their ideas, often fail to readily yield their true import to later readers; and its function is, by *judicial* interpretation, to reach that true significance which a mere surface reading does not give.

Of course, its task is not to reform papers, but to interpret them; but in doing that it treats particular words as the servants of the sense, and the first-blush reading is not even presumptively the true one; for one of its most ancient maxims is "*Qui haeret in litera, haeret in cortice.*"

Its canons are not artificial. It observes how men make writings, and the imperfections of expression they naturally fall into; and erects the results of these observations into rules by which from the expression it reaches back to the thought. This is not judicial legislation; it is ascertaining the legislature's meaning from the legislature's expression of it.

It is often said that language is a poor vehicle for the expression of thought; it would be more correct to place the imperfection in our use of it. In the preparation of a paper of any length, the draughtsman's mind is permeated with a general idea or purpose. Around this and in aid of this, all the particular ideas of detail group themselves. He sees his sentences as he thinks them, dominated by the central purpose, and they seem to him to express what he has in view. It must be admitted that they *can* bear that meaning, if to an intelligent writer, they seemed to express it. But a later comer, without that pre-occupation, reads a single passage, and receives from it a totally different impression. He looks at it again; its words taken by themselves, even read with intelligence, do not strike him as unintelligible or as ambiguous. Is his meaning necessarily the correct one; or can it be said *from that fact* that there is no ambiguity or doubt which calls for or permits the application of judicial interpretation?

Clearly not. Interpretation does not confine its offices to the mere case of sentences unintelligible or obviously ambiguous by themselves. Indeed the old distinction between patent and latent ambiguity, that is between a writing unintelligible on its face, and one which presented no difficulty until the parties began to apply it, was that it was to the *latter* class particularly that the law lent its aid.

The aim of legal interpretation is not to find *some* meaning in a paper, but if possible to read in it the true meaning of the parties. And therefore, any discordancy between a particular clause and the general scheme of the paper or of papers which the law reads with it (as the whole of a statute or other statutes *in pari materia*), or a want of harmony between the natural working effect of the apparent meaning of one clause and the rest of the system of which that clause is to form a working part, raise, of themselves, a difficulty which calls for judicial interpretation; and the particular clause, though its words taken alone might seem clear, will generally yield to the rest of the document.*

For in a long course of legislation, whether found in a lengthy single statute of which the clause in controversy forms a part, or in a series of acts which, added year after year, have built up a legislative system, there is usually a main plan around which all the lesser provisions group themselves. The legislature thinks of them and reads them as details engrafted on the main system and forming a part of it; and the law therefore so reads them that they will form a part of it. This is especially true of a provision which, like the one in controversy, constitutes a minor feature of a vast system, strikingly harmonious throughout, unless disturbed by this section; a system, too, which had taken form forty years before legislation touched this particular feature.

In such cases the first thing the court does is to follow Coke's wise rule, which was to inquire what the system was before the specific legislation was initiated; what difficulties had arisen from it in the

* A clause is always to be read with its context; and in *Atkins* v. *Disintegrating Co.*, 18 Wall. 272 (p. 19, *infra*), this court defined what is "context" for the purposes of this rule:

"The intention of the law maker is to be sought in the entire context of the section, — statutes or series of statutes *in pari materia*."

courts or in practice; why amendment or remedial legislation was called for; exactly what it was aimed at; and the character of the remedy applied. Then it will read the remedial legislation so that it will be remedial, and will not introduce a disturbance. When we are dealing with part of a system, therefore, and it is suggested that the apparent meaning of what purports to be remedial legislation has introduced a disturbance, the court at once looks to the legislative and judicial history of the matter for its surest guide. And nothing but the most explicit, express and positive statements in the statute will prevent it from following that guide.

We have not, therefore, read enough to know whether judicial interpretation of this section is called for, until we have read the whole statute of which it forms a part, with a clear comprehension of the entire system which that statute presents, and of the legislative and judicial history of that system. When we are possessed of all this, the language of some part may be explicit enough to override other parts; but we are not in a position to judge whether one particular element will prevail over the others until we have considered all of them. Some very pertinent instances where no doubt was *raised* except by considering the elements outside of the words of a particular clause are found on pp. 15–20, *infra*.

Such have been the leading rules from the earliest time, — to seek the intention of the legislature from legitimate sources, and to treat the inquiries we have mentioned as among the most legitimate and surest sources for that intention. These rules have prevailed so long that they have become a part of every statute; those who enact it know that it will be so interpreted.

The rule of *consistency with the integrity of the system* has been always and especially the guiding star in the interpretation of patent legislation, because, beyond all other statutory creations, the patent law constitutes a system, and an harmonious system. Judge STORY in the appendix to 3 Wheat., in 1819, and this court, through Judge STORY, in *Pennock* v. *Dialogue*, 2 Pet. 1, in 1829, pointed out that, though the nature of our frame of government and other like causes made our patent system differ in many respects from the English, yet it was founded on the main principles developed in England, and those principles afforded a guide to the interpretation of

our statutes, *mutatis mutandis*. But this is still more true of our own legislation; because, since 1836 and, indeed, from the earliest beginnings with us, there have been substantially no changes except in the working details; and such changes do not prevent the ascertainment of the harmonious plan and the application of the rule from it (*Converse* v. *U. S.*, p. 19, *infra*). For such examples of the interpretation of patent legislation see *Butterworth* v. *Hoe*, *Gandy* v. *Main Co.*, *The Woodworth Cases*, *Siemens* v. *Sellers*, *Refrig. Co.* v. *Featherstone*, pp. 19, 20, 24, 30, 45; also p. 122, *infra*.

The True Intent of the legislature is to be sought for.

Church of the Holy Trinity v. *United States*, 143 U. S. 457. "It must be conceded that the act of the corporation is *within the letter of this section*"; but

"It is a familiar rule, that a thing may be within the letter of the statute and yet not within the statute, because not within its spirit, nor within the intention of its makers. This has been often asserted, and the reports are full of cases illustrating its application. This is not the substitution of the will of the judge for that of the legislator, for frequently words of general meaning are used in a statute, words broad enough to include an act in question, and yet *a consideration of the whole legislation, or of the circumstances surrounding its enactment, or of the absurd results which follow* from giving such broad meaning to the words, makes it unreasonable to believe that the legislator intended to include the particular act. As said in Plowden, 205: 'From which cases, it appears that the sages of the law heretofore have construed statutes **quite contrary to the letter** in some appearance, and those statutes which comprehend all things in the letter they have expounded to extend to but some things, and those which generally prohibit all people from doing such an act they have interpreted to permit some people to do it, and *those which include every person in the letter, they have adjudged to reach to some persons only*, which expositions have always been founded upon *the intent of the legislature, which they have collected sometimes by considering the cause and necessity of making the act, sometimes by comparing one part of the act with another, and sometimes by foreign circumstances.*'"

United States v. *Lacher*, 134 U. S. 624; p. 96, *infra*. Speaking of a statute the court said: "although the apparent grammatical construction might be otherwise, the true meaning, if clearly ascertained, ought to prevail."

Oates v. *First N. Bank of Montgomery*, 100 U. S. 239: "The duty of the court, *being satisfied of the intention of the legislature*,

clearly expressed in a constitutional enactment, *is to give effect to that intention*, and not to defeat it by adhering too rigidly to the mere letter of the statute, or to technical rules of construction. *Wilkinson* v. *Leland*, 2 Pet. 627; Sedgwick, Const. and Stat. Constr., 196. And we should discard any construction that would lead to absurd consequences. *U. S.* v. *Kirby*, 7 Wall. 482. We ought, rather, adopting the language of Lord HALE, to be 'curious and subtle to invent reasons and means' to carry out the clear intent of the law-making power when thus expressed."

The Court then quoted: "A thing which is within the intention of the makers of a statute is as much within the statute as if it were within the letter; and a thing which is within the letter of the statute is not within the statute unless it be within the meaning of the makers. *Suckley* v. *Furse*, 15 Johns. (N. Y.) 338; *The People* v. *Utica Insurance Co.*, id. 357, 380."

Brewer v. *Blougher*, 14 Pet. 178, 198. "It is undoubtedly the duty of the court to ascertain the meaning of the legislature, from the words used in the statute, and *the subject matter to which it relates;* and to restrain its operation within narrower limits than its words import, if the court are satisfied that the literal meaning of its language would extend to cases which the legislature never designed to embrace in it."

Reiche v. *Smythe*, 13 Wall. 162, 164. "If it be true that it is the duty of the court to ascertain the meaning of the legislature from the words used in the statute and the subject matter to which it relates, there is an equal duty to restrict the meaning of general words, whenever it is found necessary to do so, in order to carry out the legislative intention. *Brewer* v. *Blougher*, 14 Pet. 178."

Thereupon, decided, that a bird is not a "live animal," within the meaning of a certain customs' act.

Observe, the words *per se* were clear; the doubt arose from comparing their apparent meaning with the rest of the act.

Canal Co. v. *Hill*, 15 Wall. 94. *Head note.* "When the substantial thing which they have in view can be gathered from the whole instrument, it will control mere formal provisions which are intended only as a means of attaining the substance."

In re Ross, 140 U. S., p. 453, 475. "It is a canon of interpretation to so construe a law or a treaty as to give effect to the object designed, and for that purpose all of its provisions must be examined in the light of attendant and surrounding circumstances. To some terms and expressions a literal meaning will be given, and to others a larger and more extended one. The reports of adjudged cases and approved legal treatises are full of illustrations of the aplication of this rule. The inquiry in all such cases is as to what

was intended in the law by the legislature, and in the treaty by the contracting parties."

Big Black Creek Imp't Co. v. *Com'th*, 94 Pa. St. 455. "Statutes are to be construed so as may best effectuate the intention of the makers, which sometimes may be collected from the cause or occasion of passing the statute, and, when discovered, it ought to be followed with judgment and discretion in the construction, though that construction may seem *contrary to the letter of the statute*."

Endlich, Interp. of Stats., s. 25. The rule that a literal interpretation is first to be taken "does not carry the interpreter far; for it is confined to cases where the language is *precise* and capable of but one construction, or where neither the context nor the consequences to which the literal interpretation would lead, show that that interpretation does not express the real intention.

"But it is another elementary rule that a thing which is within the letter of a statute is not with the statute unless it be also within the meaning of the legislature, and the words, if sufficiently flexible, must be construed in the sense which, if less correct grammatically, is more in harmony with that meaning. *Language is rarely so free from ambiguity as to be incapable of being used in more than one sense;* and **to adhere rigidly to its literal and primary meaning in all cases would be to miss its real meaning in many.**"

The defendants quoted below, as their leading authority:

Newell v. *People*, 7 N. Y. 9, 97. "Whether we are considering an agreement between parties, a statute or a constitution, with a view to its interpretation, the thing we are to seek is, *the thought which it expresses*. To ascertain this, the first resort in all cases is to the natural signification of the words employed, in the order and grammatical arrangement in which the framers of the instrument have placed them. If, thus regarded, the words embody a definite meaning, which involves no absurdity, **and** no contradiction between different parts of the same writing, **then** that meaning apparent upon the face of the instrument is the one which alone we are at liberty to say was intended to be conveyed. In such a case there is no room for construction."

According to this, their own authority, it is not enough to exclude "construction" that a particular sentence relied on escapes being unintelligible or absurd on its face, when taken by itself. First, the words themselves must constitute an express, explicit and "definite" statement, precisely to the point; and even then, if, upon a view of the *whole* statute or legislation, any absurdity or contradiction is "involved," the paper itself *calls* for judicial interpretation; and in-

vokes it *in order to overcome the "meaning apparent on the face of the instrument."*

The other authorities cited show that "the letter," the "literal meaning," is often overruled. That could not be if "the letter" could ever exclude the consideration of the other elements of interpretation.

That the LAW has not read a single clause *until it has possessed itself of the "context"; and that the "context" includes the legislative and judicial history of the subject; and that harmony with the system of which the clause forms part is a most important guide; is also shown by abundant authority.*

Lord Coke's Rule (*Heydon's Case*, 3 Rep. 7a; 10 Rep. 73a).

The gist of this rule is that, at the outset the court will take into view not a single clause alone, nor even content itself with reading the statute in which it is found, but will possess itself of the whole course of legislation as the prime means of interpreting any part of it; and will especially do this where, as in our case at bar, the particular provision was introduced to remedy a defect or a deficiency.

Coke's statement is that "for the sure and true interpretation of all statutes in general (be they penal or beneficial, restrictive or enlarging of the common law), four things are to be discussed and considered":

1. What was the law before the Act was passed;
2. What was the mischief or defect for which the law had not provided;
3. What remedy the legislature has appointed; and,
4. The reason of the remedy."

Endlich, Interp. Stats., s. 27, quoting this, says: "The literal construction then, has, in general, but a *prima facie* preference. To arrive at the real meaning, it is always necessary to take a broad general view of the act, so as to get an exact conception of its aim, scope and object."

Lord Bacon's rule, quoted in 4 How. 690, is: "*The most natural and genuine way* of construing a statute is to construe one part by another part of the same statute; for this best expresseth the meaning of the makers."

Blackstone, 1, 59. "The fairest and most rational method to interpret the will of the legislator is by exploring his intentions at the

time when the law was made, by *signs* the most natural and probable. And these signs are either the words, the context, the subject-matter, the effects and consequence, or the spirit and reason of the law."

Butterworth v. *Hoe*, 112 U. S. 50, 58. "We are led, therefore, immediately to inquire whether such a construction of phrases . . . *is justified by a view of the whole legislation in pari materia*, and *consistent with the integrity of the system* of the statutes in relation to letters patent for new and useful inventions."

The words *in themselves* raised no doubt.

Converse v. *United States*, 21 How. 463. The question was as to a claim by the collector of the port for commissions on lighthouse disbursements, and it turned on the meaning of the statute. The rule laid down by this court for ascertaining that meaning is, in effect, Coke's rule. The opinion by TANEY, C. J., said:

P. 467. "The object and policy of this whole legislation, when taken together, will be made evident by looking at the state of the law before and at the time the different laws were passed, and the defects which then existed, and which they were intended to remedy."

Thereupon, the court rehearsed at some length the state of legislation at one time, the decisions which the courts made under it and some consequences which arose therefrom, and the legislation in controversy which grew out of that condition of things. From that it deduced the reason of the later laws *and their meaning*. In the course of this, it said:

P. 473. "It will be seen, from this history of the complicated legislation on this subject, that, however varying the provisions may be in some particulars, they are yet all founded on the principles and policy of the acts of 1822 and 1839."

Atkins v. *Disintegrating Co.*, 18 Wall. 272. The question was whether certain general provisions of the Judiciary Act relating to "civil suits" touched admiralty suits *in personam*.

P. 301. "It may be admitted that an admiralty case is *a civil suit* in the general sense of that phrase. But that is not the question before us. It is whether that is the meaning of the phrase as used in this section. The intention of the lawmaker constitutes the law (*United States* v. *Freeman*, 3 How. 563). A thing may be within the letter of a statute and not within its meaning, or within its meaning though not within its letter. In cases admitting of doubt the intention of the lawmaker is to be sought in the entire context of the section, — statutes or series of statutes *in pari materia* [citing *Patterson* v. *Winn*, 11 Wheat. 389, and other authorities].

"The general language found in one place, may be restricted in its effect to the particular expressions employed in another, if such,

upon a careful examination of the subject, appears to have been the intent of the enactment [citing *Brewer* v. *Blougher*, 14 Pet. 178, 198, and other authorities]."

Thereupon it was decided that an admiralty case *in personam* is *not* "a civil suit" within the meaning of the provision which limits civil suits to the district where the defendant resides or is found.

Platt v. *Union Pacific R. R.*, 99 U. S. 48, 59. "We are seeking for the intention of congress; and to discover that, we may look at the paramount object which congress had in view, as well as the means by which it proposed to accomplish that object."

U. S. v. *Hartwell*, 6 Wall. 385, 395. "We are not unmindful that penal laws are to be construed strictly. It is said that the rule is almost as old as construction itself. But whenever invoked it comes attended with qualifications and other rules no less important. *It is by the light which* **each** *contributes that the judgment of the court is to be made up.*".

Gandy v. *Main Belting Co.*, 143 U. S. 587. R. S. 4886, provided that whoever has made a new invention "not known or used by others in this country, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, *and not in public use or on sale for more than two years prior to his application*," may have a patent therefor.

Will such public use and sale *abroad*, by the inventor himself, bar him?

The language, as language, is clear; it specifies public use without restriction of place. The rest of the sentence makes it more clear; for on the subject of *priority*, congress carefully and specifically limits the inquiry to a particular locality; but on the subject of the bar by public use, it makes no such distinction, and its language is universal. No ambiguity can be raised on the section itself. Nor would it be intrinsically absurd to make two years' public use anywhere a renunciation of the right to patent. St. 1800 specifically provided that it should be fatal in the case of aliens.

But the court read two other sections of the act (4920, 4923), and, *from those other sections it first raised a doubt*, and then solved it, deciding that public use abroad was not within the statute; that is, it read into this clause the words "in this country," which the legislature had put into the former clause but had not put into this. It said, "*Taking all these provisions of the patent law together*, we think it was manifestly the intention of congress," etc.

Pratt v. *Street Com'rs*, 139 U. S. 559, 563, p. 100, *infra*. "*In determining also what is the meaning properly attributable to any language* we are also to consider the other language used in relation to the same subject."

Dominick v. *Michael*, 4 Sandford, 374, 407. "Certainly if these words are to be understood in the full extent of their literal meaning, the argument would be irresistible." But the court overruled that argument.

Endlich, Interp. of Stats., s. 35. "*All parts of a statute to be compared.* . . . It is an elementary rule that construction is to be made of all the parts together, and not of one part only by itself." Citing, *inter al.*, *Pennington* v. *Coxe*, 2 Cranch, 33, 53; *Rice* v. *R. R. Co.*, 1 Black, 358, 378; *Wilkinson* v. *Leland*, 2 Pet. 627; *Atkins* v. *Disintegrating Co.*, 18 Wall. 272.

Endlich, s. 2. Words and phrases are to be construed in their technical or their popular sense, and according to the rules of grammar, "*unless* adequate grounds are found, either in the **context** or in the **consequences** which would result from the literal interpretation, for concluding that that interpretation does not give the real intention of the Legislature."

Sedgwick, c. vi, p. 190, 2d ed. "It is hardly necessary to assert the proposition, that, in the use of language uncertainty and ambiguity are sure to occur. . . . In regard to laws, as in other cases, difficulties will arise, in the first place from the disputed meaning of individual words, or, as is usually said, of the language employed; and in the second place, **assuming the sense of each separate word to be clear, doubt will result from the whole context.** *It is to meet cases of these two kinds that principles of interpretation or construction become necessary.*"

Sutherland on Statutory Constr., § 240. "*General intent of statute, key to meaning of the parts.* The presumption is that the law-maker has a definite purpose in every enactment, and has adapted and formulated the subsidiary provisions in harmony with that purpose; that these are needful to accomplish it; and that, if they [do not?] have the intended effect, they will, at least, conduce to effectuate it. That purpose is an implied limitation on the sense of general terms, and a touchstone for the expansion of narrower terms. This intention affords a key to the sense and scope of minor provisions."

Because, in a long paper, the most vigilant draughtsman will use phrases, or specify details which, when applied literally to circumstances he did not have in mind at the moment, will run counter to the general purpose; but the law is not helpless before such a difficulty.

The General Framework of a System of legislation *will, upon similar principles, enable the court to ascertain the will of the legislature and give effect to it, in respect of details where the words express no intention or none which can be imputed to the legislature.*

It not unfrequently happens that practice under a statute presents situations and raises questions which were certain to arise in the ordinary course of events, but which the legislature did not in fact think of. It seems at first sight a misnomer to speak of discovering from the expressions of the legislature its intent upon a subject which it did not think of; but to do this is one of the duties of judicial interpretation and construction.

Endlich, s. 1. "The subject of the interpretation of a statute seems to fall under two general heads: what are the principles which govern the construction of the language of an act of parliament; and, next, what are those which guide the interpreter in gathering the intention on those incidental points on which the legislature is necessarily presumed to have entertained one, but on which it has not expressed any."

Judge COOLEY thus states the broad scope of the judicial powers which he calls "interpretation" in the one case, and "construction" in the other:

Cooley, Const. Limit. (6th ed.) 51. "Interpretation differs from construction in that the former is *the art of finding out the true sense* of any form of words; *that is, the sense which their author intended to convey;* and of enabling others to derive from them *the same idea which the author* **intended** *to convey.* Construction, on the other hand, is the drawing of conclusions respecting subjects that lie beyond the direct expressions of the text, from elements known and given in the text."

Judge Cooley points out that these judicial powers, for which both words are generally used indiscriminately, are employed to discover what he has just called "the *true* sense" as distinguished from *some* meaning; and to give to a particular passage, by comparison with the rest of the law, and in order to harmonize it with the rest of the law, a meaning different from that which it would bear by itself. By a similar application of the rule of general intent gathered from general sources, the will of the legislature is in a legal sense discovered and enforced in a case which it overlooked, and as to which

of course it had in fact no intent, and its particular words expressed none. So his view, like that of other jurists, is that it is only after we have studied *all* the elements which affect judicial interpretation or construction that we can know whether the exercise of its powers, as distinguished from mere surface reading, is called for. He says:

"Construction is resorted to when, *in comparing* two different writings of the same individual, or *two different enactments* by the same legislative body, there is found contradiction where there was evidently no intention of such contradiction one of another. . . . So, too, if required to act in cases which have not been foreseen by the framers of those rules, by which we are nevertheless obliged, for some binding reason, faithfully to regulate, as well as we can, our action respecting the unforeseen case."

In one view, the case at bar might be of this character. We might assume that the exact question whether the *issue* date or the *application* date of the American patent shall govern was not present in the minds of congressmen who voted for the revisions of 1870 or 1874, or of the "revisers" who wrote them. But if that were so, we should not be left in the dark as to the legislative will; for we *know*, from the statutes themselves, two facts: one is that congress, invariably, in this statute and in all others, made the *application* date and the inventor's *own* delay the criterion of forfeiture or penalty; and the other is that *the* object of the enactment of the "revision" was to reproduce, in condensed language, the old law which admittedly adopted the *application* date. To override these two all-pervading intentions in this particular instance, by force of *words*, they must forcibly convince the mind that congress here specifically, and with express purpose, meant to override them.

Interpretation from Consequences. On congress which makes a law, and not on the courts which construe it, rests the responsibility for its folly or for its evil consequences, if it be foolish or pernicious. Yet the courts always look at the consequences of two possible constructions, and reject that which leads to results no sensible or just legislator could have intended.

In *Murdock* v. *Memphis*, 20 Wall. 590, p. 93, *infra*, the question was whether St. 1869, which omitted a limitation found in the judiciary act of 1789, extended the power of this court to questions

excluded by the former limitation. The decision was that it did not. This extension of the power of this court, of course, was not an evil *per se;* but it would be a great innovation in the time-honored distribution of judicial powers. The court declared that *explicit* and *affirmative* words were required to bring about such a change, and summed up the grounds of it decision by saying (p. 629), "*It is impossible to believe that congress intended this result.*"

Two cases which arose on the two extensions of the Woodworth planing machine patent offer vigorous application of this rule.

Wilson v. *Rousseau*, 4 How. 646 (1846). Woodworth, the inventor of the planing machine, had sold his patent. His assignees had licensed very many machines, granting, usually, an exclusive right to use a certain number of machines in a certain territory. Woodworth died during the term of the patent. His administrator asked for and obtained an extension under the general law, St. 1836, s. 18. The question was as to the rights of the various parties, under that statutory extension and during the extended term.

The question was a difficult one. Three judges dissented; the majority agreed that the true meaning of the statute "cannot be asserted with entire confidence." The surface reading of the statute did not suggest a doubt; the important phrases were copied from other parts of the statute where they had a well-defined meaning. But when the *effect* of a verbal rendering was considered, it became obvious that it would work results which were unjust, or not in accordance with the general purpose of the patent law. Thereupon the court gave to it a meaning which conformed to those principles, but which the words, taken by themselves, did not even suggest, and with difficulty bore.

All the court agreed with and applied Lord BACON'S rule, quoted in Justice MCLEAN'S dissenting opinion:

> "The most natural and genuine way of construing a statute is to construe one part by another part of the same statute; for this best expresseth the meaning of the makers."

The differences were chiefly as to the exact extent to which the language of the section should be so controlled. The statute was:

Stat. 1836, s. 18. "Whenever any patentee . . . shall desire an extension . . . he may make application therefor, in writing, . . . and shall furnish a statement in writing, under oath, of the ascertained value of the invention and of his receipts and expenditures."

The commissioner is to "renew and extend the patent by making a certificate thereon of such extension . . . and thereupon the said patent shall have the same effect in law as though it had been originally granted for the term of twenty-one years. And the benefit of such renewal shall extend to assignees and grantees of the right to use the thing patented to the extent of their respective interests therein."

It was pointed out that the petition was to be made by the inventor; that it required his personal oath; that while the sections about *original* patents and *reissues* provided that they might be made to the administrator, and that the latter might make the oath, there was no such provision here; and therefore it was insisted that there was only a personal right which died with the inventor. But the court said that the object of the statute was to enrich a meritorious but unfortunate inventor; and if he died the benefit should survive to his estate.

The last quoted clauses, however, raised the greatest difficulty. The verbal scheme of the section was that the patent should stand as a twenty-one year patent, — "as though it had been originally granted for the term of twenty-one years." Upon which it was clear, *so far as words go*, that those who had bought and owned the patent, owned it such as it had grown to be. This was strengthened by the fact that no new patent was to issue, but a "stretcher," if we may be permitted the word, was to be written on the back of the old one, the owner of which must therefore be present and produce it; and the words, that "the benefit of such renewal shall extend to assignees," etc., seemed to be explicit to this end.

To this argument the administrator replied that the clause about assignees should be read to apply to those who had bought the extended term from the patentee and were assignees of *that;* this view was taken by WOODBURY, J., in his dissenting opinion. But the court refused both these views, and declined to adopt any construction resting on *words*. It said:

P. 678. "Now, the serious difficulty in the way, and which renders the first interpretation inadmissible, except upon the most explicit and positive

words, is, that it subverts at once the whole **object** and **purpose** of the enactment, as it is plainly written in every line of the previous part of the section."

"Nothing short of the most fixed and positive terms of a statute could justify an interpretation so *repugnant to the whole scope and policy of it, and to wise and judicious legislation.*"

Upon the same ground of repugnancy to the wise and judicious legislation of the patent act the court rejected Justice WOODBURY'S view. Many planing mills had been built to use machines constructed under licenses granted during the original term — as would naturally be the case under any patent of importance. Now, if the whole matter were *tabula rasa* upon the grant of the new term, the inventor (or his administrator) had those users at his mercy; they must pay him any price he chose to ask, or see their factories shut up. This court would not believe that congress intended *that*, and *therefore* construed the statute so as to prevent it. It held that the clause which extended the benefit to "assignees" etc., referred to those who had acquired interests under the original term.

But "assignees" was a technical term, meaning those who had an interest in the *monopoly:* should the same interest continue under the extension? No; the court declined to give its well-known technical meaning to the word; it, in effect, treated the word as tautological, and restricted this clause of the statute to those who were grantees of a mere right of user; and decided that the right of using machines acquired during the original term was, by force of the statute, continued under the new term as a right to use those same machines, but without any element of exclusiveness.

Here again the words stood in the way. In Woodworth's case it happened that the interest of every user was an exclusive interest — exclusive as to his limited territory; and if the statute prolonged their interest it prolonged it "to the extent of their respective interests." But the court held that it did not; the right it gave them, said the court, entitled them to *use*, but it did not "extend" to the exclusion of others.

One can imagine doctrines of patent law or of equity, by which a court might possibly have worked out the protection of those users; but it did not resort to them. It could not, because, while they

might have solved that case, it was realized that the statute meant *something;* it could not be ignored; it must be construed. The court refused to dodge the difficulty, saying (p. 684):

"We must remember, too, that we are not dealing with the decision of the particular case before us, though that is involved in the inquiry; but with a general system of great practical interest to the country; and it is the effect of our decision upon the operation of the system that gives to it its chief importance."

And so its decision was, that in dealing with a section which, certainly upon the question of the right of assignees, did not, upon its words, present even a doubt, they must give it a meaning which would avoid consequences they were unwilling to impute to congress. The court said how it learned its true meaning (p. 677):

"A due regard to the great object and intent of congress, as collected from the context and general provisions and policy of the patent law," is to be resorted to "to fix and control their meaning, so as to reconcile it, if possible, with the general policy of the law."

Then coming to the precise point we are now considering, it said (p. 684):

"**The consequences** of any different construction from the one proposed to be given are **always** to be regarded by courts, when dealing with a statute of doubtful meaning."*

Next, tracing out the result of one interpretation, the court said that under it those who had bought and paid for these machines, would be "left to the discretion or caprice of the patentee."

"A construction leading to such **consequences**, and fraught with such unmixed evil, we must be satisfied, was never contemplated by Congress, and should not be adopted unless compelled by the most express and positive language of the statute" (p. 684).

P. 680. "We cannot but think a court should hesitate before giving a construction to the clause so **deeply harsh and unjust in its consequences**, both as it respects the public and individual rights and interests, upon so narrow a foundation."

* The doubt did not arise upon reading the words themselves; but only upon view of the consequences which ensued from engrafting the surface meaning, or the mere *verbal* meaning on to the patent system as a whole.

The foundation was "narrow", not because the words were inapt in themselves; but because words are at best a narrow foundation against the more powerful elements of interpretation, from which the court raised its doubts and by which it solved them.

Bloomer vs. *McQuewan*, 14 How. 539. In 1845 congress further extended the same Woodworth patent by a special act, and the question now came up whether the defendants who had acquired an exclusive right to use a certain number of machines in a certain territory during the original term, could continue to use the same machines during the term of the second, or congressional extension. *Now* the difficulty was that the clauses of the general law which the court availed itself of to give that right in the former case, were totally omitted in the special act (which however was passed before that decision). That act contained no reference whatever to the rights of grantees, and no reference whatever to the general law.

But the court held (1), that in construing the special act it must, *at the outset*, consider also the general law and also all special acts, both earlier and later, extending other patents. In those other laws it found the desired words; the statute before the court was plainly in this respect an exception to the others. But if the words of the other laws upon which the court based the grant to users were absent from this law, could the court find the same grant in this law? The court did not so put the question. It turned it round. There is a great deal in the way a question is put; and the court looked at the inquiry in a way that led towards a particular answer, because that is the way the law looks at it: The general plan and policy was clear from all the other laws; did the *omission* of the words which expressed that plan cogently express an *intent to depart* from it? The opinion, drawn by TANEY, C. J., said: "We ought not to presume without plain words to require it" that congress intended to make the exception.

In short, the omission to put into the statute the words which, in all other statutes, had given the right, did not amount to the declaration of a contrary intent. It only showed (p. 553),

"that in some cases the attention of the legislature was more particularly called to the subject, and the rights of the purchaser recognized and more cautiously guarded."

Blake v. *Nat. Banks*, 23 Wall. 307. An amendatory act levied an income tax "for and during the year 1871." This court read it as laying a tax on the income of two years, 1870 and 1871. No support for this could be found in the words taken by themselves; but, pointing out the *consequences* of the one construction or the other, this court said of the literal meaning of the phrase (p. 320):

"It is impossible to believe congress intended to make this discrimination. It is entirely unreasonable, and not in harmony with the well-known views of congress on the subject."

United States v. *Kirby*, 7 Wall. 482 (*per* FIELD, J.): "All laws should receive a sensible construction. General terms should be so limited in their application as not to lead to injustice, oppression or an absurd consequence. It will always, therefore, be presumed that the legislature intended exceptions to its language which would avoid results of this character. The reason of the law in such cases should prevail over its letter."

Rex v. *Skeen*, 28 L. J., M. C. 91: "If the language employed admit of two constructions, and according to one of them the enactment would be absurd and mischievous, and according to the other it would be reasonable and wholesome, we surely ought to put the latter construction upon it as that which the legislature intended."

Our opponents' case comes down to a single allegation, — that certain phrases in this section *taken by themselves*, present no ambiguity. This is not true in fact (p. 139, *infra*); but no layman, even, would be satisfied to stop on those words. For, in view of the absurdity and injustice of our opponents' meaning (pp. 47–52, *infra*), he would refuse to believe that it was the true one.

But congress has always meant to be fair to inventors and to be sensible with regard to patents. It did not seem to us possible that it intended to work this evil and this injustice, and to perpetrate this folly. How will the law ascertain what congress meant?

Rule of Interpretation from Causes which gave rise to the law, from the Defect which called for a Remedy and from the Surrounding Circumstances.

Perhaps the most important rule of interpretation is the one drawn from an observation and experience we have referred to. Shall the paper be read with the eyes and the mind of the writer or with those of a stranger? No rule is better settled, both as to contracts and statutes than this, that the court will put itself in the position of

the parties at the moment "so as to view the circumstances as they viewed them, and so to judge of the meaning of the words, and of the correct application of the language to the things described." It will always use what in *Nash* v. *Towne*, 5 Wall. 689, 699, and *Mobile R. R.* v. *Jurey*, 111 U. S. 584, 592, was called *the strong light of surrounding circumstances*. Other cases illustrate this.

In *Church*, etc., v. *United States*, 143 U. S. 457; p. 15, *supra*, the court quoted from Plowden various instances of construction,

"which expositions have always been founded upon the intent of the legislature, which they have collected sometimes by considering **the cause and necessity** *of making the act, sometimes by comparing one part of the act with another and sometimes by foreign circumstances.*"

Siemens v. *Sellers*, 123 U. S. 276. Before 1861 our patents varied both in length of term, and in the date from which the term might run. Thus they were for fourteen years, or by extension, twenty-one years. The term might be reckoned from either one of three dates; most usually from their date of issue, but, in cases affected by St. 1839, s. 8, from "the date or publication of" a foreign patent for the same invention; and by St. 1836, s. 8, they could be antedated to the time of application, not exceeding six months before allowance.

St. 1861 enacted that "*all* patents shall remain in force for the term of seventeen years from *the date of issue*." Language could not more clearly unify both the term and the starting point. It certainly, so far as words went, fixed the starting point for "all" patents, as much as it did the term for "all" patents. Stronger words could not be found to put *all* patents under one uniform rule as to *both*. But the court read it as changing and fixing the duration of the term, and as not changing nor fixing the starting point.

It cannot be pretended that the *words*, on their face, offered any ambiguity, or suggested a doubt. But the court at once compared the act with all other legislation about patents, and considered the consequences of the reading of the words by themselves. From a consideration of *these other elements of interpretation* the court *first raised a doubt;* and by them it solved it.

The court read this statute as making "all patents" bear a nominal term of seventeen years, but as not making "all patents" reckon

their seventeen years "from the date of issue." In its effect on statute 1839 the court made it amend the provision which named fourteen years, but did not permit it to amend the other provision of the same clause which named the starting point;* so that patents granted under statute 1839 ran seventeen years from the date of a foreign patent for the same invention. The court, of course, did not pretend to rest this on any verbal interpretation. It found that the general intent of congress in the new law was to change the length of term; and it refused to permit any language, however apt, to work any change which it did not believe congress actually thought of and intended. It said (p. 285):

"No doubt, the words of a law are *generally* to have a controlling effect upon its construction; but the interpretation of those words is often to be sought from **the surrounding circumstances and preceding history.** From the history of the law in this case, as exhibited in previous enactments, and from the evident object and purpose of § 16 of the Act of 1861, we are satisfied that the words there used to define and limit the term during which patents thereafter granted should remain in force, namely, 'seventeen years from the date of issue,' were only intended to change the length of the term, and not the point of its commencement;"

and thereupon declared:

"Seventeen years' limit was substituted for fourteen years. That was all that was intended or thought of. **That was the sole point before the legislative mind.**"

The other view "can *hardly be supposed* to have been the intention of congress."

Burdett v. *Estey*, 19 Blatch. 1; 3 Fed. R. 566 [1880] had already held that this statute of 1861, did not affect the *antedating* clause of St. 1836, s. 8.

Endlich, Interp. Stats., § 113. "PRESUMPTIONS ARISING FROM SCOPE AND SPECIFIC PURPOSE OF ACT. *Presumptions against Needless Change of Law.*

"It is more reasonable to hold that the legislature expressed its intention in a slovenly manner than that it intended something which it is presumed not to intend. One of these presumptions is that the

* Statute 1839. "*Fourteen* years from the *date* or publication of such foreign letters patent."

legislature does not intend to make any alteration in the law beyond what it **explicitly** declares, either in express words or by unmistakable implication; or, in other words, beyond *the immediate scope and object of the statute*. In all general matters beyond, the law remains undisturbed. It is in the last degree improbable that the legislature would overthrow fundamental principles, infringe rights or *depart from the general system of law*, without expressing its intention with **irresistible** clearness (2 Cranch, 390); and to give any such effect to general words, simply because, in their widest and perhaps *natural* sense, they have that meaning, would be to give them *a meaning in which they were not really used*. It is, therefore, an established rule of construction that general words and phrases, however wide and comprehensive in their literal sense, must be construed as *strictly limited to the immediate objects of the act, and as not altering the general principles of the law; i. e.*, they are to be construed as near the use and reason of the prior law as may be, without violation of their obvious meaning."

Among the canons based on the preceding observations and crystallized into specific rules, is one of peculiar importance here.

IV. The Construction of Statutory Revisions.

All statutes are to be read according to their purpose. One which is to amend an existing system is so construed as to remedy the evil aimed at, but not to touch other matters. One whose object is to restate the sum of the old legislation in briefer terms but without changing it, is interpreted so as to reproduce but not to change. Whoever asserts that a law which avows one or the other of these purposes, nevertheless goes beyond it, must show that the legislature meant to do something else, and knew that it was doing it; and he must show it by pointing out in the statute itself explicit and positive statements to the precise point he asserts. Few rules of interpretation are so stringent as these, and few rest on such strong foundations of both reason and authority. Let us examine them.

Construction of Amendatory Acts. It is a general proposition that a statute is to be construed with reference to the main purpose of the legislature: broadly enough to attain that purpose, but very closely and very strictly when any attempt is made to carry its effect outside of that purpose. Thus an amendatory statute is to be read in

view of the older law and of the defect to be remedied; and it will change it or engraft a new feature on it within what appears to be clearly the aim of the legislature; but this court has resolutely refused to allow any effect beyond that. *Siemens* v. *Sellers*, 123 U. S. 276, just stated, is a good example of this. Coke's rule (p. 13, *supra*), is a time-honored statement of it.

Saxonville Mills v. *Russell*, 116 U. S. 13, 21. "The whole system must be regarded in each alteration, and no disturbance allowed of existing legislative rules of general application beyond the *clear intention* of congress."

Endlich, Interp. Stats., § 73. "The words of a statute are to be understood in the sense in which they best harmonize with the subject of the enactment and the object which the legislature has in view. Their meaning is found, not so much in a strictly grammatical or etymological propriety of language, nor even in its popular use, as in the subject or in *the occasion on which they are used, and the object to be attained.*"

See other authorities on pp. 15, 16, 18–21, 31, *supra*.

People v. *Utica Ins. Co.*, 15 J. R. 358, 380. "That in construing a statute, the intention of the legislature is a fit and proper subject of inquiry, is too well settled to admit of dispute. That intention, however, is to be collected from the act itself, and other acts *in pari materia*. It may not, however, be amiss to state and keep in view some of the established and well-settled rules on this subject. Such construction ought to be put upon a statute as may best answer the intention which the makers had in view. And *this intention is sometimes to be collected from the cause or necessity of making the statute, and sometimes from other circumstances;* and whenever such intention can be discovered, it ought to be followed with reason and discretion, in the construction of the statute, *although such construction seem contrary to the letter of the statute.*" *

These rules apply peculiarly to the patent law, because the very essence of it is that it is a just, consistent and philosophical system. It was made so and has remained so chiefly because this court has always construed and applied the statute so as to make it so.

* Of course a legislative intention must be distinguished from an individual hope. The legislature determines upon a certain policy of customs taxation. One man votes for it in the hope that it will help the industries of the country; another because he fancies it will improve the chances of his party at the next election; another for another reason. But that does not prevent the court from discovering the legislative intent and being governed by it. *Murdock* v. *Memphis*, p. 93, *infra*.

Now, the legislation we are considering was, in its origin, and always has been, *supplementary* legislation, engrafted upon a general and ancient system, in order to remedy what congress thought was a defect or short-coming of the system without it. It cannot therefore be allowed to have any operation beyond the cases affected by that defect; and every possible question as to a further scope must be resolved against it.

Moreover, while *we* say that being such supplementary legislation it is not to be construed to go beyond the known need, the *defendants* assert that it is *destructive* legislation; that it curtails, that is, in fact destroys in whole or in part, the right which had been given by the general clauses of all the laws as they had existed from the beginning in 1790. Whoever asserts such an effect, and asserts it for a section which on its face purports to be an *enabling* and *granting* section, must show *unmistakably* that congress so intended.

Construction of Statutory Revisions. There is one class of legislation, peculiar to this country, or rather which has received its greatest extension in this country, to which a somewhat similar rule of limitation by general aim and purpose has been specially and most vigorously applied — we mean statutory revisions.

From time to time every American legislature undertakes to consolidate thirty or forty years of legislation into a single volume. To do this, the statutes *in pari materia* must be brought together; but this involves more than the clerical labor of copying them on consecutive pages. Some have been repealed; some have been superseded in part only, or modified in part only; additions have been made from time to time; in this process of cumulative legislation, discrepancies or virtual contradictions creep in. To consolidate such laws requires re-writing, in which, with every desire to retain the old language, some new arrangement of sentences or change of phraseology is almost essential.

To restate without omission and without change really requires, however, the painstaking and patient labor of an editor, instead of that consideration of t he wisdom of changing which is the function of a legislator. Accordingly, the practice is universal to commit this work to a non-legislative commission, with directions to reproduce existing legislation, but to introduce no change. Their work is gen-

erally submitted to a legislative committee, and is voted by the legislature itself; but, in the nature of things, the labor of the commission is not repeated, and the fidelity of the individual revisers to their function of reproduction without change, is relied on.

From the nature of this kind of legislation, indeed from the necessity of the case, and as the only means of making a revision speak the real will of the legislature, has arisen the universal rule that the "*revision*" *so prepared and enacted is presumed to be a reproduction*. It is, of course, competent for the legislature to introduce changes. But changes of language, as they are generally necessary for a consolidated restatement of the old law, are not considered any indication of an intent to change the substance, *unless* the court is satisfied that the legislature realized that the change of words worked a change of effect, contemplated that change and actively intended it; *unless* it finds the new statute, taken altogether, so "plain and unequivocal" as to "demonstrate that intention beyond a doubt." *Canan* v. *Pound Mfg. Co.*, 23 Bl. 173; 23 Fed. R. 185; C. D. 1885, p. 207 (WALLACE, J., 1885), approved in *Bate* v. *Hammond*, 129 U. S. 151, 169.

In *Taylor* v. *Delancy*, 2 Caines' Ca. 149, the court, *per* SPENCER, J. said:

"Where the law, antecedently to the revision was settled, either by clear expressions in the statutes or adjudications on them, the mere change of phraseology shall not be deemed or construed a change of the law, unless such phraseology *evidently purports an intention* in the legislature to work a change."

KENT, who had approved this in *Yates'* case, cited both in 1 Kent, *468, n, saying that a change of language in a revision "without a palpable design to depart, ought not to be considered as a departure," and, with his usual sagacity, he attributed those changes to the mania of revisers for giving a new dress to an old thing. This power of construction, he said, must always be a part of a judicial system (p. 88, *infra*).

Crosswell v. *Crane*, 7 Barb. (N. Y.) 195, states the rule pithily:

"In a revision of the laws a reform of the language is not necessarily an alteration of the law. The *intent* of the legislature to alter the law

must be evident, or the *intent* of the new act must be such as *palpably* to require a different construction, before the courts will hold the law changed, upon such revision, merely from the fact of a change of the language employed."

In *Gwathmay* v. *Clisby*, 24 Blatch. 398; 31 Fed. Rep. 220 [1887], WALLACE, J., quoted from the Supreme Court of Alabama (*Landford* v. *Dunklin*, 71 Ala. 609):

"No rule of statutory construction rests upon better reasoning than that, in the revision of statutes, alteration of phraseology, or the omission or admission of words, will not necessarily change the operation or construction of former statutes. The language of the statute as revised, or the legislative intent to change the former statute, must be clear before it can be pronounced that there is a change in such statute in construction and operation."

Other authorities on the subject of revision are collected on p. 87, *infra*.

In short, a "revision" is not a reversal. It does not make a new edifice of a different style; it repairs the old and preserves its identity of conception.

This rule has been universally approved for three quarters of a century. Sixty years ago KENT declared that it was then a "settled rule." Legislators vote for revisions which no member can examine in detail, because they know that this rule will repair all oversights; and a statement in the title of a statute that it is a "revision" or "consolidation" is a legislative direction to the courts to apply this rule of interpretation.

A most prolific and well recognized source of error in revisions arises from the **attempt to generalize or omit full statements in order to condense** various successive enactments into one sentence or one paragraph. When the question at bar was before BRADLEY, J. at the circuit, he said of it:

"The great trouble with the section is the evident attempt of the compilers or revisers to abridge the language, to shorten the words of the enactment, and in so doing they have introduced a great deal of uncertainty Now look at this: 'No person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by

reason of its having been first patented or caused to be patented in a foreign country.' See how very general that is. 'First patented': first patented before what? It is so general *that no one can read it without seeing that it is at least doubtful what it does refer to.* There is the difficulty of the whole thing. The generality has introduced ambiguity." (*Stenographic report*, pp. 349, 350; p. 4, *supra*.)

Endlich, s. 26. "Many [words and phrases] admit of indefinite extension or restriction, according to the subject to which they relate and the scope and object in contemplation. They may convey faithfully enough all that was intended, and yet comprise also much that was not." (Cf. pp. 15, 16, 19, 21, 31, 33, *supra*, and p. 106–8, *infra*.)

But it is a cardinal doctrine, that the slips of the revisers never change the old law unless the intent of the legislature to change is manifest. *This rule has been invariably and most rigorously applied where revisers, in their efforts to condense*, have reproduced the principal clause couched in general language, and omitted a specially defining clause, — a most usual and a most frequent defect in "revisions." *In spite of such an omission, the revision is always held to mean the same as the old law*, though if it were a new statute, the general words, without the omitted phrases, would have a broader meaning. *Other* elements of interpretation may, of course, be strong enough to show a specific intent to change. But if the limitation in the old was in accordance with the whole line of legal thought (as here), the rule of the preservation of the old meaning is absolute. General words are constantly restricted even in *original* legislation (references just given). And in revisional, or even supplementary legislation, the omission of an ancient qualification is not an affirmation that there shall be none.

Murdock v. *Memphis*, 20 Wall. 590, 667 (p. 93, *infra*). "But if congress, or the framers of the bill, had a clear purpose to enact affirmatively that the court *should* consider the class of errors which that clause [the old law] forbade, nothing hindered that they should say so in positive terms; and, in reversing the policy of the government from its foundation in one of the most important subjects on which that body could act, it is reasonably to be expected that congress would use plain, unmistakable language, in giving expression to such intention.

"There is, therefore, no sufficient reason for holding that congress, by

repealing or omitting this restrictive clause, intended to enact affirmatively the thing which that clause had prohibited."

Other instance of the application of this rule are *Bloomer* v. *McQuewan*, p. 28, *supra*, and the following, *infra: Myer* v. *Car Co.*, p. 40; *Taylor* v. *Delancy*, *Yates' Case*, p. 87; *Goodell* v. *Jackson*, p. 88; *Theriat* v. *Hart*, p. 90; *Croswell* v. *Crane*, p. 90; *Murdock* v. *Memphis*, p. 93.

We do not mean that the presumption is that a revision introduces *no* changes whatever. On the contrary, as its function is to harmonize and consolidate, *details* which vary in successive statutes must receive modification. But that the revision changes such details, which it is its very duty to change, has no tendency to show that the legislature intended to alter the general plan or system which it was the special office of the revision to reproduce. Thus it often happens that successive statutes *in pari materia* have employed, now one and now another detail, as means for effecting one general and unchanged purpose. Revisers cannot perpetuate all these; and they must choose that particular detail which best speaks the sound sense of the legislature on the subject, or best accords with its general purpose. The real question, therefore, we agree, is not whether the revision before us introduces some change, but whether, on our opponents' reading, it introduces a change of plan, as distinguished from a choice among old means of still carrying out the old plan. Now the fact is — and **this is of the gist of our argugument** — that **the defendants' reading introduces** not a change of detail or of more or less, but **a change in that which was the keynote of the whole plan**; and so utterly overturns both its objects and the good sense on which it was founded.*

These rules for the construction of revisions have often been applied by this court.

In *U. S.* v. *Bowen*, 100 U. S. 508, and in *Myer* v. *Car Co.*,

*This court has pointed out that, even in legislation which is not revisory, changes of detail do not imply an intent to change the plan (p. 9, *supra*).

It has also been pointed out that the introduction of an exact definition where the old statute was *recognized* to be obscure is one of the functions of a revision (pp. 94, 100, *infra*). But that is not the case here.

102 U. S. 11, it cited the usual leading cases, and declared the rule undoubted and well established.

In *Bowen's* case, it appeared that the statute which created the Soldiers' Home required all regular army soldiers to contribute to it by stoppages from their pay during their whole enlistment, and gave them its benefits without further charge. It also provided, in another section, that volunteers who had not so contributed, might have its benefits upon assigning to the Home their invalid pensions during residence there. A later army appropriation bill contained language which declared that "*all*" occupants should transfer their pensions. R. S. 4814 and 4820 copied the provisions of the *original* act which established the Home. Bowen, a regular army soldier, who had contributed by stoppages, refused to transfer his pension. The court held that he need not. It approved the rule of construction and the authorities we have quoted, but pointed out the clear justice of the distinction which the R. S. made; and rested its view, not upon the meaning of a single word, but upon the whole frame work of the chapter, one section of which gave the right to previous contributors without transfer of pension, while another gave it to non-contributors upon transfer of pension; and the court pointed out how "appropriate" this was.

Obviously the case was a clear one under the rules we have referred to and which the court approved. The meaning which the court gave to the revised statutes attributed to the revisers exactly what revisers ought to do. An *explicit* provision in the act which established the Home and under which it was carried on, gave the benefit to regular army soldiers and made their "stoppages" full payment, while another section extended the benefits to those "who may *not* have contributed to the funds of the institution . . . upon transferring his pension," etc. The provision in the later appropriation bill, which seemed to require double payment from the regular army soldier, was very unjust; was probably passed in forgetfulness of the distinction; and might, indeed, have been limited by the court according to principles of *Myer* v. *Car Co.* and *Siemens* v. *Sellers*. The revisers, in reproducing the entire act establishing and regulating the Home, simply obeyed the statute which ordered them to "reconcile the contradictions of the original text."

No one could doubt that their result exactly spoke what ought to have been, and what was, the intent of Congress.

In *Myer* v. *Car Co.*, an Iowa codification gave a certain right to "*any* creditor or purchaser" as against certain transfers not recorded and not accompanied by a change of possession. There was certainly no obscurity in the *language*. But the earlier statute contained a clause which limited its scope to attaching or judgment creditors, and the court so limited the revised statute, though the limiting clause was omitted in the revision.

Our opponents have intimated that the court put that limited construction upon the revised statute under consideration, by reason of a limiting clause in its title: it did no such thing, because there was no such clause in its title. The *original* act had a title which imported a limitation, and this court put the narrower meaning on the *original* act because of the presence of that title. The *revised* code did not contain that title at all, nor its words, nor any equivalent for them. The court limited it *because it was a revision, although the limiting words were omitted.**

The statute we have to deal with is a "Revision" of the most technical sort. St. June 27, 1866 (printed in full in appendix to this brief), created a commission and ordered it "to revise, simplify, arrange, and consolidate" the existing laws. They were directed "in per-

*A similar rule has been applied in the construction of statutes which were not "revisions" but were, in terms, amendments. That is to say, words of an amending statute, in themselves neither equivocal nor obscure, have been so construed by the court as to effect the main purpose for which the section was designed, and to have no effect in altering the plan and policy of the previous legislation *in pari materia*, unless it was clear that Congress, with its attention specifically directed to the subject, expressly intended to do so. See p. 37, *supra*; p. 93, *infra*; also *Siemens* v. *Sellers*, p. 32, *supra*, and *Bloomer* v. *McQuewan*, p. 34, *supra*.

The court is disposed to apply to statutes which, whether revisions or amendments, are engrafted on to an older system something of the spirit o the common sense rule of *Carroll* v. *Carroll*, 16 How. 275, 287, that the words of an opinion are of little weight beyond where there appears to have been "an application of the judicial mind to the precise question" with an intent to fix the rights of the parties upon the exact point.

forming this duty" to bring together the laws *in pari materia* "omitting redundant or obsolete enactments, and making such alteration as may be necessary to reconcile the contradictions, supply the omissions, and amend the imperfections of the original text" — that is, to harmonize details without any change of substance; adding side-notes "with references to the original text from which each section is compiled." The consolidation of the patent statutes, prepared by this commission in 1869, was reported to congress in advance of the rest of their work and, with some amendments specially distinguished as amendments and not affecting the question at issue, became St. 1870. The commissioners afterwards somewhat recast the language of their work, and, so recast, it became the Revised Statutes. The section in question is s. 25 of St. 1870, and R. S. 4887. These two sections differ in language, even in the very clauses we have to consider. But it is settled that they have the same meaning.*

The revisers' work of 1870† was laid before the revision committee and the patent committees of the House and the Senate, and those committees reported to congress that the bill which became St. 1870, was, except in certain particulars specifically pointed out and not here material, "a restatement of the old law"; "the law as it now is." *The language of the section so far as concerns us*, both in St. 1870, and in the R. S., is *the language of the revising commissioners*, and is the language as to which this report was so made. The clause we have to deal with was thus reported both by the revising commissioners and by the congressional committees, to be a

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* "This provision (St. 1870, s. 25) is substantially carried forward into R. S. § 4887." *Siemens* v. *Sellers*, 123 U. S. 276.

"There is no practical difference in the phraseology of R. S. 4887 and that of s. 25, St. 1870, from which the section is reproduced." WALLACE, J., in *Edison El. Light Co.* v. *U. S. El. Light Co.*, 35 Fed. R. 134; C. D. 1888, p. 437.

The defendants' brief below (p. 4) said: "confessedly, s. 4887 did not alter the law as expressed in the corresponding portions of the act of 1870. No new provision was introduced by the revision. As was stated by Judge Wallace" — repeating the quotation just given.

† "The act of 1870, which was a revision of all previous laws relating to patents,—" *Siemens* v. *Sellers*, 123 U. S. 276, 284.

restatement of the pre-existing law; and congress accepted and enacted it as such.

Now the old law, from 1836, *to* 1870 (contained in two statutes, 1836,1839), *worked no curtailment unless the foreign patent preceded the domestic application.* The revisers drew their section by copying into one paragraph phrases taken from each of the two statutes they were to consolidate. *We* read the new clause as working no change in the plan or substance of the old law; and we point to the careful use of old phrases as fortifying our view. But the infringers say that the new *collocation given to the old phrases*, in the effort to restate the two old laws in one sentence (for the revisers wrote it in 1870 as one sentence, unbroken by a single period) has introduced in legal effect, a totally new meaning.

V. Legislation on the Subject of Patenting here and Abroad; its Plan and how it is to be Construed.

Established rules for the construction of the Patent Act. Its opening sections enact that

(4886) any person who has made a new invention "not known or used by others in this country and not patented or described in any printed publication in this or any foreign country before his invention or discovery thereof, and not in public use or on sale for more than two years prior to his application" and not abandoned, may obtain a patent therefor;

(4884). "Every patent shall contain . . . *a grant for the term of seventeen years*, of the exclusive right to make, use, and vend the invention or discovery throughout the United States and the Territories thereof."

Mr. Bate, on the day when he filed his application, came within that definition, in fact and law, and was, on that day, in the words of s. 4893, "justly entitled under the law" to such a patent. He received and his assignees now hold such a patent, containing such a grant for seventeen years. That he was so entitled on the day when he filed that application is admitted by the pleas, and was long ago settled in his favor (*Bate Co.* v. *Hammond*, 129 U. S. 151). The defendants want to use his discovery without paying for it, during the term which his patent recites, and which the main clause of the act fixes in language which applies to all patents. They rely on an

alleged exception which they say takes his case out of the general rule so enacted; and it is therefore important to know whether the law is astute to lay hold of and enlarge exceptions in order to defeat this general and equal right, or whether the general rule is to prevail unless the exception be made out by the letter and by the spirit of the act, within the principles stated on pp. 15–21, 28, 33, *supra*.

The general rule is against exceptions.

United States vs. *Dickson*, 15 Pet. 141, 165 [*per* STORY, J.] "In short, a proviso carves special exceptions only out of the enacting clause; and those who set up any such exception, must establish it as being within the words as well as within the reason thereof."

But, especially, under the patent law, the infringer who relies on a forfeiture of the inventor's right once accrued must clearly make out his case.

Courts are certainly to hold a just and even hand between the patentee who demands protection, and members of the public who wish to use without payment; but, so this court has often laid down the rule, they are to remember, when reading the patent act, that its direct object was not to prevent monopolies, but to create them and to make them profitable. And, therefore, the statute has always been construed by this court so as not to abridge the full monopoly of the inventor in that which he had first created, unless he had put himself in the wrong by contravening some clear policy or prohibition of the statute.

In *Butterworth* v. *Hoe*, 112 U. S. 50, this court had to determine the meaning of some portions of the statute. It did this by inquiring whether the construction given by the court below was in conformity with the whole patent system; and as a basis for that inquiry it re-formulated the well-known proposition that, while that system was created for the public welfare, its plan for attaining the public welfare was to make it profitable for individuals to create inventions and to introduce them. It said (p. 59):

"The general object of that system is to execute the intention of that clause of the Constitution, Art. 1, VIII., which confers upon congress the power 'to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their

respective writings and discoveries.' The legislation based on this provision regards *the right of property in the inventor as the medium* of the public advantage derived from his invention."

In *Grant* v. *Raymond*, 6 Pet. 218, this court, by MARSHALL, C. J., after referring to the purpose of the constitution to deal honorably with promoters of the progress of useful arts, which it declared to be the "interest and policy of every enlightened government," pointed out that the means which the constitution adopted for the promotion of the arts was "by securing to inventors the exclusive right to their discoveries." The *direct* object of the law is to provide the specific means for progress described by the constitution, that is to secure to the inventor an exclusive right. "It cannot be doubted that the settled purpose of the United States has ever been, and continues to be, to confer on the authors of useful inventions an exclusive right in their inventions for the time mentioned in their patent" (p. 241).

From this statement, the broad truth of which has always been accepted, the court deduced *the rule of construction* (p. 242):

"The laws which are passed to give effect to this purpose ought, we think, to be construed in the spirit in which they have been made; and to execute the contract fairly on the part of the United States, where the full benefit has been actually received, if this can be done without transcending the intention of the statute, or countenancing acts which are fraudulent or may prove mischievous."

This fundamental principle has often been concretely applied to questions of construction in the sense we have indicated.

Topliff v. *Topliff*, 145 U. S. 156, 171. "The object of the patent law is to secure to inventors a monopoly of what they have actually invented or discovered, and it ought not to be defeated by a too strict and technical adherence to the letter of the statute, or by the application of artificial rules of construction."*

* *U. S.* vs. *Denver Ry*, 150 U. S. 1. A general offer, made by statute, as an inducement to any individual who will undertake it, to do something which the public desires to have done, is not a bounty, nor a private grant, and is to be liberally construed.

Refrigerating Mach. Co. v. *Featherstone*, 147 U. S. 209. In this latest case the Chief Justice reiterates the time-honored rule for construing the statute laid down by his predecessor:

"In view of these considerations, as the language of the statute admits of a construction which, in sustaining the grant, effectuates *the settled policy of the government in favor of inventors*, our judgment is that that construction should be adopted," etc.

"We are to remember that it is to be assumed that James Boyle had made a useful invention and taken all the necessary steps to secure the benefits to be derived therefrom, and that in view of the policy of the government to encourage genius and promote the progress of the useful arts, by securing to the inventor a fair and reasonable remuneration, a liberal construction in favor of those who claim under him must be adopted in the solution of the principal question before us."*

The Plan and the Policy of Congress on the subject of Patenting an invention both Here and Abroad.

The causes which gave rise to this legislation, the defects which preceded it, the remedy which it applied, and the purposes which it intended to effect, and those which it did not intend to effect, can plainly be read in the successive acts and the decisions which expounded them. We fortunately also have a full explanation of the whole matter, given by Judge GRIER in 1853, accompanied with a description of the practice which existed at least as early as 1838, and the reasons of that practice.

It is for the good of the inventor to get the profits of a foreign patent. Such a patent also increases the stimulus to make and to perfect inventions, and it costs our people nothing. Patenting abroad, therefore, comes directly within the purpose and policy of the patent law. So far as its direct effect on individual members of the public is concerned, its tendency is also useful; because manufacturers who pay royalty for the use of the invention here, find it advantageous that their foreign competitors, who can learn the invention from the United States patent, are likewise to be put under the burden of paying for it. The right to patent abroad, therefore,

* This authority, which is of special importance in a more specific aspect, is fully stated on p. 116, *infra*.

is not a grudged concession; it is not even a burden imposed on the public; it is a right given to the inventor with the desire that he shall use it.

Of course a statute which merely enables the inventor to patent in both countries does not necessarily put the foreign user under royalty, because the inventor may patent here and not abroad. But the patent law throughout is based on the assumption that when it has enabled the inventor to reap a profit by doing what it wants to have done, he will usually do it. It so acts in this instance, by a law which enables him to patent here and abroad with convenience and without injury — *if our reading of it is the true one*. A statute, however, which attached an injury or a serious risk of injury to taking out patents in two countries would directly discourage the practice and would thereby directly hurt the inventor; and, so far as any purpose to equalize royalty here and abroad might be concerned, its tendency would be directly against that purpose. Such a statute would not be an enabling, but, practically, a disabling act, for both purposes.

We do not believe that a desire to secure general equalization of royalties here and abroad was thought of as a general purpose or policy. What congress directly intended was to enable our inventors to reap the benefits of foreign patenting, and to invite foreign inventors to our shores; the curtailing provisions had a specific and definite object which we shall presently state. But our opponents have suggested that equalization in the subjection to royalties is a *main* object of the provision in controversy; we have therefore pointed out that *our* reading of the statute, which facilitates patenting in two countries, tends towards such equalization in the only mode in which our laws can effect it, and that our opponents' reading, which directly discourages foreign patenting, directly tends against putting foreigners under royalty to American inventions. On this subject see also pp., 47–8 *infra*.

The whole plan of our legislation before the revision of 1870 (the meaning of which revision is what is here in question) *was to afford convenient facilities for such patenting without risk of injury or curtailment, and* thereby encourage it. It curtailed the United States patent only in case the inventor was guilty of deliberate delays,

totally unnecessary on his part, and specifically mischievous in their effects on the public. It worked out this policy by a definite and well-ordered plan, which is, in substance, the only one possible. Its workings were explained and its wisdom praised in *O'Reilly* v. *Morse*. Our reading of the "revision" continues this plan; our opponents' reading utterly reverses it.

The Working Plan. In *all* foreign countries (except so far as partially modified by very recent legislation) the law always has been that any publication in that country, even of the inventor's own invention, as by a United States patent, or even through a newspaper reporter who had heard of it, will vitiate the patent, if such publication be made a single day before application. The foreign application *must*, therefore, be very prompt. In England and the other principal countries, moreover, as they have no examination system, time only for formal routine work is needed, and the patent is required by law or practice to issue within six months after application. The inventor, therefore, *cannot* postpone either his date of foreign application nor his date of foreign issue. Any plan established by *our* laws to permit or facilitate patenting both here and abroad must enable the inventor to conform to those foreign conditions without injury and *without serious risk of injury* to his American patent; otherwise it will not be a law to facilitate, but a law to prevent or discourage foreign patenting.

No better illustration of the danger of even slight delay abroad can be given than the following statement from the brief of Mr. Lowrey in the *Pohl* case before the Supreme Court:

"It is well known that Mr. Edison's invention of the high resistance filamentary incandescent lamp — an invention which has, perhaps, suffered more perils of law in various countries than any other invention ever made — reached the British Patent Office only a few days before the arrival of a complete printed description in the New York *Herald*, and that, within six days after, a complete claim for the same invention was filed in the British Patent Office by Mr. Swan, who had, indeed, been engaged upon similar studies, but like others, had failed to hit upon the principle of high resistance until he saw it set out in the *Herald* article — an unauthorized and unexpected publication. Mr. Edison escaped, therefore, by only six days, the loss of his English patent."

Other inventors have been less fortunate. *Bell's* foreign telephone patents were held invalid except as to some slight details of his instruments, because of the speedy publication of his own work before he applied abroad. *Morse* went abroad to take out foreign patents five weeks after filing his American application. The danger was then so well known that he had the American grant suspended until he could get his foreign patents. But he was too late — or his invention too great; an English patent was refused him, because his own invention had got published in an English magazine before his arrival (p. 64, *infra*). *The greater the invention, the greater is this danger.* **The necessity of the promptest application abroad** was therefore well recognized as far back as 1838, and a practice had even then grown up in consequence of it.

The inventor can file his American application as early as he pleases, and if our law required our patent office to issue the patent within a certain time after application, the inventor could control the date of the American *grant*. But such is not the case. Ever since statute 1836 an examination system has been one of the distinctive and most cherished features of our law. More than six months is habitually occupied by officials in that examination. A glance at the *Official Gazette* shows that less than one quarter of our patents issue within six months. If, therefore, an inventor applies here the day after his invention, and then sends a copy of his specification abroad for a foreign application, the inevitable result of the system established by the patent act itself is that in three cases out of four the foreign patent comes out before the American patent. The inventor cannot help this. If he delays his foreign application he risks the loss of his foreign patent. Nor can he hasten his American issue. The long pendency here is the *inevitable result of the time taken to do the work the patent act requires.*

Unless patenting in two countries is to be prevented by law — and no one pretends that the law wishes to prevent it — promptness in the *application* is all that either country can require of the inventor, and it is all that he has the power to bring about; for the matter then is in the hands of the public officials, and the public, through them, controls the question of delay. Early *pendency* or simultaneous pendency (which would be the ideal of fairness if all countries

equally desired promptness) is due to the act of the inventor in filing the applications and may fairly be required of him; but it is all that depends upon *his* act; date of issue the law controls, not he; and therefore simultaneous pendency is the most that can be asked of him. He *cannot* give more, and public policy cannot ask more from *him*.

The case at bar affords a good illustration of office delays.

Mr. Bate applied here on Dec. 1, 1876. His application appears to have been erroneously rejected by the examiner, requiring an appeal to the board of examiners in chief. Then, as another inventor claimed the same invention, R. S. 4904 *obliged* Mr. Bate to go into an interference contest. It was only after his victory in this that his patent could issue; it came on Nov. 20, 1877. But in England, where he applied Jan. 29, 1877, two months after his application here, his patent was sealed July 13, 1877, four months before our law could give him his American patent.

And now, because *our law* compelled this vigilant inventor, who applied first in his own country, to wait a year for his patent, because, in other words, the *public* (who made the law, and appointed and controlled the officers who administered it) consumed a year in making the examination, it is said that the same public is entitled to confiscate the four best years of his patent. The public promised him a seventeen-year patent if he would make and would disclose his invention; when he applied he was entitled to such a patent; for seven months afterwards his right to it confessedly remained unimpaired; it is now said that the public shall reap the benefit of his invention and disclosure, and shall find *in its own delay* in performing its promise an excuse for breaking it.

A sharp sense of wrong will justly rankle in the breast of an inventor so treated. Nor does the law look with tolerance on such conduct. In *Grant* v. *Raymond*, 6 Pet. 218, upon a suggestion that the public had a just right to avoid a patent on account of the mistake of its own officers, the court (*per* MARSHALL, C. J.) said: "The attempt would be disreputable in an individual, and a court of equity might interpose to restrain him."

Now the proposition of the other side is that a statute which was in terms enacted as a "revision" and reproduction of the old law, shall, by force of a mere change of phraseology, in the attempt of

the revisers to condense two paragraphs into one, create this wrong from which the old law about foreign patenting was absolutely free; by making the curtailment, which under the old law arose only in consequence of a delay by *him* in *asking* for the patent, depend now upon the delay by the public officers, after it is asked for, in granting it. Laws are not made to perpetrate such wrongs, but to prevent them; and no court will find, in what is at most a careless condensation of language, an intent to work such an evil.

Such delays as Mr. Bate has suffered from are not, be it observed, abnormal and accidental. They are a necessary and a usual part of the system created or perpetuated by the statute of which the section in controversy forms a part. The court, when it reads this section to interpret it, knows of these delays and the results from them. They were publicly known, indeed announced by this court in Morse's case in 1853, long before the law in question was created, and it was then pointed out that the law had carefully guarded against wrong from this cause by making the curtailment of patents depend upon date of *application* and not upon date of *issue* (*Morse's case*, quoted p. 67, *infra*). If the section *plainly* means what our opponents say it plainly means, then those who wrote it must have intended this iniquity. We know they did not. If such a meaning can be found in the words, it is a meaning so obscure that it escaped those who wrote the statute, and those who voted for it.

It is obvious that if Mr. Bate's American patent is to be curtailed because its date of *issue* is after the foreign grant, he suffers from the act of the law; from the act of the public; from no act on his part which can be called a fault; — because carrying his invention to foreign patent offices after he has brought it to ours, is in no sense wrong, nor forbidden, nor injurious to our people, — and in spite of every vigilance of his own. Not to speak again of the injustice of such a condition of things, it is clear that a law which so treats the inventor is not a law which facilitates, but a law which discourages foreign patenting. If, on the other hand, his patent is curtailed only when and because he delays his *application* here, he need not suffer at all, and if he does, it will only be for his own fault.

The penalty, where it attaches, is a very severe one. The American patent, instead of being for seventeen years from its own date, is

cut down to fourteen years or less from the earlier foreign date.* The loss is of at least three and a half, and usually more, of the last years of the patent, which are by far the most valuable. The risk of curtailing the American patent is so great and the amount of the injury risked is so great that inventors are greatly discouraged.

The *intolerable* situation thus depicted is one which confronts American inventors every day of every week of every year. According to the hostile construction, it presents a practically insurmountable difficulty and an insoluble dilemma. Whichever way the meritorious inventor turns a shadow of disaster impends above him. Every day some inventor elects to forfeit all prospect of obtaining valid foreign patents that he may conserve his interests in this country under the present hostile construction; and every day other inventors, having felt compelled to take the risk of applying abroad by reason of facts which would make delay disastrous, are at last distressed and damnified by finding that their foreign patents have been granted first, and that, according to the hostile construction, *they have forfeited the very best years of their American grant.*

It is true that by a concert of action between the solicitor here and the solicitor abroad, and by an ingenious use of the cable, patents are now sometimes taken out in several countries without curtailment. But whether this device succeeds in any given case is a matter which the inventor can neither control nor know in advance; and it constantly fails in spite of his utmost care.†

The utter absurdity of our opponents' reading is obvious, however

* English patents, which of course are the most frequent, are for *fourteen* years from *application*. On the continent many patents are taken for five years, and none are granted for more than fifteen.

† One mode sometimes resorted to is to prosecute the patent here until "allowed." Then the final fee is withheld and the "issue" thus suspended, which, by s. 4885, the applicant can do for six months; he uses this time to start his foreign proceedings; and as soon as they are started he pays his fee and takes out his American patent before the foreign one issues. That is, he tries to do this; but he risks absolute destruction of his foreign patent by premature publication of his own invention (and the more remarkable it is, the more likely to be thus published and destroyed for him) or by its publication by a patent to a later "inventor" abroad; and he risks his American patent, because if before the actual issue of his

the matter be looked at. A British patent is granted for fourteen years. If the British patent is granted one day after the American patent for the same invention, the latter lasts seventeen years. If the British patent is granted one day before the American patent, then, according to the hostile construction, the American patent is for so much less than fourteen years. What public end is secured by making three years of American monopoly depend upon two days of chance delay — delay which may be due to the mere overburden or the sluggishness of the clerk who writes out the patent, or the public printer who prints it? The discrimination is utterly senseless.

But if the date of American *application* be the critical date, that is to say, if the law says to the inventor: when you have applied here with due promptitude — and it will be purely your own fault if you do not — you may, after that, patent abroad, and your rights will not be impaired by the delays imposed by our system; — then the law will afford him all reasonable convenience; and will punish him only for his own unnecessary delay.

It is apparent, therefore, that the question whether date of American *application* or date of American *issue* shall be the critical date to determine whether curtailment is inflicted or not, is not a question of mere detail, nor a question of more or less; it is a question between encouraging and discouraging; and a question between justice and injustice. **It goes to the very gist of the matter.**

Moreover, no results in the slightest degree beneficial to the public, and no known or suggested policy, wise or unwise, is *promoted*

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patent any interfering application is made — whether in good faith or through malevolence — the commissioner *must* put him into interference (*Ex parte Hunt*, Com'r's Dec., 1878, p. 149. *Lawrence's case*, C. D. 1879, p. 346. *Ex parte Osgood*, C. D. 1885, p. 113), and then his American patent is delayed and curtailed.

Moreover, whenever an interference is declared, the invention is disclosed to the adversary, and described in printed depositions, and usually the specification is printed. If the foreign application is delayed, the adversary has merely to send abroad a copy of the printed book to prevent a foreign patent. If the foreign application has been filed, an American patent delayed by an interference here is sure to come out last. These are only some examples of the troubles encountered.

by change from the old law, which fixed upon the date of American application, to our opponents' reading of the present act, which takes the date of American issue as the criterion of curtailment. On the contrary, a well-recognized and sensible public policy — to encourage patenting abroad — is thereby reversed. If their view be accepted the legislature has both stultified itself and committed a gross wrong.

In *Pennock* v. *Dialogue*, 2 Pet. 1, 23, the court (*per* STORY, J.) summed up the strength of the argument in favor of the construction it put upon the statute, in words which exactly fit the construction we contend for here, and exclude our opponents':

"No public policy is overlooked, and no injury can ordinarily occur to the first inventor, which is not, in some sort, the result of his own laches or voluntary inaction."

The Legislation before 1870 Facilitated Foreign Patenting by the following well-arranged plan.

From the origin of our patent law the first inventor could forfeit his right by various acts which constituted a public disclosure *before application*. But, from the outset, as more fully explained on p. 105, *infra*, there never was a state of the law such that acts done *after* the application was filed could impair his right. The application once in the office, the inventor, without injury, might publish or even put his invention into public use, — acts which if done the day *before* he applied would be fatal.

It was therefore always the law that a patent taken out abroad *after application* here, — even during the pendency of that application, that is, before the American *issue*, — did not bar the right to obtain the American patent. Under this power English patents were quite extensively taken by American inventors, long before the initiation of the legislation we have to consider. *Fessenden on Patents* [1822] pp. 41, 166, mentions that it is a frequent practice for American inventors to take English patents, and he therefore devotes considerable space to stating the English law.

A difficulty arose, however, when, as often happened, especially with foreigners, the foreign patent *preceded* the American application. That was held a bar to obtaining an American patent.

The special legislation we are considering was initiated in 1836. Its object was not to cover the entire subject of patenting the same invention both here and abroad. Inventions had long been so patented under the *general* provisions which St. 1836 reproduced and indeed perhaps enlarged. *Its purpose was to remove the bar just stated;* to enable those who had *afterwards* taken foreign patents to apply for American patents; and therefore, those persons only were within its scope; all others were already provided for. Congress showed that it took exactly this view of the situation by the form of the act, which was that of an "*un-barring*" act. "Nothing in this act contained shall be construed to deprive the inventor", "No person shall be debarred," by reason of a foreign patent, is the language of the statutes of 1836 and 1839.

Let us make sure that the law was accepted to be what we have stated.

There has never been a pretence that publicity *after* application had any effect; and the statute is perfectly clear.

All the courts agreed that any public *use* before *application* was fatal. As to whether *publication alone* before application without public *use* was fatal, the *circuit* courts were not entirely agreed; *this* court expressed the opinion that it was fatal. St. 1800, also, in terms, provided that any knowledge or any use *abroad* before application would be fatal to an *alien;* and this court pointedly declared that the same effect must be given to St. 1793, under which, up to 1836, all patents to *citizens* were granted.* Thus:

Pennock v. *Dialogue*, 2 Pet. 1, 22 [*per* STORY, J., 1829]. St. 1793 required that the invention shall be "not *known or used* before the application." In that case, there had been use before application; but, substantially, throughout the opinion, the court classes knowledge and use together; and it refers to the decisions of the English courts which made both equally fatal. In fact, the opinion quotes

* Undoubtedly the old prohibition against applying here *after* a foreign patent, troubled foreigners more than it did our citizens, and it was doubtless expected that the relieving act would chiefly help them, would invite them to our shores. It has been strongly argued that the whole provision is limited to foreigners; there is much force in the argument, but it has not seemed to us the strongest ground on which to put the case.

the provision of St. 1800* about aliens, and says that St. 1793 which controlled citizens must be taken as having the same meaning (p. 22):

"This proviso [of 1800] certainly certifies the construction of the act of 1793, already asserted; for there is not any reason to suppose that the legislature intended to confer on aliens privileges essentially different from those belonging to citizens. On the contrary, the enacting clause of the act of 1800 purports to put both on the same footing, and the proviso seems added as a gloss or explanation of the original act."

Shaw v. *Cooper*, 7 Pet. 292 [1833]. The patentee was a resident alien. The court below quoted the proviso of 1800 and ruled (p. 313) "that there was nothing in the act confining such use to the United States, and that if the invention was previously *known* in England or in France," [the case turning not on priority of invention but on forfeiture by subsequent voluntary publicity] "it was sufficient to avoid the patent under that act." The Supreme Court affirmed this. It referred to St. 1793 and St. 1800 and said (p. 316):

"It would seem, from the above provisions, that citizens and aliens, as to patent rights, are placed substantially upon the same ground. In *either* case, if the invention was *known* or used by the public before it was patented, the patent is void. In *both* cases, the right must be tested by the same rule."

Phillips on *Patents*, p. 179 [1837], states this as the accepted law.

O'Reilly v. *Morse*, 15 How. 62 [1853] quoted more fully p. 64, *infra*. Justice GRIER'S opinion contains a valuable historical statement. It says that under the general provisions of St. 1793 a foreign patent *after* application here was not a bar, but a foreign patent *before* application here was a bar.

The general sections of St. 1836 (§§ 6, 7) were also accepted by the learned judge as having the same effect, for he refers the right

* St. 1800, s. 1. "*Provided that*" the applicant must make oath *in the petition* that the invention "hath not, to the best of his or her knowledge or belief, been **known** or used either in this *or any foreign country*," and "every patent which shall be obtained pursuant to this act, for any invention, art or discovery which it shall afterwards appear had been *known* or used *previous to such application* for a patent shall be utterly void."

to patent in the latter case, even under St. 1836, not to its general sections, but to a *gift* made by a special provision, identified with § 8, — the foreign patent section. He says (p. 127):

"By the Patent Act of 1793, the applicant must swear 'that his invention, was not *known* or used *before the application*.' The *filing of the application* was the time fixed for determining the applicant's right to a patent. *If a patent had issued abroad*, or the invention had been in use or described in some public work, *before* that *time*, it was a good defence to it. The time of filing the application was, therefore, made by law the criterion of his right to claim as first inventor. *A foreign patent subsequent to the date of his application, could not be set up as a defence against the domestic patentee.* The American inventor who had filed his application and specification at home, was thus enabled to obtain his patent abroad, without endangering his patent at home. This was a valuable privilege to American citizens, and one of which he has never been deprived by subsequent legislation. And thus the law stood till the act of 4th July, 1836."

The change then made, he says, was to *increase* the cases in which patents could be obtained without in any way diminishing the rights hitherto enjoyed.

"Accordingly it [St. 1836] *gave* an inventor who had obtained a patent abroad and who was generally a foreigner, a right to have one here, provided he made his application here within six months after the date of his foreign patent" [that is the provision of s. 8]. "Neither the letter nor the spirit of this act interferes with the right of an inventor who has filed his application here from obtaining a patent abroad, or his right to a term of fourteen years from the date of his patent."

Siemens v. *Sellers*, 123 U. S. 276, 284, lays down the same rule. In St. 1836, ss. 6, 7, were the *general* clauses stating the qualifications for a patent; s. 8 was the relieving clause, the first original of the one we have to deal with. The court held that the purpose and effect of this was to relieve against *this* disability.

"By the same act [1836] (s. 7) if an invention for which a patent was sought had been patented in a foreign country, before the application for a patent here, it was a bar to obtaining a patent in this country, unless (s. 8) such foreign letters patent had been taken out by the applicant himself within six months previous to the filing of his specification and drawings. The act of 1839, s. 6, removed the limitation of six months, and allowed a patent to be taken out here at any time after the inventor had taken out a

patent for the same invention in a foreign country, provided it should not have been introduced into public and common use in the United States prior to the application for a patent here: '*And provided also*, that in all cases every such patent shall be limited to the term of fourteen years from the date or publication of such foreign letters patent.'"

We need not inquire whether, if pushed to it, this court would or would not *to-day* hold that a foreign patent before application here would be fatal. Such was the law up to 1836, specifically; and it was commonly *accepted* that the law would be the same under the general clauses of St. 1836.* Two learned judges of this court, in giving an historical *résumé* of the statutes, have declared that a foreign patent before application here would have been equally fatal under those general clauses (s. 6, 7) of 1836; and that the legislation we are considering was introduced by s. 8 of 1836 expressly to relieve just those cases. The form of that legislation — "Nothing in this act contained shall be construed to deprive," etc.; "No person shall be debarred," etc. — assumes that such was the law, and we must therefore read it with that assumption.

The result of this judicial history is that long before 1870 it was recognized and understood that **the sole subject matter** of this supplementary and relieving legislation was American patents the *applications for which were filed after the foreign grant*. They constituted its sole subject-matter, not merely because the statutes of 1836 and 1839 specified application date in its description of the subject-matter, but for the higher reason that it was relieving legislation, and there were no other cases to be relieved. Because (and there-

* A foreign patent was, of course, a disclosure, and a voluntary disclosure abroad, and, as it was a public document, it was a publication to the world and for all countries, and therefore might well be held fatal if before application here.

In *Gandy* v. *Belting Co.*, 143 U. S. 587, p. 20, *supra*, deciding that *use* abroad was not a bar, this court relied on the distinction which has existed ever since St. 1836, that *use* abroad has not that element of *universa* publicity which arises from a patent or a printed publication abroad.

St. 1836 assumed that, under general provisions, knowledge or use abroad stood on the same footing as knowledge and use here. It first introduced the idea that they should *not* always have the same effect, and this was recognized at the time as an innovation (5 Op. Att'y Gen. 21). This

fore), as Judge GRIER expressly put it, patents granted by virtue of the other and general provisions of the law were outside of its scope and were not affected by it.

This legislation was therefor for the purpose of making *patenting here and abroad*, by both citizens and aliens (who by the general clauses of s. 6, 7 were put on the same footing as citizens except as to fees) a **part of the policy of the system**; it made it so by the provision we are considering; and *the legislation to secure this grew out of this old condition of the law* which made a foreign patent a bar when, *but only when*, it preceded the American application.

A clause, however, which took away the bar due to a foreign patent, if the provision stopped there, led to the risk of a public mischief; for it would permit a man who had made his invention publicly known by a foreign patent, to take his American patent an indefinite time afterwards, *at his pleasure*, subject only to defeat by the vague and then little-used doctrine of abandonment; and the bar of abandonment could hardly be based upon a foreign patent, in face of a statute which enacted that such a patent should not be a bar.* The two cases just cited and others at the circuit show also a strong feeling by the court, probably a reflex of public sentiment, against any delay in applying, particularly by aliens. To guard against opening the door to such delays, wilful and unnecessary on the part of inventors and mischievous to the public, another clause was added to the one just quoted, limiting its benefits to the case where the foreign patent was taken out and published "within six months next preceding the filing of his specification and drawings." Thus, if the inventor filed his application here within

was done by special provisions, first introduced in St. 1836 by s. 16, and by s. 6 (the one now under consideration). In *Gandy's case* the court relied on these very provisions as the basis for the distinction, *which enlarged the right of the inventor*.

It is, we submit, impossible to argue that one of these enactments gave to a lawful foreign act — taking out a patent — an effect injurious to the inventor when that act had never before impaired his right.

* The doctrine of abandonment was first suggested by Judge STORY in *Whittemore* v. *Cutter*, 1 Gall. 478. In *Pennock* v. *Dialogue* [1829], he again suggested it. It is not found in any statute prior to St. 1839, s. 7, where it appears rather incidentally.

six months after his foreign patent, — the filing was his own act, its date was entirely under his own control, and the time allowed did not require any inconvenient diligence,— his foreign patent in no way affected his American one.*

The law thus enacted is as follows:

St. 1836, s. 8. "But nothing in this act contained shall be construed to deprive an original and true inventor of the right to a patent for his invention, by reason of his having previously taken out letters patent therefor, in a foreign country, and the same having been published, at any time within six months next preceding the filing of his specification and drawings."

St. 1839 still further liberalized the patent law. Its sections 6, 7, both deal with the subject of delay by inventors in patenting their inventions; but both deal with it by punishing delay in the *application*, not delay in the grant; thus again recognizing that the *application* date was the only one which the inventor could control, or for delay in which he ought to suffer; and that the date of application was the moment as of which his rights were fixed.

When congress enacted this statute of 1839, it desired to go beyond St. 1836, and to open the door to *all* those who had taken foreign patents. But it saw, as it had seen in 1836, the mischiefs which might result from delays by inventors if no safeguards were provided. Tardy applicants might exploit their inventions for years abroad, and patent here after their inventions had already entered into our industries; they could thus also by means of such deliberate delay deter our manufacturers from starting by the apprehension of a future patent, and keep them under royalty long after foreign competitors were free. There was no such risk if the American application was before the foreign patent: the possibility of that danger arose only when a *new* provision conferred the *new* right to postpone the American application until *after* the foreign patent.

St. 1836 had guarded against this by giving the new right only to those who applied within six months after the foreign grant. But, in 1839, congress had thought of a better plan; a plan which would

*These provisos show that at this time special attention was paid to the subject of delay; and that it was seen that *the proper requirement was to ensure promptness in the* application.

allow patents to *all*, and yet prevent the abuse of that right and the consequent mischiefs. The new legislative device for that purpose was that those who had overrun the very liberal allowance of time granted by St. 1836, and who still wished to patent here, might do so, but that such deliberate and unnecessary delay on their part should be at their own expense; for in such case the fourteen-years term should run as from the date of the foreign patent. It also provided that they could not have a patent at all if their inventions had been introduced into public and common use in the United States prior to the application for such patent.* The act is as follows:

St. 1839, s. 6. "No person shall be debarred from receiving a patent for any invention or discovery, as provided in the Act of July 5, 1836, to which this is additional, by reason of the same having been patented in a foreign country *more* than six months prior to his application: *Provided*, That the same shall not have been introduced into public and common use in the United States, prior to the application for such patent: *And provided, also*, That in all cases every such patent shall be limited to the term of fourteen years from the date or publication of such foreign letters patent."†

HOLT, *Commissioner*, in 1858 (quoted by FISHER, C., in C. D. 1869, pp. 62, 63), explained that the object of the limitations in the two statutes was to guard against abuse from *unnecessary* delay, by limiting the time for application in the one case and the duration of the patent in the other. He said that congress considered the delay of six months under St. 1836, "as too small a fraction of time

* It has been held that St. 1839 does not supersede St. 1836; that the two are cumulative. That is to say, those who apply *within* the six months come under St. 1836 and suffer no curtailment. This penalty attaches only to the wilfully tardy class, who delay beyond that limit, and therefore have to invoke the aid of St. 1839. In other words, the curtailing proviso of this statute applies only to those patents which rest upon the benefit of its granting clause. *This was settled before the enactment of* 1870. It was explained by HOLT, C. in 1858,; and in *Ex parte Cochran*, FISHER, C., C. D. 1869, p 60, quoting HOLT, C.: and by *Kendrick* v. *Emmons* [SHEPLEY, J.], 2 B. & A. 208. Also by GRIER, J., in Morse's case, in 1853 (p 65, *supra*).

† There is a verbal difference in one phrase common to the provisions of 1836 and 1839. The first says, — "*within* six months next preceding the filing of his specification and drawings" and the second says, — "*more*

to require its [the limitation's] introduction . . . while, *to guard against abuse if the period were longer*, the inclusion of the whole might be consistently and properly exacted." This curtailment was not the object of the act; it was introduced only to guard against an abuse of the right the statute conferred.

This curtailing provision did not, in terms or in law, distinguish between citizens and aliens, but from its nature, as was well understood, it bore chiefly on foreigners;* *because* Americans conveniently could, and naturally would, *apply* here before taking their foreign patents. But the American would not naturally *obtain his patent* here before he did abroad; for that depended on the length of pendency of his application, and St. 1836, which inaugurated the examination system, including "interferences" and appeals to the courts, contemplated that the pendency would always be rather long and might be very long; the inventor could not its control length.

But *Morse's* case puts this matter beyond debate.

In *O'Reilly* v. *Morse*, 15 How. 62, a question arose under St. 1839. Morse applied here for his first telegraph patent. Then he had the proceedings suspended, went abroad and took his foreign patents, then came home and prosecuted his case here and got his domestic patent, which was in terms for fourteen years from its own date. Two questions arose: this statute required that patents granted under it "shall be *limited* to the term of fourteen years from the date or publication of such foreign letters patent." It was insisted for the

than six months prior to his application." "Application" and "the filing of his specification" mean the same thing. This is evident from the statutes themselves, which have always been held to be the complements of each other.

In fact, from the very earliest times, a "specification" was embodied in, or, rather, annexed to, the petition. In *Hogg* v. *Emerson*, 6 How. 436, 481, careful inquiry was made as to the practice, and the court described it, saying that the *petition* did not usually contain a description of the invention, "but, the specification being filed at the same time and often on the same paper, it seems to have been regarded, whether specifically named in the petition or not, as a part of it."

* "Accordingly it gave an inventor, who had obtained a patent abroad, and *who was generally a foreigner*, a right to have one here," etc. 15 How. 127. See note to p. 54, *supra*.

defendant that a grant under that statute must be, *in words*, for the limited period; because a grant for the usual full term would be *ultra vires*, and would, moreover, put into the patentee's hands a false show of title and an instrument of fraud; and so, if Morse's case came within the statute, his patent was void *ab initio*. Now, it was insisted that the paper filed by him in 1838 could not be considered a legal application because, so it was alleged, they did not contain all that the law required; and, apparently, it was urged that the long suspension had broken the continuity. If the paper of 1838 was to be regarded as *the* application, then his application was before the foreign patent; otherwise not.

McLean, J., at the circuit, and Grier, J., in this court, held that if the case was within the statute the grant was void. The circuit courts held that Morse's application took the late date; Judge Grier held that it got the benefit of the earlier date. The majority of this court construed the statute not to require the limitation to be expressed in the grant, and, as the suit was brought before even the limited period had run, it did not pass upon the question of date, — then, as always, construing this law so as to avoid a forfeiture.

The part of that case which is important in the present connection is the historical statement found in the opinion drawn by Grier, J.* It pointed out that long pendency in our patent office was the inevitable and the natural result of our system; that the invention must be kept secret *here* to avoid the risk of spoiling a foreign patent by premature publication; that, but for the special provisions, a foreign patent would bar a subsequent *application* here; that the *general* provisions *already* enabled an inventor when once he had *applied* here to take a foreign patent without affecting his American patent, which was Morse's case; that it was because *application* date was the criterion that the inventor could obtain a patent abroad without endangering his patent at home; that this was a right

* All the judges agreed in sustaining the patent. The minority thought it proper to decide that the foreign patentee clauses did not touch Morse at all. The majority said that the patent was good whether those clauses touched it or not. The general statement in Judge Grier's opinion concerned matters within his own knowledge and experience; he was forty-two years old in 1836. There was no difference as to *these* matters.

valuable to Americans, of which the law had never deprived them because it did not wish to discourage patenting in both countries.

Specifically, the opinion showed that a foreign patent *after application* was *not* a bar, but one before application here was a bar. It was only the latter class, therefore, which had a bar to be removed; and the legislation which removed it was confined to them alone.

It follows from this, so the opinion points out, that *those* cases — the *tardy application* cases — constitute the *sole subject-matter* of all this remedial legislation; and that the cases where the foreign patent was *after* the American application, and where, therefore, the right to patent existed under the general clauses of the previous sections, were outside of the spirit and purpose as well as of the letter of this special remedial section, formed no part of its subject-matter, and, consequently, were not touched either by its enabling or by its curtailing clauses.*

GRIER, J., 15 How. 126: "In many instances, owing to various causes, the patent is not issued till many months, and sometimes a year or more after the application. The Commissioner requires time to examine the specification; he may suggest difficulties and amendments; and disputes often arise which delay the issuing of the patent. But the application does not require to be renewed, and

* The other cases on the Morse patent are in line with the foregoing.

Smith v. *Ely*, 5 McLean, 76, 78. In this case the date of the early suspended application did not appear, and Judge MCLEAN treated the patent as applied for after the French patent. He recognized that date of *application* governed. He quoted St. 1836, 8, and said of it, "This limits *the right of application* by a foreign patentee to six months from the date of his foreign patent."

French v. *Rogers*, 1 Fish. 133 GRIER and KANE, JJ., Nov. 1851], says that "all the provisions of both sections [1836 and 1839] relate only to such patents as were applied for here after the issue of a foreign patent."

So also *The Morse & Bain Telegraph case*, 9 West. Law J., 106[1851].

So the opinion of Commissioner HOLT, p. 60, *supra*, which shows that the curtailing provision was only to guard against abuse of the right given by the enacting clause, limits the curtailment *by the nature of the provision* to the cases where the new right was conferred.

is never considered abandoned in consequence of such delay. It still remains as of the date of its filing for every purpose beneficial to the applicant."

"There is nothing in the act of congress which requires that the patent should be issued within any given time after the application is filed, or which forbids the postponement of it for a time, at the suggestion either of the applicant or the officer. Nor is there anything in the general policy of the patent law which forbids it. On the contrary, *it has always been the practice, when a foreign patent is desired, to delay the issuing of the patent here, after application filed, for fear of injuring such foreign application.* **It forms no part of the policy of any of our patent acts to prevent our citizens from obtaining patents abroad.***

"By the patent act of 1793, the applicant must swear 'that his invention was not known or used before the application.' The filing of the application was the time fixed for determining the applicant's right to a patent. If a patent had issued abroad, or the invention had been in use or described in some public work, before that time, it was a good defence to it. The time of filing the application was, therefore, made by law the criterion of his right to claim as first inventor. *A foreign patent subsequent to the date of his application could not be set up as a defence against the domestic patentee.* The American inventor who had filed his application and specification at home was thus enabled to obtain his patent abroad, without endangering his patent at home. This was a valuable privilege to American citizens, and one of which he has never been deprived by subsequent legislation. And thus the law stood till the act of 4th July, 1836.

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* That taking out an American patent endangered a subsequent application abroad, had *long* been known and had given rise to the practice stated. In 1838, Morse went abroad to take out his foreign patents, and just before starting he wrote to the commissioner (15 How. 78):

"May I ask the favor of you to delay issuing the letters patent until you hear from me in Europe, as I fear issuing them here will at present interfere with my plans abroad."

Morse learned the danger more sharply a few weeks later. England refused him a patent because his own invention had been described in the "London Magazine" (*ib*). He was just in time in France.

"Before this time the right to obtain a patent was confined to American citizens, or those who had filed their intentions to become such. The policy of this act was to encourage foreign inventors to introduce their inventions to this country, but in doing so *it evinces no intention of limiting our citizens by taking away from them rights which they had hitherto enjoyed.*

"Accordingly it gave an inventor, who had obtained a patent abroad, and who was generally a foreigner, a right to have one here, provided he made his application here within six months after the date of his foreign patent. *Neither the letter nor the spirit of this act interferes with the right of an inventor who has filed his application here, from obtaining a patent abroad, or his right to a term of fourteen years, from the date of his patent.*

"In 1838, therefore, when complainant filed his application, he was entitled to such a patent. But in March, 1839, an act was passed, by the sixth section of which it is alleged the complainant's rights have been affected. That section is as follows:

"'That no person shall be debarred from receiving a patent for any invention, etc., as provided in the act of 4th July, 1836, to which this is additional, by reason of the same having been patented in a foreign country, more than six months prior to his application. *Provided*, that the same shall not have been introduced into public and common use in the United States prior to the application for such patent. And provided, also, that in all cases, every such patent shall be limited to the term of fourteen years from the date of publication of such foreign letters patent.'

"Now the act of 1836, as we have shown, *had given a privilege* to foreign patentees to have a patent within six months after date of such foreign patent. It had not affected, in any manner, the right previously enjoyed by American citizens, to take out a foreign patent after filing their applications here. *This section gives additional rights* to those who had first taken out patents abroad, and holding out an additional encouragement to foreign inventors to introduce their inventions here, subject to certain conditions contained in the proviso. Neither the letter, spirit nor policy of this act have any reference to, or bearing upon, the case of persons who had just made their applications here. *To construe a proviso, as applicable to a class of cases not within its enacting clause, would*

violate all settled rules of construction. The office of a proviso is either to except something from the enacting clause, or to exclude some possible ground of misinterpretation, or *to state a condition to which the privilege granted by the section shall be subjected.*

"Here the proviso is inserted to restrain the general words of the section, and *impose a condition on those who accept the privileges granted by the section.* It enlarged the privileges of foreign patentees, which had before been confined to six months, on two conditions. 1st. Provided the invention patented abroad had not been introduced into public use here; and 2d. on condition that every such patent should be limited in its terms. The general words, "in all cases," especially when restrained to every such patent, cannot extend the conditions of the proviso beyond such cases as are the subject-matter of legislation in the section. The policy and spirit of the act are to grant privileges to a certain class of persons which they did not enjoy before; to encourage the introduction of foreign inventions and discoveries, and not to deprive our own citizens of a right heretofore enjoyed, or to affect an entirely different class of cases, when the applications had been filed here before a patent obtained abroad.*

"It is supposed that certain evils might arise by allowing an applicant for a patent here to delay its issue till he can obtain a foreign patent. To which it is a sufficient answer to say, that if such evil consequences should be found to exist, it is for congress to remedy them by legislation."†

Two things are thus apparent:

1. The plan and the policy was to encourage patenting both here and abroad; the law gave ample facilities for this; the legislation in question was for the express purpose of promoting it by giving additional facilities; curtailment was only to guard against abusive

* Similar statements are found in the other Morse cases just cited.

† As pointed out on p. 85, *infra*, congress, in 1861, took up the subject of delays, abolished that right of suspension which Morse had used, and which, under the mail facilities of 1861, had become quite unnecessary, and very much restricted other delays. But what it chose to do about delays it did by express legislation on that exact topic.

delays in the use of those *new* facilities, by urging the inventor to promptness in that act which was the only one *he* could control, and which no one else could control. This plan was workable and just, because the application date was the critical date.

2. Under the *general* provisions, a foreign patent after the American application did not bar the later American grant. The *special* legislation we are concerned with had for **its sole subject matter** cases where the American patent was barred because the foreign patent was prior to the American *application*. The granting clause touched those cases alone, and there were no others to be touched; the curtailing proviso touched them alone, because a proviso is a relative clause, the subject matter of which is defined by its legal antecedent, the granting clause.

We have gone through with the practical workings of this legislation before 1870 and with its judicial history, not in order to show that it touches only such American patents as are *applied* for here after the foreign grant, for Sts. 1836 and 1839 are clear on this point, and the matter is not disputed. What we wished to do was to put it beyond discussion that that division line between what is included and what is not included within the scope of the legislation we are studying is not an arbitrary division, but is a division of *principle*, growing out of the nature of our system, and out of a leading characteristic of it: that it is a division on which the legislation was based, because all the defect to be remedied is, in the nature of things, confined to the class of patents which lie on one side of it and cannot be found on the other, and is, therefore, a division which is to *govern* the court in construing that legislation; and that it is a division which, when adhered to, makes the law wise and just, and when departed from, absurd and unjust.

That such was the true character, scope, reach, purpose and **subject matter** of that legislation is not a fancy evolved by us today to help this case. It is indeed apparent from a study of the legislation itself: but it is also clear that such were in *fact* its scope and moving purpose, to be read in the reports of this court forty years ago, and long before and always since, down to 1870, universally recognized and acted upon. And therefore, not only does that division exist but

it was, from the beginning of this legislation, *known*, and was **in fact the basis** of and therefore the key to the interpretation of all this legislation, and explains it all.

In *Murdock* v. *Memphis*, 20 Wall. 590, p. 93, *infra*, the court held that a limitation expressed in terms in the judiciary act of 1789, must be read with the act of 1869, although that act in fact omitted it. It reached this conclusion from the greatness of the change in our distribution of judicial powers which a literal reading would bring about, and pointed out as an additional argument that the *consequences* of the change would have been evident to congress. It said (p. 629):

"It is impossible to believe that congress intended this result; equally impossible to believe that they did not see it would follow if they intended," etc.

Such is the legislation *in pari materia* which the law orders us to look at. If we were construing amendments to it, the most explicit statements would be required before the court would given even amendments a wider scope, or let them touch any subject matter other than that class of patents which gave rise to this legislation and which alone called for it.

But here the question is whether a "revision" of the law has preserved the old plan, policy, and just effect, as *we* say it has, or has made a new law which discards and reverses the old and introduces all the folly and wrong which we have rehearsed, as our opponents read it; and has accomplished that by rejecting *application* date, the universal test of forfeiture from the origin of our patent law, and introducing *issue* date, a criterion foreign to the whole thought of our system.

Or, looking at the matter in the terms of Lord COKE's rule, that is, construing remedial legislation in the light of the mischief to be remedied: shall we read this provision as including, together with those cases which called for the remedy, other cases which needed no remedy, were entirely outside of its purpose, and had never been included within its scope?

Now, upon *our* construction of St. 1870 and R. S., this plan and this policy are preserved.

But the defendants insist that certain changes of wording in the revision of 1870 and in the Revised Statutes have upturned and reversed the whole of it.

The question before the court is whether such **radical changes of substance** *are worked by mere changes of phraseology in a "revission," or rather by a mere rearrangement of old phrases, themselves carefully copied from the old laws, which is found in the condensed revision as prepared by the revising commissioners and enacted by congress.*

The established canon is that the court must find the clearest intent to make this change (pp. 35, 40, *supra;* pp. 87–104, *infra*). Now, it is absolutely certain, from public documents, that congress did not intend to make a change, and that it enacted the revision of 1870, copied in substance in the Revised Statutes — for it is settled and not disputed that they mean the same (p. 41, *supra*) — in the firm belief that the revision made no change, and *because* it so believed.

A comparison of St. 1870, s. 25, and R. S. 4887 illustrates the nature of revisional changes. The commissioners of 1870 condensed two sections of 161 words into one sentence of 106 words. Their successors stretched the 106 words of 1870 to 121 in 1874, and caused the printer to break the one sentence of 1870 into two by changing "provided" to "unless" and "But," and putting a period after "application" instead of a comma. The phrases of 1874 are mostly those of 1870; but one change was introduced; St. 1870 was written that "the patent shall expire at the same time," etc. R. S. says that the patent "shall *be so limited as to* expire." For a verbal critic the argument was very strong that the introduction of the words in italics required the patent itself to be limited, and in *Bate* v. *Gillett*, 13 Fed. R. 553, NIXON, J., so held. But this court at once disregarded that suggestion (*Bate* v. *Hammond*, 129 U. S. 167) and, throughout, the two sections have been held to mean the same (p. 41, *supra*). More than half the sections of the patent act in R. S. contain verbal changes from St. 1870. It savors more of vanity than of wisdom to make such changes, and these commissioners seem to have been rather bitten by a mania for them; but the courts never permit, and under the patent act never have permitted, the literary taste of the revisers to overturn the law of the land.

V. The Congressional History of St. 1870 and the Revised Statutes.

The commissioners appointed under St. 1866 to prepare the revised statutes, acting with the House committee on the revision, had, by the beginning of 1870, completed the chapter about the patent and copyright law. The general committee was then, by vote of the House, discharged from this part, which was referred to the committee on patents. That committee also had received many petitions for amendments and gave full public hearings on the subject. As the result of their deliberations, they found and reported to the House two things: *first*, that the "revision" prepared by the commissioners was a true consolidated re-statement of the existing law, which was what the commissioners were directed by law to make; *second*, that certain *changes* were, in their opinion, desirable. So they reported, in print, the "revision" drawn by the commissioners, and added to each section the changes they proposed; but in each case, by a typographical arrangement (italics and brackets), they showed what was the commissioners' revision and what were the committee's amendments; and because of this double character of the paper (H. R. 1714; printer's No. 719; 41st. Congr. 2nd Session, April 7, 1870) they entitled it "A Bill to revise, consolidate, and amend the Statutes relating to Patents and Copyrights." But while it was a bill to amend as well as to revise, they distinguished, in the mode already stated, between what was technical revision and consolidation, and what was amendment; they informed congress that both they and the general committee on revision vouched for the "revision" as an accurate reproduction of the existing law without change, and that congress therefore need not even read that part, but might safely confine its attention to the features and passages which were pointed out by the printed document as amendments.

Now the point of all this is that the language we have to construe is the language of the commissioners' revision. It is thus strictly within the rules about revisions; and moreover it is part of the statute which the commissioners, the general committee on revision and

the patent committee reported and vouched for as a true "revision" and not an alteration of the law.

On April 14, 1870, Mr. JENCKES, of Rhode Island, a very eminent patent-law lawyer, and chairman of the committee on patents, reported the matter to the House. The printed report consisted of the bill arranged as stated, bearing at its head the words, "*Strike out the parts within* [brackets] *and insert the parts in italics.*" These were the committee's proposed changes; but the document without these changes was the "revision" of the commissioners.

The section in controversy appears in that report as follows:

"No person shall be debarred from receiving a patent for his invention or discovery by reason of his having first patented it in a foreign country; provided the same shall not have been introduced into public [and common] use in the United States prior to the application, and that the patent shall [be limited to seventeen years from the date or publication of the foreign patent] *expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term, but in no case shall be in force more than seventeen years.*"

"Foreign [patents] *inventions* may be patented. 4 July, 1836, c. 357, § 8; v. 5. pp. 120, 121. 3 March, 1839, c. 88, § 6; v. 5, p. 354. 5 McLean, 78, 80. 15 How. 112.

That is to say, the commissioners' revision was the roman print, disregarding the brackets. That is what was reported as a true revision; and the first clause of that, down to the semi-colon (with one change not material and presently to be stated), is the exact language which constitutes the first clause of St. 1870 and R. S. 4887 and which we have to interpret.

COM'R'S REPORT.	ST. JULY 8, 1870, § 25.
No person shall be debarred from receiving a patent for his invention or discovery by reason of his having first patented it in a foreign country;	No person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, by reason of its having been first patented or caused to be patented in a foreign country;
provided the same shall not have been introduced into public and common use in the U. S. prior to the application and that the patent shall be limited, etc. . . .	*provided* the same shall not have been introduced into public use in the U. S. for more than two years prior to the application, and that the patent shall expire. . . .

The following is taken from the *Congr. Globe*, 41 Congr. 2d sess., part 3, vol. 90, p. 2679, April 14, 1870:

"Mr. JENCKES, from the Committee on Patents, reported back with amendments, and with the recommendation that it do pass, the bill (H. R. No. 1714) to revise, consolidate, and amend the statutes relating to patents and copyrights.

"*Mr. Jenckes.* Mr. Speaker, if the House will indulge me I think they will obtain a sufficient idea of what is proposed by this bill, from a statement in explanation of its provisions without reading it in full.

"The bill now reported from the Committee on Patents is based upon the revision of the laws relating to patents and copyrights made by the commissioners of revision appointed under the statute authorizing a revision of the laws of the United States. That revisal of these particular statutes was reported to this House early in this Congress and referred by the House to the Committee on the Revision of the Laws of the United States. *It was examined by that committee and was found to embody all the provisions of* existing *law, in brief, clear, and precise language.* They subsequently reported it to the House, and recommended that it be referred to the Committee on Patents.

"In prospect of this proposed revision the Committee on Patents had already received numerous communications from those interested in the subject, and also numerous bills and petitions that had been filed in the House and referred to that committee, proposing various amendments to the existing laws. They had taken all these into consideration and invited the presence of persons interested in the different subjects to which the amendments were intended to apply, and encouraged discussion from those interested and from those learned in this branch of the laws upon those proposed amendments. They were heard at great length, and the committee were very careful to give a hearing, either orally or by written communication, to any and every person who supposed that there were defects in the existing laws which ought to be remedied, or who could make plain and clear the practice under the laws so as to secure more perfectly the rights which these laws were intended to protect. The result of all these hearings and discussions has been the adoption *by the committee* of certain propositions of amendment to these laws, which they have embodied in the bill now before the House.

"The bill is so printed as to show the law exactly as it now is, in the form in which it came from the hands of the commissioners of revision. Every provision which is now in force has been printed at length in the bill, although it is proposed to strike out by way of amendment many of them. All those which it is proposed to strike out are printed, and the amendments, many of which are substitutes for the parts proposed to be omitted, are also printed separately, and in

italics, so that they may be clearly distinguished from the law as it now is. **The House, therefore, now have before them in the reported bill the exact state of the law,** those provisions of the law which it is recommended shall be dropped, and of the new provisions which shall be substituted in their place, and also of the minor amendments which are proposed to different parts of the bill. *It can be seen, therefore, at once what has been the law, what is the law,* in what respects the existing law is supposed to be defective, how that defect is proposed to be amended, and how the law will read if the amendment should be adopted.

"Having thus stated the history of the bill, and the state in which it is presented to the House, I will consider the general provisions of the act, without at the present time going into details."

After discussing some special phases of the law, Mr. Jenckes said:

"These are the amendments to the law of patents. There are not new nor additional provisions except in the case of the payment of the fee during the term of the patent, to keep it alive.* In other respects the law stands without any other change than that it is enlarged, defined, made clear in its terms and provisions and in its proposed execution, so that the remedies can be pursued without mistake and with effect."

In short, the report of the committee on patents and of the committee on revision was that they vouched for it that the *roman print reproduced the old law and that congress might vote for it without reading it.*

In the Senate (June 24, 1870), some amendments were made not here important. The permission for *two* years' public use without invalidity was introduced by the Senate committee in order to assimilate the foreign patentee to all other applicants, and adopted without discussion. **That enlarged liberality in favor of those who held foreign patents distinctly refutes any notion that congress at that time meant to go backwards, or to discourage patenting in two countries.** The present phraseology, "its having been patented or *caused to be patented,*" was introduced after a debate between Senators Carpenter and Thurman, specifically to preserve the meaning that although a foreign patent taken out by a stranger on the same invention would not curtail, yet one taken out by a foreign agent, in

*This was rejected by congress after debate.

his own name but on behalf of the United States inventor, was not by a stranger, and would curtail.*

In the Senate the chairman of the committee said:

"We have gone through all the matters in this bill *on the existing policy* of the Government."

Clearly, congress was not *upturning* the whole "existing policy" and plan on this subject.

In the House, nearly or quite all of the provisions introduced by the committee, except those relating merely to procedure, were rejected, and so were all other amendments of *substance* proposed in House or Senate, during the debate. The principal one was rejected in the House, upon the chairman's statement and objection that it was

"*foreign to the whole principle of this revision, and that is to destroy or impair no existing rights* but to enlarge and make clear the remedies which have heretofore been given by law."

That is, the new law even with the avowed "amendments" of the committee (because those amendments are what the chairman's phrase "enlarge and make clear" refers to) did not change the ultimate right of the inventor, but improved the mode in which it was to be established or enforced. Such in fact is its character throughout, *unless, by the hostile construction, this section be made the sole exception.*

Thus the crucial words of St. 1870 for the purposes of the question at bar, — "*first patented in a foreign country*," — and the words of R.S. 4887, "*previously patented*," which have been declared to be of identical import (p. 41, *supra*), as obviously they are, — are words selected by the revising commissioners, approved and reported by the committees of both branches, accepted and voted upon by congress in public and reported proceedings, *as working no change in the previous law.* The proposition of our opponents, therefore, is that

*The objection was rather hypercritical; "his having patented it" would, of course, cover a patent taken out by his procurement, as upon his invention, and for his use.

The Bate patent in suit was taken out in the name of Mr. Lake, an English solicitor, but expressed to be on a communication from Mr. Bate. Such has always been the English practice; and this is what the Senate referred to.

a statute which is known from its history and from its contents, and declared by its title, to be a revision and a codification, without change of plan or policy; declared to be such and accepted as such upon the public records, and, at the instant of voting; shall be read as introducing an entire change of policy, passing from a plan which was wise, just and sensible, to one of gross injustice to the inventor, and of absolute folly from every point of view.

Now, no revision has ever been so construed. No precedent for such a construction can anywhere be found.

The Court may properly refer to this legislative history. Our opponents, of course, see the overwhelming weight of these facts, and therefore urge that the court should pretend to be technically ignorant of them. But that is not the law, for several reasons.

1. We are not dealing with an original and new enactment, but with a *revision*. When we read the authorities on p. 35, *supra*, and pp. 87–97, *infra*, and see how stringent the rule is that in a revision the court must find a *clear and definite intent to change*, it is impossible to close one's eyes to this history, which is conclusive that there was no intent to change, but a most active and positive intent to preserve the old plan. It is true that, generally speaking, the opinions of an individual member of congress expressed in debate are not competent to control the meaning of a statute; because a hundred others who voted, but did not speak, may have thought it had a different meaning. But that is not this case. We are dealing with a revision; with the assertion of an implied change; and we have before us, not the utterances of individuals, but the official reports of the proper committees that no change was made; and this was accepted as correct — so well accepted that it was declared to be unnecessary to read the bill. It is the case of a revision, and of a revision which consolidated thirty-three statutes on an extremely technical subject; the report that it was a true consolidation and not new legislation was not merely the report of a general committee on a great volume in bulk, it was also the report of a special technical committee, headed by a gentleman (Mr. JENCKES, of Rhode Island) of special professional prominence in that branch of the law. Whether he and his committee had done their work well or not, congress, on such a subject and under such circumstances was

justified in relying on their report; for it could not find greater certainty elsewhere.* And what congress was justified in doing, this court is justified in knowing that it did.

In re Mew, 31 L. J., Bkcy. 89, WESTBURY, L. C., referred to his own speech introducing the bankruptcy bill which he was construing. In *Moyer* v. *Gross*, 2 Penrose & Watts (Pa.), 171, 172, GIBSON, C. J., upon a question of implied repeal by an act passed in 1812, said: "Having been a member of the Legislature in 1812, I know that no repeal was in fact contemplated." These references were to individual opinions, and not as here to an official report. In each case, indeed, other technical grounds for the decision were found; but those judges could not have decided contrary to what they knew to be the very truth of the matter. They ought not to; for all courts must feel the force of what was said by Justice FIELD in *Ah Kow* v. *Nunan*, 5 Saw. 552, 560, cited and repeated by this court in *King* v. *Gallun*, 109 U. S. 99, 101, "When we take our seats on the bench, we are not struck with blindness and forbidden to know as judges what we see as men."

The court always relies on the history of legislation, and construes each amending statute in conformity with the general intent and policy it finds in the older statutes, unless the new unequivocally shows an actual and specific intention to reverse it. Some striking examples of this, besides those already cited, are the *Pacific R. R. cases*, 91 U. S. and 99 U. S., *Andrews* v. *Hovey*, 123 U. S. 267, and more especially *Blake* v. *Banks*, 23 Wall. 307.

In *Blake* v. *Banks*, the court reviewed the condition of the law at the time when the act in question was before congress, and from that and from the proceedings in congress, it deduced a general intention of congress, and made this intent override specific words of the statute not in conformity with it. The act levied an income tax "for and during the year 1871." The court held that this covered income of 1870 as well as income of 1871.

In reaching this conclusion, which certainly forced the words far

* Mr. DAWES said, during the discussion of the bill, that he had examined it; that it seemed to him "the result of great labor." He also said: "It is a measure which the gentleman from Rhode Island is competent above all others to prepare."

more than it is even pretended we have occasion to (the opinion called them "*embarrassing words*") the court relied much on the legislative history of the particular act in question; that is to say it examined the *proceedings in congress*, in order to determine the intent with which the particular words were introduced. It looked at the *Globe*, the *reports of the committees*, traced the bill through its various amendments, its successive steps, and saw when and how the various changes were made from its first introduction to final enactment. This was not a reliance on individual views expressed in debate; it was a reliance, as in the case at bar, on what represented one house or the other as a body, on verbal acts which constituted a part of the *res gestae*. The court said (p. 319):

"Under these circumstances, we are compelled to *ascertain the legislative intention by a recurrence to the mode in which the embarrassing words were introduced*, as shown by the journal and records, and by giving such construction to the statute as we believe will carry out the intentions of congress."

Then, pointing out the consequences of the construction asked, it said, in words which perfectly fit our case:

"It is impossible to believe congress intended to make this discrimination. It is entirely unreasonable, and is not in harmony with the well-known views of congress on the subject."

In *United States* v. *Lynde*, 11 Wall. 632, this court, for the purpose of construing a statute, stated the substance of a communication by the Secretary of State to congress, quoted the report of the committee on public lands thereon (p. 640); stated the substance of another report (p. 644); and having thus ascertained the purpose and intent of the statute, it construed it accordingly. This was confirmed in *United States* v. *Morant*, 123 U. S. 335, 342.

In *Matthews* v. *Com'th*, 18 Gratt. 989, and in *State* v. *Forey*, 21 Neb. 223, 226, the court examined the original bill, and the amendments introduced, to aid in the interpretation of the statute.

2. It is the invariable rule *in construing revisions* to recur to the report of the revisers and the legislative proceedings thereon, to learn whether the words under consideration were written by the revisers and accepted by the legislature as a reproduction of the old law, or were specifially introduced as an amendment. Such instances are: *Douglass* v. *Howland*, p. 88, *infra*; *Croswell* v. *Crane*, p. 90, *infra*; *Dominick* v. *Michael*, p. 91, *infra*; *Elwood*

v. *Klock*; *The L. W. Eaton*, p. 92, *infra*; *United States* v. *Claflin*, p. 94, *infra*; *Pratt* v. *Street Com'rs*, p. 100, *infra*. When congress, by statutes, enacted that the marginal references to the old statutes and to the decisions explaining them should be appended not only to the revisers' report but to the published edition of the Revised Statutes, it recognized and gave a legislative sanction to the universal habit of the bench and the bar of recurring to these sources as the most usual guides for interpretation.

3. This history certainly shows the *possible* meaning of the words. It is asserted by our opponents, indeed it is all they seriously pretend to stand on, that the language itself is too cogent to admit of any consideration of our reading. They must go further; they must establish that the meaning for which they contend is so plain and unmistakable that congress when it enacted this revision, that is, that every reasonably intelligent man when he voted for it, must have seen *that* meaning and have intended to change the law and to enact the interpretation for which they contend. Now the revision commissioners, the general committee on revision, and the special patent committees of both branches, headed by a specialist, saw in the section *the meaning of the old law only*. One may argue that they were careless, or that the meaning they saw was not on the whole the true one, but one cannot argue that it is *impossible* for the words to bear the meaning with which intelligent jurists have used them.

VII. The Law about the Construction of Statutory "Revisions," and its precise Application to this Case.

We have already indicated the canons by which statutory revisions are to be interpreted (p. 34, *supra*); we purpose now to pursue the subject somewhat further, especially in the application of those rules to this case; and to offer a further collection of the leading authorities.

The new section, upon our reading, differs from the old only as, and exactly as, a revision should differ. Our opponents have urged that the revision test cannot be applied to this section, because,

they say, it certainly makes *some* change from the old law; and, when any change is made, the revision rule cannot determine the extent of the change. This argument has no basis in law.

That the section as prepared by the commissioners varies in some details from some of the older statutes does not make it any the less a "revision," calling for the application of the revision rule of interpretation; for it is the function of a revision in consolidating the previous statutes to harmonize their discordances of detail, without change of plan; and that is what was done here.

At the time of the revision the statutes in force about patents alone (omitting copyrights, etc.) were twenty in number, containing over one hundred sections, and many of these were long sections, embracing several subjects. The general duty of revisers, and the express terms of St. 1866 (appendix, *infra*), required their work to be "compiled" "from the original text"; but at the same time the older statutes were to be "revised, simplified, arranged and consolidated," and not reprinted in full. They brought their work into seventy short sections; upon the very matter we have to deal with, they condensed into one section of 66 words the matter contained in 69 words forming part of s.8, St. 1836, and in 99 words constituting the whole of s.6, St. 1839. Their duty and the statute also required them to omit, not only matter which had been repealed expressly or by implication, but also "redundant and obsolete provisions, and to "reconcile the contradictions of the original text."

An examination of their work shows that scarcely a section, and rarely even a whole sentence of the old, is literally copied in the revision; and yet every phrase of importance found in their work is old. In short, they showed their sedulous care to preserve the old meaning by using the old phrases, and to effect the condensation by a rearrangement of those phrases which would permit the omission of redundant expressions and repetitions, or what they thought were such, and yet enable them to use old words.

At the argument of *Bate* v. *Hammond*, at the circuit, Justice BRADLEY expressed the result which almost inevitably accompanies such attempts:

"The great trouble with the section is the evident attempt of the compilers or revisers to abridge the language — to shorten the words of the enactment; and, in so doing, they have introduced a great deal of uncertainity" (p. 36, *supra*).

We all know that the proper way to abridge or condense is for the writer to possess himself of the old thought and restate the gist of it in his own words. But "revisers" are cut off from this. Their first and cardinal rule is to use the old language. Yet they cannot use all of it, for that would be to reprint. They are therefore driven to pick out what strike them as the leading phrases of the various statutes they are to consolidate, and to make up the new section chiefly by the use of them. The putting of new cloth into an old garment is proverbially dangerous; the result is necessarily a patchwork of old phrases and connecting language of their own. The pieces are fitted with difficulty; they get into new relations; antecedents drop out; their relatives seek them in vain or get attached to the wrong ones; and then, on such accidents, some one makes exactly the argument with which we are here confronted and which we have stated on p. 10, *supra*, and p. 134, *infra*.

But that which leads to such troubles cures them. They arise from a sedulous care to repeat the old words in order to run no risk of departing from the old meaning; and that very fact is accepted by the law as the key to the legislative intent, and governs the meaning of the revision. This care, from ancient times, legal draughtsmen have resorted to as a means for reproducing the old meaning, though the draughtsman may not be sure that he understands that meaning or appreciates the force of the words; but whenever this is done it is *a declaration written, by force of those words, on the face of the statute* that the reviser who writes and the legislature which enacts a section so written mean to re-enact the old law; and, consequently, before it will reverse the old statute, where such care to reproduce has been taken, the law requires positive and explicit statements, directly in point.

If such slips could change the law, "revisions" would be impossible. It is because the law will not permit such intolerable mischief, that the rule for construing revisions has been found indispensable.

It was inevitable also that in thirty-four years of legislation and twenty acts, congress, though following a uniform plan and policy, would, from time to time, improve the details for carrying it out; and in such case the earlier provisions, though not strictly repealed by the latter, even by implication, would be "redundant," and should give way to the later and improved ones. But through such changes of detail the court readily traces a uniform plan, and treats it as a continuing policy in the interpretation of every part of the whole mass of legislation.

Converse v. *United States*, 21 How. 463, 473 [*per* TANEY, C. J.]. "It will be seen, from this history of the complicated legislation on this subject, that, however varying the provisions may be in some particulars, they are yet all founded on the principles and policy of the acts of 1822 and 1839."

Such was the case here. Both the old statutes aimed to let in foreign patentees, and both intended to guard against mischievous prolongations of the term by the inventor's delay. In 1836, congress had thought of only one way to accomplish this latter object, and that was by giving the right only to very prompt applicants; but in 1839, it had thought of a much better plan, which was to fit the punishment to the crime by making the inventor bear the cost of his own delay. But both statutes equally recognized that the delay to be punished was a delay in the only act which was the inventor's act, that is, the *application;* never putting the delay of others to the cost of the inventor.

Commissioner HOLT, in 1858, had declared (p. 60, *supra*) that both these provisions were for this same purpose, and that the difference between the two was "too small" to be regarded. The revisers, therefore, ordered to bring together and consolidate these two sections *in pari materia*, omitting redundant matter, ought to express their section so as to open the door to *all* foreign patentees (which is what the two old sections taken together did), guard against abusive delays in applying (which was what both the old did), and use for this purpose the improved device which embodied the latest wisdom of congress and was obviously the best. They could not consolidate these two sections *in pari materia* without doing so much. That they did that, does not tend to show a purpose to go outside

the strict line of "revision." Their intent to reproduce is further made certain from the careful copying of old phrases.

In fact also the six months' leeway in addition to the time of foreign pendency, which was reasonable with the European mail packet service of 1836, was totally unnecessary in 1870.

The report of the patent committee shows that they went over the whole law, for they touched most of the sections, often making verbal changes which were mere matters of literary taste. Perhaps they were not always entirely happy; but their work is everywhere good enough to reproduce the old law, under the application of the known rule that a revision on which such care to reproduce has been bestowed will be read as a reproduction of the substance unless a clear intent to change is manifest.

It is certain that those who took so much pains to copy, and who, in connection with this section, had read *O'Reilly* v. *Morse* (p. 67, *supra*), which is referred to in the revisers' and the committee's marginal note to this section (p. 71, *supra*), did not intend to change the whole plan and policy of the law, there explained, nor punish the inventor for delays which every one knew, and that case declared, habitually occurred and were without his fault.

The Marginal Notes of the Revision. St. 1866 ordered the revisers to add "side notes so drawn as to point to the contents of the text and with references to the original text *from which each section is compiled* and to the decisions of the federal courts explaining or expounding the same." The revisers did this (*v.* p. 71, *supra*); and the like notes are reproduced by express order of congress, in the authorized edition of the Revised Statutes. In *U. S.* v. *Lacher*, 134 U. S. 624, and *U. S.* v. *Averill*, 130 U. S. 335 (quoted p. 96, *infra*), this court said that the rule that the revision meant the same as "the original text from which each section was compiled" must be most strictly and vigorously applied in accordance with such references, so placed by law.

Reference to these marginal notes is always had, and congress enacted that they should be appended to the published edition *in order that they might be so used*. See the authorities, p. 77, *supra*.

No Purpose, real or alleged, is subserved by the Defendant's Reading; on the contrary, that Reading amounts to a Stultification.

It is for those who insist that a revisers' change of wording in the revision introduces a change so great, so unreasonable and unjust, to show, under Coke's rule (p. 18, *supra*), some mischief left by the old law and which the alleged new reading would remedy. Our opponents recognize this burden, but utterly fail to meet it.

There is no policy to produce a simultaneous expiration, which can influence the interpretation of the section.

Our opponents suggest that it was a general policy of congress to have our users free of royalties when foreigners were, and therefore that the court should be astute to apply and extend the curtailment. There is no such policy; nor would the defendants' reading promote it if there were. And this court has already rejected that suggestion.

1. If the inventor takes no foreign patent, and thus puts the foreigner under no royalty, he suffers no curtailment. The penalty never applies, upon either reading, unless the inventor does just that which it is suggested congress wants him to do, viz., put the foreigner under royalty. It is a stultification of congress to suggest that a statute which *punishes* the inventor when (and only when) the foreigner is put under royalty, was dictated by a desire to drive the inventor to put him under royalty. The real policy was exactly what we have stated, — to facilitate patenting here and abroad, guarding against abusive delays in the exercise of the *new* right.

2. The inventor, under our opponents' reading as well as our own, may take the seventeen-year patent here, and the next day take, abroad, a patent which in no country will be for more than fifteen years, and may be only for five years. Or he may take a fifteen-year patent abroad and let it expire at the end of a few years by non-payment of the first of the periodical fees required in all foreign countries to keep patents alive. In both cases he will have patents in two countries, but the statute, even on our opponents' reading, will have not the slightest tendency to produce simultaneous expiration.

Now it happens that this court has recently had before it, in *Pohl* v. *Brewing Co.*, 134 U. S. 381, the question whether this clause should be construed so as to promote simultaneous expiration; but

it paid not the slightest attention to that consideration in interpreting the section. The language — "*expire at the same time with the foreign patent*" — certainly expressed, upon a surface reading, the view which the would-be destroyer took in that particular case; but this court construed it in exactly the opposite sense, as follows:

The claim was that allowing the foreign patent to expire by non-payment of fees terminated the American patent. The language, just quoted, strongly leaned that way, and if simultaneous expiration was a "policy" or could give rise to an argument for construction, it must be there applied. But the court decided that such foreign expiration did not touch the American patent.

3. Moreover, our reading, which makes patenting abroad safe and easy, promotes it, while our opponents' reading discourages it. To suggest that congress in 1870 intended *their* meaning rather than ours in order to promote a policy of keeping foreigners under royalty, is therefofe to suggest that congress still further stultified itself.

Alleged "Overpayment." The defendants have also suggested that congress thought a United States patent a sufficient reward for an inventor; and, if he took a foreign patent, a full term here would be overpayment. The suggestion is absurd in itself; GRIER J., p. 64, *supra*, answers it: it is contradicted by all the statutes. St. 1836 was for the express purpose of allowing patents in several countries without curtailment. The present act also in terms allows them, curtailing them only in case of certain special delays; and in every case to which the statute applies, the longer the foreign patent, *that is, the more valuable the foreign monopoly*, the less is the curtailment. Of course, if congress had intended what our opponents allege, it would have enacted that the more valuable the foreign monopoly the *greater* the curtailment.

If congress had had such an idea it would have said that taking a foreign patent, before or after ours, should curtail it. Plainly, the purpose is not to discourage the inventor from taking a foreign patent, but *to urge him to speed in taking ours*, if he wishes to take both.

The matter has been compactly stated:

Brush v. *Accumulator Co.*, 47 Fed. R. 48, 56, COXE, J. "Why a meritorious inventor, who is a citizen of this republic, should lose his rights at home because he has tried to protect them abroad is,

on principle, not easy to comprehend. It is said the expiration of the Italian patent threw the invention into the public domain. So it did, into the domain of the Italian public, but if Mr. Brush had taken no patent in Italy the Italian public could have practised the invention from the moment it became known there. Had he taken no foreign patents his invention would have been thrown into the public domain of every land but this. In this country his inventions would have been protected for seventeen years; outside of this country they could have been used with perfect impunity. The inventor applied for his patent here long before he applied abroad, but through the delay of the Patent Office the foreign patents were issued first.

"Assuming the inventions to be similar, the inventor has been guilty of no fault, the American public has lost no rights, and yet, under the provisions of this statute, which it is thought was never intended to apply to a case like this, a valuable monopoly is destroyed."

Delay or speed in the Patent Office. It has also been suggested that congress intended the infringers' meaning as a device to urge inventors to prosecute their applications with speed in the Patent Office. That is not true, in fact; for —

1. It punishes alike one who deliberately delays after application and one who, in spite of his utmost vigilance, is detained by the necessities of his case or the faults of others, or even the sluggishness or misconduct of public officers.

2. In three cases out of four, pendency in our office is longer than in foreign offices, which shows that the lapse of time is the natural result of our system, beyond the control of the applicant.

3. The proportion of patents affected by this section upon any reading, that is, the proportion of inventions which are patented abroad as well as here, is small; and a provision which reaches only an insignificant portion of the cases to be affected is not a remedy for delay, and was not enacted for that purpose.

4. In this very act, congress laid hold of the question of delays in the office. St. 1836 allowed the applicant to suspend his application for a year; and Morse's case shows that this was done and the time used in obtaining foreign patents (pp. 63–4, *supra*). This continued to be the law until 1870. The revision commissioners repeated the provision, in s. 22 of their report of 1870, but the patent committee struck it out, calling attention to the change as an

"amendment" by printing the clause in brackets. Congress had, before this, begun to deal with the question of delays in the office by a specific course of legislation *ad hoc*. St. 1861, s. 12, enacted that an application not "completed and prepared for examination" within two years after filing should be regarded as abandoned. St. 1863, c. 102, s. 3, amended by Sts. 1864, c. 159, and 1865, c. 112, required the final fee to be paid and the patent to be taken out within six months after final allowance, with a mode of relief against accidents. St. 1870 repealed the suspension provision of 1836, re-enacted the provisions of 1861–5 just stated, and *added the further provision* that a delay of the applicant for more than two years, after "action" by the office calling for some "action" or step on his part, should constitute abandonment, unless excused as unavoidable. This was introduced and announced by the patent committee as an *amendment*, and gave rise to much debate in the House, and was enacted as part of s. 32. Congress, therefore, elaborately considering the subject of delay, carefully prepared the remedies it thought proper, placed them in sections by themselves, enacted them as amendments and made them apply, as of course they ought to, to all cases.

The gist of all these provisions was that the applicant was to be punished for long delays in those matters which were *solely his own acts*, and *where the delay was solely his own fault;* and even then he was to be relieved if the delay appeared to be unavoidable. It is absurd, in the face of this, to attempt to find in the revisers' condensation of sections on a totally different subject, a remedy for delay, which would be ridiculously inefficient; which would punish for a delay which might be only for a few days; committed by public officials, and perhaps even without personal fault on their part; and against which the commissioner had no power to relieve.

The actual desire of congress may be described as for a practically simultaneous disclosure to the patent offices of both countries; more exactly a simultaneous pendency. Only the inventor can bring *that* about, and he may justly be urged to it. That is all *he* can bring about, and it is all that is needed from *him;* for when the patent office has once got possession of the application, it will deal with it according to its own system of practice.

The "Revision" Argument is conclusive. We are dealing with a strictly revising statute. It was drawn as a strict revision, reported to congress by its own committees as a true revision, accepted and enacted as such. Throughout, it sedulously copies the old language. There is not in the revisers' whole work a single section which goes beyond the proper function of a revision or works any change of policy, of plan, or of substance. The proposition of our opponents is that this section shall be made the sole exception; that this section, declared by every official at the time to be a reproduction of the old; a section which, by the marginal note required by law, is announced as "compiled" from Sts. 1836, 1839; a section, every phrase of which is copied, part from one and part from the other of those statutes; shall overturn the plain policy and plan of the old law, known to everybody and expounded by learned judges; and, in place of it, by force of a mere rearrangement of the old phrases in the effort to condense, shall reverse the whole plan of the old law, stultify the legislature, and not only grossly injure but morally wrong the inventor.

It will be healthy to here collect some of the leading authorities on the subject of revision.

Some Authorities as to the Interpretation of Revisions:

Taylor v. *Delancy*, 2 Caines' Ca., in Err. 143 (1805). SPENCER, J., giving the opinion of the court, says: "My opinion is founded on this proposition that where the law, antecedently to the revision, was settled, either by clear expressions in the statutes or adjudications under them, the mere change of phraseology shall not be deemed or construed a change of the law, unless such phraseology *evidently* purports an intention in the legislature to work a change. A contrary construction might be productive of the most dangerous consequences."

The original statute in terms gave a certain discretionary power. The revision *omitted* this; held that the statute appeals to discretion as much as the old one did.

Yates' Case, 4 Johns. 316, 359 (1809, KENT, C. J.). "That the 'mere change of phraseology,' in the revised laws, was not to work a change in the established interpretation, was the unanimous decision of the court for the correction of errors, in 1805, in the case of Taylor *v.* Delancy (2 Caines' Ca. Error, 150, 151)."

The case was a habeas corpus under the Revised Statutes; and Yates had been imprisoned for contempt of court. The original New York act, like the English act, was limited to cases of imprisonment for crime. The R. S. *omitted* the limiting word. The court construed the statute like the old act.

Chancellor KENT again recurs to the doctrine in 1 Kent, *468, n., which is as follows:

"In *Douglass* v. *Howland*, 24 Wendell's R. 45–47, Mr. Justice COWEN has expressed himself with a justice, strength and truth, on the subject of the interpretation of statutes, worthy to be transcribed.

"We cannot," he observes, "escape the power of construction, so long as we have a judicial system. Well-known rules in the construction of statutes ought not to be departed from. *'Nor ought the new enactment to be holden a deviation from the former law, unless it be obviously so.' It is equally true of the old statutes themselves, wherein changes of some kind occur at every step in the revision. All the general acts were remodelled. An arrangement more scientific, a style improved in elegance and simplicity, were sought to be introduced throughout the whole; hence, short paragraphs, made up of short sentences, generalities, ellipses, complications, equivalent words or translations, for old and well-defined technical terms. In short, the old costume was dismissed, and that of the civil code of France adopted as nearly as could be. Yet I take it that the main substance of what we had before was always intended to be retained. The revision was mainly a re-enactment or codification of the substance, the principle, of what we had before, though I admit the identity cannot easily be ascertained in very many instances.

"To do this with the least hope of success, both the old and new systems must be studied and compared, *aided by the reviser's notes and their marginal references*. The object is worth all the labor it costs; for when once attained, we have the explanations of the old system to aid in understanding the new one. It cannot be that the formal changes I have mentioned meant a change in substance. The transmutation of a principle of the common law, or the rule of practice, into a statute, or an old statute or its received construction into a new one, *without a palpable design to depart from the former, ought not to be considered as a departure*. We are then left where we were, with all the old helps about us, the old lights burning.

"To pursue a contrary course would be to love darkness rather than light. It seems to me that the rule settled by our venerable predecessors, in respect to the revision of old statutes, applies with

*We quote the opinion exactly, instead of giving Kent's paraphrase of it.

full force to a revision and enactment of any branch of the law. It was thus laid down by Chief Justice KENT and Mr. Justice SPENCER."

The opinion then gives, from *Taylor* v. *Delancy*, and from *Yates' Case*, the quotations just made.

KENT, in repeating this, states it to be "a *settled* rule."

COWEN, J., in the opinion quoted, replies to the argument **that the words are too plain to admit of construction.** That, he says, is **an argument which itself appeals to the power of construction.**

"You cannot escape the powers of construction so long as you have a judicial system. The very position contended for invokes the power. What is such an expression so direct as to have no room for exerting the power? The answer itself must say, 'According to *my construction* of this clause, it is too plain to admit of *construction*, or so obscure as to require it.' The argument, if allowed, would only give the power another direction by putting it to follow the rules furnished by Johnson and Murray, instead of the rule of law; to raise a verbal or grammatical construction, instead of a legal one."

It was this which KENT approvingly paraphrased in the first part of his note.

Goodell v. *Jackson*, 20 Johns. 693, 721 [1823]. Court of Errors. Opinion by KENT.

St. 1788 had a preamble which defined and limited the more general words of the enacting clause. The revisions of 1801 *omitted* the preamble.

"It is impossible that I, for one, could ever have considered that the Act of 1788, by being incorporated with many other provisions into the body of the Act of 1801, was to receive a different and broader construction because the preamble was laid aside in the revision of it . . .

"Besides, it had already been settled, by the unanimous opinion of the Court of Errors in 1805 (*Taylor* v. *Delancy*), that even the change of phraseology in the language of a revised act, should not be deemed or construed to be a change of the law as it stood before the revision, unless such phraseology evidently purported an intention in the legislature to work a change."

In the Matter of Brown, 21 Wend. 316, 319 [1839]. *Head note.* "It is a rule of construction, that a mere change of phraseology in a revision of the statutes, will not be deemed to alter the law, unless it evidently appears that such was the intention of the legislature."

The old law about arresting a non-resident debtor contained, in two provisions, an enumeration of various facts which must be made to appear. *One* of these old sections required the facts *it* enumerated to be proved by two witnesses. The revisers condensed both into one section, which on its face read as if two witnesses were required to *all* the facts. *Brown's case* held that the revision should be taken to mean the same as the old law.

Theriat v. *Hart*, 2 Hill, 380 [1842]. *Head note.* "A mere change of phraseology in the revision of a statute will not alter the law as previously declared, unless it clearly appears that such was the intention of the legislature."

Under the old law a levy for rent held the goods only for what rent was due at the instant of taking. The specific restriction to this was *omitted* in the revision. The decision in *Theriat* v. *Hart* was that it would be held to be so limited. Opinion by NELSON, C. J.

Croswell v. *Crane*, 7 Barb. 191, 195 [1849]. The original statute allowed parol leases of land for a time not exceeding a certain number of years "from the making thereof." The revision *omitted* the words "from the making thereof," and read, "leases for a time not exceeding one year." The question was whether a lease for one year *to commence in futuro* was valid. Decision: it is not valid.

"It is well settled that in the revision of statutes an alteration in the phraseology, or the omission or addition of words, does not necessarily alter the construction of the act, or imply an intention on the part of the legislature to alter the law. In a revision of the laws a reform of the language is not necessarily an alteration of the law. The intent of the legislature to alter the law must be evident, or the language of the new act must be such as palpably to require a different construction, before the courts will hold the law changed upon such revision, merely from the fact of a change of the language employed."

"The construction of the present act, in conformity with the former legislative provisions, and the adjudications under them, will best promote the design and intent of the statute for the prevention of frauds and perjuries, and make the action of the legislature consistent with the history of past legislation upon the same subject. The legislature, as well as the revisers, knew the period fixed by the antecedent law, and, if they had intended to fix a different period

for the commencement of the term for which a parol lease might be given, they would have said so expressly, and would not have left it in doubt and uncertainty, both as to their intent to make any change in this respect, and also in regard to the time at which the term should commence.

"**By reference to the notes of the revisers** and the acts [action] of the legislature upon the section under consideration, there can be but little doubt as to the intent of each upon this subject. The section was adopted by the legislature as reported by the revisers, except that the legislature substituted the words 'leases for a term not exceeding one year' in lieu of 'leases not exceeding three years,' as reported."

On p. 198 the court again referred to the value of "**the history of the change in its language**" as controlling the interpretation.

Dominick v. *Michael*, 4 Sandford, 374, 407 [1851]. The court read the clause of the Revised Statutes and said:

"Certainly if these words are to be understood in the full extent of their literal meaning, the argument founded upon them is irresistible. . . . We are not aware nor can we believe that it has ever been contended that the general words of the statute are to be understood in their broad and literal sense, and the supposition that they are so, it is certain, would lead to manifold absurdities" — which absurdities the court pointed out.

"We shall not deny that this construction of the statute would be highly reasonable were its provisions wholly new, or if, although founded on existing law, they involved such a change of phraseology as of necessity to require a different interpretation; but this construction, reasonable as it seems, must be rejected, if the section we are considering, so far from being entirely new, was a mere revision of an existing law; and it is certain that the change of phraseology was not designed to alter the construction."

"That no change of the law, as it then stood, was intended by the revisers, we regard as entirely certain, and **as the section was enacted in the very words in which it was reported**, *it is a reasonable, if not a necessary inference, that no change was intended by the legislature.* On examining the original reports of the revisers, we shall find that they were exceedingly careful, as the proper discharge of their duties required them to be, to designate as 'new' every section, sentence, and place which was designated to *vary* in any degree the construction of the law then under their revision, and that when the alterations which they made were understood by them, and were meant to be understood by the legislature as purely *verbal*, they confined themselves to a simple reference, without any remark, to the particular

section which in its revised form they meant to be re-enacted. (3 R. S., p. 421, 2d ed.). In their original report, this reference, and nothing more, is appended to the section under description, 'Sec. 21, act concerning executors, Vol. 1, R. L. 316'; and we doubt not that this was understood by the legislature as equivalent to a declaration that the section as reported was a mere revision, without any change in the substance and meaning of that to which the reference was given; and that it was with this understanding the section was passed.

"Nor is this all. Had we no such evidence of the actual intent of the legislature not to alter the existing law, it would still be our duty to rest in that conclusion. **For nearly half a century it has been a cardinal and controlling maxim** that in the construction of a revised act, a mere change in the language shall not be regarded as evidence of an intention to vary the construction, unless the change is such as to render that intention manifest and certain. (Chief Justice SPENCER in *Taylor* v. *Delancy*, 2 Caines's Cases in Error, 151; Chancellor KENT in *Goodell* v. *Jackson*, 20 Johnson, 722). It was in the Court of Errors that a rule of interpretation so eminently judicious was first established, and although cases may since have occurred in which it has been violated, it has certainly never been reversed or abandoned. It is now *the rule which, as judges, we are bound to follow*, and we add that it is especially in the construction of the Revised Statutes, where the changes in phraseology are so frequent as to have changed entirely the outward form of the acts which are revised, that the observance of the rule is a necessary and paramount duty. Its abandonment or frequent violation would open a perennial source of confusion, uncertainty and litigation."

Elwood v. *Klock*, 13 Barb. 50, 55 [1852]. "There is no evidence that the revisers or the legislature designed to change the effect of the former statutes upon this subject. The change in the language does not necessarily imply a change in the statutes revised.'

In this case, a specific requirement about a married woman's acknowledgment contained in the original statute, was *not expressly repeated* in the revision. But it has always been deemed an essential requirement, and the court held it so under the revision.

Jenkins v. *Fahey*, 73 N. Y. 355, 362 [1878]. "A difference in the phraseology or verbiage of a statute in a revision does not necessarily call for a different construction, or import a change in the law."

The L. W. Eaton, 9 Ben. 289, 301 [1878, BLATCHFORD, J.]. "Undoubtedly, where the language of any section of the Revised Statutes is so clearly different from the language of any prior provision referred to in the marginal note to such section, as to make it

impossible to give to the new language the same meaning and interpretation which were given to the former language, the new language must receive a different meaning and interpretation. But the presumption is against any intention that new language should have a different meaning and interpretation. The presumption is that the new language is the result merely of revision, simplification, rearrangement and consolidation, with a view to the re-enactment of the same substance and meaning."

To emphasize this argument the court quoted the statutes appointing the revising commission and defining its duties. It cited, *Murdock* v. *Memphis*, 20 Wall. 590, 617; *Smythe* v. *Fiske*, 23 Wall. 374; *U. S.* v. *Claflin*, 14 Blatch. 553.

Murdock v. *Memphis*, 20 Wall. 590, 617. In this extremely important and very elaborately considered case, one cardinal question was whether the act of 1867 brought before this court questions which the judiciary act of 1789 did not permit this court to consider. St. 1867 was an amendatory act, and, so the court held, was intended to take the place of the corresponding section of St. 1789. Now St. 1789 contained express restrictive words. St. 1867 *omitted them*. The court held that they could go no further under St. 1867 than they could under St. 1789. Opinion (*per* MILLER, J.), p. 618:

"The argument may be thus stated. . . . 2. That by the fair construction of the act of 1789 in regard to removing those cases to this court, the power and the duty of re-examining the whole case would have been devolved on the court, but for the restriction of the clause omitted in the act of 1867; and that the same language is used in the latter act regulating the removal, but omitting the restrictive clause. And, 3. That by re-enacting the statute in the same terms as to the removal of cases from the State courts, without the restrictive clause, congress is to be understood as conferring the power which that clause prohibited.

"We will consider the last proposition first.

"What were the precise motives which induced the omission of this clause it is impossible to ascertain with any degree of satisfaction. In a legislative body like congress, it is reasonable to suppose that among those who considered this matter at all, there were varying reasons for consenting to the change. No doubt there were those who, believing that the Constitution gave no right to the federal judiciary to go beyond the line marked by the omitted clause, thought its presence or absence immaterial; and in a revision of the statute it was wise to leave it out, because its presence implied that such a power was within the competency of congress to bestow. There were also, no doubt, those who believed that the section

standing without that clause did not confer the power which it prohibited, and that it was, therefore, better omitted. It may also have been within the thought of a few that all that is now claimed would follow the repeal of the clause. But if congress, or the framers of the bill, had a clear purpose to enact affirmatively that the court *should consider* the class of errors which that clause forbid, nothing hindered that they should say so in positive terms; and in reversing the policy of the government from its foundation in one of the most important subjects on which that body could act, it is reasonably to be expected that congress would use plain, unmistakable language in giving expression to such intention.

"There is, therefore, no sufficient reason for holding that congress, by repealing or omitting this restrictive clause, intended to enact affirmatively the thing which that clause had prohibited."

The court then considered at length the consequences of one interpretation or the other and concluded (p. 629):

"It is impossible to believe that congress intended this result, equally impossible to believe that they did not see that it would follow if they intended," etc.

Smythe v. *Fiske*, 23 Wall. 374, 380. "A thing may be within the letter of a statute and not within its meaning, within its meaning though not within its letter. The intention of the law-maker is the law."

The court then declared the rule that a revision was presumed to reproduce the old; but that where *doubts were known to exist* about the meaning of the old a change of language which made the matter clear was readily accepted for that purpose, and as a proper part of a revision. It said (p. 382):

"It was the declared purpose of congress to collate all the statutes as they were at that date, not to make any change in their provisions. Obviously these exceptions" [the new phrase was "except", etc.] "were intended to remove doubts and misconstruction which were known to have prevailed to some extent."

United States v. *Claflin*, 14 Blatchford, 55, 61. In this case, decided by BLATCHFORD, district judge, and affirmed by JOHNSON, circuit judge, the court quoted at length from the report of the revising commissioners as to whether they had changed the law or not, and relied upon it, in construing the Revised Statutes. Affirmed in 97 U. S. 553.

U. S. v. *Bowen*, 100 U. S. 508 [1879]. See p. 39, *supra*.

Myer v. *Car Co.*, 102 U. S. 1 [1880]. See p. 40, *supra*.

Pentlarge v. *Kirby*, 20 Fed. R. 898, 900 [1884; WALLACE, J.]. "The intention to make a radical change is not to be implied in a revision; and if there is any fair room for doubt, the original acts may be resorted to in aid of their interpretation. *U. S.* v. *Bowen*, 100 U. S. 513."

Baldwin v. *Franks*, 120 U. S. 678, 691 [1886; *per* WAITE, C. J.]. The question was whether "citizen" was used in a political sense, or as equivalent to "resident." "As the Revised Statutes *are but a revision and consolidation* of the statutes in force December 1, 1873, the presumption is that the word has the same meaning there that it had originally."

Landford v. *Dunklin*, 71 Ala. 609, quoted in *Gwathmay* v. *Clisby*, 24 Bl. 398; 31 Fed. R. 220 [1887; WALLACE, J.]:

"No rule of statutory construction rests upon better reasoning than that, in the revision of statutes, alteration of phraseology, or the omission or admission of words, will not necessarily change the operation or construction of the former statutes. The language of the statute as revised, or the legislative intent to change the former statute, must be clear before it can be pronounced that there is a change in such statute in construction and operation."

"As said by the court in *East Tennessee* v. *Hughes*, 76 Ala. 590: 'Unless the alteration of the original act is of such a character as to manifest a clear intent to make a change in the construction and operation, effect will be given to the statute as originally framed by the General Assembly'."

Bate v. *Hammond*, 129 U. S. 151, 169. In *Canan* v. *Pound Mfg. Co.*, 23 Fed. R. 185; 23 Bl. 173, WALLACE, J., in construing this very section upon another point, said: "If it had been intended, in the revision of the statutes, to introduce a new rule, or change the construction which had been placed by the Supreme Court and the Executive Department upon the former provisions of law, plain and unequivocal language would have been employed, which would have demonstrated that intention beyond a doubt."

This court, referring to Judge Wallace's decision, approved its results and its reasoning.

Endlich on Stat. Interp., s. 378. "The presumption of a change of intention from a change of language, of no great weight in the construction of any documents, seems entitled to less weight in the construction of statutes than in any other case; for the variation is often to be accounted for, not only by a mere desire of improving the graces of style, and of avoiding the repeated use of the same words, but from the circumstance that acts are often compiled from different sources; and further, from the alterations and additions from various hands which they undergo in their progress through Parliament."

Sect. 381: "The importance of the principle which attaches slight weight to mere changes of phraseology, is particularly manifest in the construction of statutes that are substantially re-enactments, or that are intended as **revisions** or **consolidations** of others. As to such enactments, it is well settled in this country, that, in the absence of an intention to change the law, sufficiently clearly appearing from other guides of interpretation, or unless the change is such as, in itself, to render such an intention **manifest and certain**, mere variations in the language of such enactments from the language of former statutes on the same subject, under which the law has become settled, will not be regarded as intended to call for a different construction."

Marginal notes in a Revision and their effect.

U. S. v. *Averill*, 130 U. S. 335 [1889]. Mr. Justice BLATCHFORD, in delivering the opinion of the court, said (p. 338):

"By the act of June 27, 1866, chap. 140, sect. 2 (14 Stat. at L. 74), the commissioners to revise the statutes were directed to place at the sections of the revision 'references to the original text from which each section is compiled.' The references opposite sect. 823 are these: '26 Feb., 1853, c. 80, s. 1; v. 10, p. 161; 3 Mar., 1855, c. 155, c. 12; v. 10, pp. 670, 671.' *This shows* that the provision of the act of 1855 was regarded as being incorporated in sect. 823. . . ."

"We think that sects. 823 and 839 must have the same construction *that sects. 1 and 3 of the act of* 1853 *were required to have, after the enactment of the act of* 1855, and that they apply to the allowance for compensation to the clerks of district courts in the territory of Utah. There is no indication in the language of those sections of the Revised Statutes of any intention to change the meaning of sects. 1 and 3 of the act of 1853, as modified by the act of 1855, as such meaning stood on the first of December, 1873. In the absence of such indication, sects. 823 and 839 of the Revised Statutes must be accepted as the law on the subjects which they embrace, as it existed on the first of December, 1873 (*United States* v. *Bowen*, 100 U. S. 508; *Cambria Iron Co.* v. *Ashburn*, 118 U. S. 54, 57)."

U. S. v. *Lacher*, 134 U. S. 624 [1890]. The question was whether the secreting or destroying of a letter containing certain articles was an offence within R. S. 5467, the contention being that the only offence punishable was taking the thing mentioned "out of any letter, packet, bag or mail of letters." This court (*per* Chief Justice FULLER) said:

"As secreting, embezzling or destroying letters, etc., containing articles of value, are plainly grave offences, and are described in the section with particularity, the intention to impose a penalty on their commission cannot reasonably be denied, *and although the apparent grammatical construction might be otherwise, the true meaning, if clearly ascertained, ought to prevail.* If there be any ambiguity in sect. 5467, inasmuch as it is a section of the Revised Statutes, which are merely a compilation of the statutes of the United States, revised, simplified, arranged and consolidated, resort may be had to the original statute from which this section was taken, to ascertain what, if any, change of phraseology there is, and whether such change should be construed as changing the law. *United States* v. *Bowen*, 100 U. S. 508, 513; *United States* v. *Hirsch*, 100 U. S. 33; *Myer* v. *Car Co.*, 102 U. S. 1, 11. And it is said that this is especially so *where the act authorizing the revision directs* **marginal references**, *as is the case here.* 19 Stat., chap. 82, sect. 2, p. 268; Endlich on Int. Statutes, sect. 51. Accordingly, we find that this section took the place of sect. 279 of the act of June 8, 1872 (17 Stat. 318), which reads as follows," etc.

Thereupon, the Chief Justice proceeded to show that the old law contained words which, if they had been repeated in the revision, would have removed all doubts, and the court held that their **omission** did *not* work "the change in the law contended for".

The rule that an omission of a qualifying word, in the effort to condense, is not an affirmative enactment that the ancient qualification shall be abolished, is an indispensable rule; for without it every revision would, in the language of *McClurg* v. *Kingsland*, 1 How. 202, 211, by "changing the law according to every change of mere phraseology, make it a labyrinth of inextricable confusion."

We have pointed out, on pp. 6, 14, 15, *supra*, how signally these rules have been applied to the patent acts, and indeed, to this very section.

In the cases enumerated on p. 78, *supra*, the courts referred to the reports and the marginal notes of the revisers as strong guides upon the question, whether the revision should be read as a reproduction or as a change.

The defendants, in their brief below, cited certain authorities in the effort to show that if *any* meaning could be got from the words of the Revised Statutes, taken by themselves, those words would override all other elements of interpretation, including the revision rule.

That is not the law, and the cases cited by our opponents show that it is not.

First, the rule of cogency in words, requires (p. 149, *infra*) that the words should be an explicit statement, directly in point; and they are seldom so explicit as not to yield to inconsistencies between them and the rest of the statute, apart from any question of the rule of revisions; for where there is an inconsistency, one passage or the other must yield, and it cannot be said, *a priori*, that it should be one rather than the other. *Second*, what the rule of revisions transfers to the revised statute is a *clear or an accepted* meaning found in the old, and not a doubt nor an ambiguity.* For if the old be of a meaning doubtful or uncertain, the true function of a revision is, by clearer language, to resolve that doubt in the direction of good sense and the general policy of the law. *U. S.* v. *Bowen* (p. 39, *supra*) was a case which had some of these elements. Now the sample cases produced below by the defendants were cases where the effort was to read into the revision a meaning which the old law did not clearly have, *and* certainly ought not to have.

The following are cases cited below by the defendants:

St. Paul Plough Works v. *Starling*, 127 U. S. 376. Sts. 1836 and 1861 allowed appeals, without regard to the amount, in all "actions, suits, controversies and cases, arising under any law of the United States, granting or confirming to inventors the exclusive rights to their inventions or discoveries." In *Dale Tile Co.* v. *Hyatt*, 125 U. S. 46 (opinion by GRAY, J.), it was decided, resting on a series of authorities, that a suit *merely* to enforce or to cancel a contract was not within this, although a patent formed the subject of the contract. But the court, with marked care, pointed out that it did *not* decide what would be the law where, though the suit was in form on a contract, the real controversy was as to the validity of the patent,

* "Where the law antecedently to the revision was *settled* by clear expressions or adjudications." "The *established* interpretation," its "*received* construction": "the construction placed by the Supreme Court upon the former provisions"; "former statutes under which the law has become *settled*," pp. 87, 88, 90, 93, 94, 95, *supra*, are phrases used by the courts.

"depending on the construction or effect of the patent laws of the United States." The previous decisions cited had carefully made the same reservation in the same terms.*

In the *St. Paul Co.'s* case the action was, in form, on a contract, but the whole controversy made by the parties and decided by the court below, was whether the patent was valid and whether it had been infringed. The present statute (St. 1870 and R. S.) defined the cases for appeal as "any case touching patent rights," and the court held that the case was clearly within that definition. The defendants insisted that the old statute did not cover their case, and that the new ought to mean the same as *their* reading of the old, in spite of the doubt about the meaning of the old. But the court, again repeating the doubt about the old, found that the new was clear language; declining to find that the old would have any different meaning. The opinion (by Justice GRAY) said (p. 378):

"The present case was an action upon a contract by which the plaintiff licensed the defendant to make and sell a patented article, and not a suit for infringing the plaintiff's patent. But the questions whether that patent was valid and whether it had been infringed were put in issue by the pleadings and decided by the circuit court. Whether, within the meaning of other statutes, and in the light of previous decisions, this case should be considered as "arising under" the patent laws of the United States, is a question not before us. See *Dale Tile Manufacturing Co.* v. *Hyatt*, 125 U. S. 46, and cases there cited. It is sufficient for the decision of this motion, that we have no doubt that a case in which the validity and the infringement of a patent are controverted is a 'case touching patent rights,' and therefore within the appellate jurisdiction of this court, under s. 699 of the Revised Statutes, without regard to the sum or value in dispute."

The contention that the Revised Statutes, by using the words "touching patent rights," gave an ampler jurisdiction to this court than the older statute which used the phrase "cases arising under," etc., was of course, absolutely frivolous. The words of the older statute are the words of the grant of judicial power in the constitution; and no statute *can* confer more power than those words do.

*In the face of *Tennessee* v. *Davis*, 100 U. S. 257, 264, it could not be said to be *settled* law that such a case was not "a case arising under the laws of the United States." It was clear that this court inclined to hold that it was such a case.

Bent v. *Hubbardston*, 138 Mass. 99. The insolvency act of Massachusetts as contained in the volume entitled "Public Statutes" (which is the latest legislative revision), gave a preference to "all debts due to the United States, and all debts due to and taxes assessed by this State, or any county, city, or town therein." Has a town a preference against the estate of the collector for taxes collected by him, or is the statute limited to claims against the tax payer for taxes assessed against him? Decided that it covers the former as well as the latter. The language is explicit; and it does not appear that the older statute had any different *established* meaning. The court said:

"The words 'debts due to' and 'taxes assessed by' being connected conjunctively in the statute, it would not seem possible to construe it in any other way than as providing that they are alike preferred debts. They cannot be limited to debts due for taxes assessed from those to whom they are assessed"

It was urged that St. 1862 from which the revision was made, while it used the same words, also had a sort of preamble or explanatory clause which might exclude such debts from a preference; and that though this clause was omitted from the revision, it should be read in. The court affirmed the general rule about revision, but intimated that it was doubtful whether the older statute did exclude those debts, and that the legislature may well have thought it did not. It also said:

"It is impossible for us to say that the *explicit* language used in the revision was not so used for the very purpose of removing any doubt which might have been caused by the expression in the St. of 1862, relied on by the plaintiff.

In this view, we do not deem it necessary to consider what is the proper construction of the statutes as they existed before the enactment of the Public Statutes."

It may also be observed that the reason of the thing of course extended the preference to all public debts.

Pratt v. *Street Com'rs*, 139 Mass. 559, 563. The petitioner owned shares in the stock of a Massachusetts corporation whose property consisted in a railway in Mexico. That corporation itself paid a certain tax to the State of Massachusetts. The "Public Stat-

utes" (a revision) exempted from taxation in the hands of shareholders, stock in any corporation "chartered in the Commonwealth paying a tax on its corporate franchises."

Under the older statutes the provision was that corporations paying the somewhat peculiar excise tax which this corporation paid, and which was very different from and very much less than the tax paid by corporations generally, did *not* enjoy the exemption; but, in the revision, the language of the clause was so changed that it did not, taken by itself, create that exemption. Thereupon, the petitioner asserted that the language of the revision was clear, and the court could not go behind that. **But the court gave to the revision the meaning of the old law.**

The court stated the rule for the construction of revisions as generally accepted. It then pointed out that the meaning asserted by the petitioner as the meaning of the revision was not in harmony with the general system of taxation, and decided that it would read the provision of the Public Statutes, — "paying a tax on its corporate franchise" — as not including *all* taxes, but as including only the larger, general, corporation tax which this corporation did *not* pay. It added, that it did this the more readily because that made the revision conform to the old law.

Here, therefore, was a case where *the doubt arose*, not upon the words of the clause alone, but *by reason of the want of harmony between the surface meaning of those words and the general scheme of the statute;* and the court construed the act so as to accord with that general scheme. The court said:

"The Public Statutes were intended to be only a consolidation and arrangement of the statutes as they were then in force, and it was the effort of the commissioners to condense into as concise a form as was consistent with clear expression the will of the legislature as embodied in them, and so to express them that no existing rights should be changed. Some amendments were made by the commissioners at the suggestion of the special committee of the legislature, by the special committee, and by the legislature itself. It will be observed also, that in consolidating and arranging statutes, a construction thereof must necessarily sometimes be made. Even if this might not agree with what judicially they would have received, when put into the form of an enactment, it must be accepted as controlling. Where, therefore, the language of the Public Statutes is *distinct*, clear and *admits of but one possible interpretation*, it must

be followed, although it assumes the law to have been as we should not have held it, and although we are not able to ascertain from the reports of the legislature, its committees, or otherwise, that there was any intention to amend or change it. *Bent* v. *Hubbardston*, 138 Mass. 99. Where the law as expressed in the Public Statutes is ambiguous or doubtful, or susceptible of two constructions, it is then most proper to examine the statutes as they previously existed, in order that it may be construed in the light afforded by them. In determining also what is the meaning properly attributable to any language, we are also to consider the other language used in relation to the same subject, and whether, if that found in the Public Statutes apparently varies from that used in the earlier statutes, *the re-enactment of those provisions therein associated with it* does not indicate the absence of any intention to make a change of meaning.

"The petitioner's contention is that the city is expressly prohibited from assessing any tax upon his shares in the Mexican Central Railway by the following proviso of the Pub. Stats., c. 11, s. 4, which section states the proper subjects of taxation on personal property: 'Provided, that no taxes shall be assessed in any city or town for State, county, or town purposes upon the shares in the capital stock of a corporation organized or chartered in the Commonwealth paying a tax on its corporate franchises, under the provisions of Chap. 13, for any year in which it pays such tax.

"If this proviso stood alone, and was to be construed without careful examination of the provisions of c. 13, to which it refers, it would seem to justify the petitioner's contention, although its effect would be to change the law as it previously existed, and, without apparent reason, make corporations for building foreign railways the only class which do not in some form pay taxes on the market value of their stock, or the profits made thereby."

But the court found that though the words, *taken alone*, would justify the petitioner's view, yet that, read with the rest of the statute which re-enacted the taxation system, that reading would be inconsistent with the rest of that system re-enacted with it, and could not be adopted; and it construed the revision to mean the same as the old law.

The defendants also referred to the *Driven Well Cases* (*Andrews* v. *Hovey*, 123 U. S. 267; 124 U. S. 694). But those cases did not arise on a revision. Moreover, they are entirely our way; for in them the court did not trust to words alone, but relied on *the reason of the law and the scheme of the legislation*, learned from its history. That history was as follows:

St. 1793 made a single day's use before application fatal. In *Pennock* v. *Dialogue* and *Shaw* v. *Cooper* [1833], the court, while enforcing this law, said that a use by the inventor and his workmen in completing the invention would not be within the statute, nor would a brief use by one of those workmen, in *treachery*. But it added that the law would and ought to presume an acquiescence in any use attended with considerable publicity, whether it originated in treachery, or from an independent inventor. It said:

Shaw v. *Cooper*, 7 Pet. 292, 320. "A pretence of fraud would afford no adequate security to the public in this respect, as artifice might be used to cover the transaction. The doctrine of *presumed* acquiescence, where the public use is known, or *might* be known to the inventor, is the only safe rule which can be adopted on this subject."

Thereupon St. 1836 continued the law making a single day's use fatal, but annexed to it the qualification of the inventor's "consent and allowance." Whatever this might mean, upon due construction, it was clearly *intended* to mean what the court had said was *the only safe rule;* and, reading it with the legal "doctrine of presumed acquiescence," it did not much, if any, overrun the spirit of the decision, which was that actual knowledge was not necessary, if there was publicity, continued for a considerable length of time.

The suit of *McClurg* v. *Kingsland*, 1 How. 202, was brought in October, 1835, though not tried at the circuit until late in 1839. The inventor, a workman, had been helped in his experiments by his employers, the Kingslands, who had built and used a set of the machinery in their shop, with his consent. He quarrelled with them, sold the invention to a third person, who took out a patent, March 3, 1835, and sued Kingsland. Thereupon congress enacted in St. March 3, 1839, that use before application should not vitiate unless for more than two years; and also that the permissive construction of a machine before patent should amount to a license.*

The question in *Andrews* v. *Hovey* was whether under St. 1839,

* This court took care of the justice of Kingsland's case. It said to the patentee that if he relied on the law as it stood when the patent was issued and the suit brought, the patent was void; if he sought the benefit of the new law, the defendant had a license.

in addition to the fact of more than two years' public use an *actual* "consent and allowance" must be proved. It was obvious that when the time for public use was extended from zero to two years, the protection against a moment's use by treachery or otherwise was no longer needed, and congress fairly might and reasonably ought to enact into positive law that doctrine of "presumed acquiescence" which this court had said was "the only safe rule." The decision was that it had done so; and for this the court relied not on the words but on what it called "the evident purpose" of congress:

123 U. S., p. 274. "The evident purpose of the section was to fix a period of limitation which should be certain, and require only a calculation of time, and should not depend upon the uncertain question of whether the applicant had consented to or allowed the sale or use."

"The evident intention of congress was to take away the right (which existed under the act of 1836) to obtain a patent after an invention had, for a long period of time, been in public use without the consent or allowance of the inventor."

In short, in *Shaw* v. *Cooper*, this court had declared what it was just and fair to do. St. 1836 meant to enact *that*, but, while it did enact the part which protected the inventor, it did not fully specify the part which the court said constituted the only safe rule for the public. In 1839, not by a revising act, but by *a new definition* of the public use which would bar a patent, congress made the law in terms what this court in 1833 had said that it ought to be. But that is not our case. On the contrary, *we* wish to read the revision to mean what the law always had been and what the courts and congress had always said it ought to be.

An attempt was also made in the Well case to tie together the two parts of the section as a proviso is tied to the main clause. But the court declined to so read them because they related to totally different subjects and to the rights of totally different persons; one gave a new right to the inventor, and he must take it as defined; the other gave a license to a user (124 U. S. 702).

VII. Comparison of the Section in Question with the Rest of the Act of which it forms Part.

This comparison may be made by comparing s. 25 of St. 1870, with the rest of that act, or by comparing R. S. 4887, with the rest of the Revised Statutes; because, though these and many of the other sections present verbal differences between 1870 and 1874, it is settled that the meaning is the same (p. 41, *supra*).

The lessons from comparison in this case. A provision which constitutes a part of a large and complete legislative or legal system is presumed to be in harmony with the rest of it, and especially with its leading and long established features. The courts therefore reject any interpretation of a single provision not in harmony with the rest of the system; and, it is a fact that the patent system especially calls for and has liberally benefited by this rule (pp. 14, 19, 20, 27, 28, 31, 44, 102, *supra;* p. 106, *infra*).

But we are here dealing with a **revision** or **consolidation** of all the older statutes, one express purpose of which, declared by the statute which ordered the revision, was to ensure the harmony of laws *in pari materia*.

From such considerations the rule arises that the re-enactment of a whole system is *a legislative declaration of a legislative intent that each particular feature which in the old law was in harmony with the rest shall, in the revision, be so interpreted as to remain in harmony with the rest.* This is especially true here, because the entire re-enactment preserves the entire harmony of the system, unless we adopt the defendant's reading which would create the sole exception and introduce the only false note.

"In determining also what is the meaning properly attributable to any language we are also to consider the other language used in relation to the same subject, and *whether*, if that found in the Public Statutes [revised statutes] apparently varies from that used in the earlier statutes, *the re-enactment of those provisions therein associated with it* does not indicate the absence of any intention to make a change of meaning." *Pratt* v. *Street Com'rs*, 139 Mass. 559, 563, p. 102, *supra*.

The Rule of Dates in the patent law; — invention date for the original creation of the right: application date as the test of subsequent forfeiture; and never the issue date. Patent legislation began by the English Stat. 21 Jac. 1, c. 3; 1624. That statute, the first of a struggle against monopolies, vigorously carried on during two reigns, contained, in pursuance of what the enemies of monopoly recognized from the outset as a policy just in itself and essential to the progress of a manufacturing nation, an exception in favor of patents for inventions which were new within the realm "*at the time of making such letters patent and grants.*"

This fixed the date of *grant* as the test date: but when it was put in practice, the injustice of destroying a man's right by reason of a publication made while, having filed his application, he waited the tardy action of government officers, was so obvious that the lord chancellor and the attorney-general, who granted the patents, at once established the practice of antedating the patent to the day of application (or as near to it as an ancient statute about royal grants permitted), and the courts sanctioned the fiction, resting it on the theory that what the king stated as the date, in a grant under the great seal, made in virtue of his prerogative, could not be contradicted. English statutes of our own time have recognized and defined that practice. It was law invented by the courts to overcome the injustice of a *literal* interpretation of the statute.

Such a fiction was, of course, impossible with us; but the same just result was made, from the beginning, a leading feature of our patent system. St. 1790 provided that the *petition* must state that the invention was "not before known or used." The accepted purpose of this somewhat vague language was made more definite by the words of St. 1793, "not known or used before the application." In *Pennock* v. *Dialogue*, 2 Pet. 19, 22 [*per* STORY, J., 1829], and *Shaw* v. *Cooper*, 7 Pet. 319 [*per* MCLEAN, J., 1833], this court said that while the language of the original act could be read as referring either to date of invention or of petition, it would be read like the second act, viz., that the invention must not have been known or used by the public at the date of *application*.

It seems to have been difficult for congress to express itself on the subject of the critical dates; for nearly every statute about them

has been so worded as to support, if not call for, so far as words go, a meaning at variance with justice and good sense; but *in every case the court has interpreted the clauses about dates without regard to verbal or grammatical construction, and in accordance with the dictates of justice and the spirit of the patent system.* The difficulty has always arisen from a disposition in those who drew the statutes to employ condensed and therefore generalized statements; and the court has always met it by taking the sentence to pieces, and referring a part to the date which was specifically defined, and a part to the date which ought to have been, but was not specifically defined.

Thus, St. 1793 gave the patent to any person who had invented any new and useful art, etc., "not known or used before the application." The court held that knowledge and use in his experiments, by him or by his assistants, did not come within the statute; that it required a knowledge or a use by the *public* before application. Then it was held that a *private* knowledge and use by another *independent* inventor, in order to vitiate the patent must be before the patentee's *invention*, and not merely before his *application*, though certainly the words of the statute were met by *any* use before *application*. So the court in effect re-wrote the single expression of the statute into three or four statements. *Mellus* v. *Silsbee*, 4 Mason, 108, 111; 1 Robb. 506 [STORY, J., 1825]. *Pennock* v. *Dialogue*, 2 Pet. 1 [1829]. *Shaw* v. *Cooper*, 7 Pet. 292 [1833].

But the rule made by the decisions always was that, as respects the *creation* of the right, the date of invention governed, while as respects *loss* or *forfeiture* of the right once created, the date of *application* fixed everything.

St. 1836 was drawn by men of ability, possessed of an intimate knowledge of the actual workings of the system, and generally not afraid to use plenty of words to express their thought. Sect. 6 clearly states and enacts the rule so established by the courts:

"not known or used by others before his or their discovery or invention thereof, and not, at the time of his application for a patent, in public use or on sale, with his consent or allowance, as the inventor or discoverer."

But, in another definition of the qualifications for a patent, this same statute is so written that when one of its statements is referred

to that with which it is grammatically connected, it attributes to one date a qualification which ought to belong to another. Its s. 7 enacts that the commissioner *must* issue the patent if "it shall not appear to the commissioner that the same had been invented or discovered by any other person in this country prior to the alleged invention or discovery thereof by the applicant, *or that it had been patented or described in any printed publication in this or any foreign country, or had been in public use or on sale with the applicant's consent or allowance* prior to the application." The *grammar* of the sentence scrupulously cuts off the "foreign printed publications" qualification from the *invention* date, connects it with the public use qualification, and attaches both to the *application* date. But the courts have always referred this first qualification to the invention date, where it philosophically belonged, in spite of the grammarian. Recently this court has, in effect, written in "in this country" as a limitation of the public-use bar; for unless it had done so, the system would have been unharmonious (p. 20, *supra*).

From this history we draw two conclusions: one, that the penmen of congress seem always to have had the greatest trouble in attaching qualifications to the date to which they belong, and that this court has had little hesitation in putting them where, in the nature of things, and according to the scheme of the system, they do belong, in spite of the logic of *words* and the rules of grammatical reference; other instances are on p. 145, *infra*. The other conclusion, which is the one we use at this moment, is that the strong inherent sense of justice in England, in spite of the words of their law, and the strong inherent sense of justice generally expressed in the granting clauses of *our* laws and always governing *our* courts, have invariably made *date of application* the date for determining questions of forfeiture of a right which once existed.

But other provisions also establish that the right existing on the day of application can never be forfeited except by the actual wrongdoing of the owner thereof.

The Patent Act throughout treats everything in the Patent Office, when done, as if done at the Moment of filing the Application. The main clause, to which everything else about patent office procedure is a mere accessory detail, is:

R. S. 4893; St. 1870, s. 31. "**On the filing** of any such application, and the payment of the fees required by law, the commissioner of patents **shall** cause an examination to be made of the alleged new invention or discovery; and if *on* **such** *examination* it shall appear that the **claimant** is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the commissioner **shall** issue a patent therefor."

That statute is violated if a delay in making the examination ordered to be made "on the filing," forfeits the patent to which the claimant was "justly entitled" on the day of filing. Any construction of any clause which leads to that result is inconsistent with this primal section.

That the right is always conceived of as fixed as of the application date, and not afterwards to be impaired except by a gross, deliberate, avoidable, and specifically forbidden delay by the inventor himself, is shown by R. S. 4894 (St. 1870, s. 32), the non-prosecution provision of which was inserted by a committee's amendment in this very act of 1870.* The defendants' reading of our section which makes *delays by the patent office*, the cause of forfeiture, is utterly inconsistent with this pointed expression of the views of congress *in this very act*. If there were occasion to weigh those sections against each other, it is clear that the thought expressed by the specific amendment, in harmony also with the rest of the system, must override the suggestion that an opposite one has been introduced by a reviser's carelessness.

The Rule of Dates fixed by the Courts is the same. That the right is always to be determined as of the date of the application, and that subsequent delays by the office itself, whether the result of the system or of a bad administration of the system, cannot affect the applicant, is declared by the courts to be an inherent rule of law independent of any statute. This has often been stated both before and since St. 1870.

Adams v. *Jones*, 1 Fish. 527, 530 [GRIER, J., 1859]. "The delay afterwards interposed [after application], either by the mistakes of the public

* The provision is that a failure to prosecute an application, continued for two years after the office has called upon the inventor to act, shall be deemed an abandonment, unless the delay shall be excused by the commissioner as unavoidable.

officers, or the delays of courts, where gross laches cannot be imputed to the applicant, cannot affect his right. . . . Involuntary delays, not caused by the laches of the applicant, should not work a forfeiture of his rights."

Planing M. Co. v. *Keith*, 101 U. S. 485, quoted this last sentence with approval.

Indeed it was decided in 1846, *that it was totally immaterial whether the statute named application date or not, as the criterion; because* the law *would not permit the delays of our patent office to work a curtailment of the patent to which, on the day of application, the inventor was entitled.*

Root v. *Ball*, 4 McLean, 179 [1846]. In a suit on a patent the defendant pleaded a public use two years before the *patent*. The court said:

"*Independently of this statute* [1839, § 7], the plea would have been bad, as the *application* for a patent must protect the right of the inventor, and the delay which may occur in the patent office in making out the patent cannot operate to the injury of the applicant."

Henry v. *Francestown Co.*, 2 B. & A. 221, 223 [Shepley, J., 1876]. "Delays in the patent office, which an inventor cannot prevent, will not impair his title to his invention."

Stark v. *Starrs*, 6 Wall. 402, 418, said of a land patent:

"The right to a patent once vested is treated by the government, when dealing with the public lands, as equivalent to a patent issued; when in fact the patent does issue, it relates back to the inception of the right of the patentee so far as may be necessary to cut off intervening claimants."

In the later land cases, it has always been considered that the condition of things *actually* existing *at that time*, controls, though the facts may not be ascertained until later.

In *U. S.* v. *Am. Bell Tel. Co.*, 128 U. S. 315, the court said that land patents and inventions patents "are of the same nature, character and validity."

It is a Universal Rule of Law that the right finally ascertained is ascertained as of the day when proceedings were begun; and that the time taken by the tribunal to deliberate shall not, of itself, destroy the right about which it deliberates.

Courts habitually give to their decisions the same effect they would have had if entered on the day when the case was submitted. Stat-

utes of limitation stop when a writ issues, and it would shock the common sense of mankind if they did not. A bill in equity lies on a patent only because it seeks for an injunction, but if it be brought long enough before the expiration to make it legally possible to move for one, the suit will be maintained, though no such motion was made, and though the patent expired before the return day and only fifteen days after the bill was filed. *Clark* v. *Wooster*, 119 U. S. 322. A Massachusetts statute makes taxes a lien from the time they are committed to the collector. But the court made this relate back to May 1, the day when the assessors are directed to *begin* their work, saying:

"Such, doubtless, was the intent, and should be the construction of this provision of law; although practically the tax is not assessed until some weeks or perhaps months after." *Hill* v. *Bacon*, 110 Mass. 387.

Gray v. *Brignardello*, 1 Wall. 627, 636. "A *nunc pro tunc* order is always admissible, when the delay has arisen from the act of the court. *Fishmongers' Co.* v. *Robertson*, 3 M. G. & S., 970."

Mitchell v. *Overman*, 103 U. S. 62, 64. "The rule established by the general concurrence of the American and English courts is, that where the delay in rendering a judgment or a decree arises from the act of the court, that is, where the delay has been caused either for its convenience, or by the multiplicity or press of business, the intricacy of the questions involved, or any other cause not attributable to the laches of the parties, the judgment or the decree may be entered retrospectively, as of a time when it should or might have been entered up. In such cases, upon the maxim *actus curiæ neminem gravabit*, — which has been well said to be founded in right and good sense, and to afford a safe and certain guide for the administration of justice, — it is the duty of the court to see that the parties shall not suffer by the delay."

Cited and confirmed in *Coughlin* v. *Dist. Col.*, 106 U. S. 7, 11. S. P., *Clay* v. *Smith*, 3 Pet. 411.

No statute or judicial practice permits the delays of litigation to be *a necessary legal answer* to a claim which was good when presented. Laws are enacted to prevent such delays, not to take advantage of them. That the public, through its half-administrative, half-judicial bureau, should make *the delays of its own system* a ground for refusing the grants it has promised would be monstrous. But here something more than a legal habit (which is a

habit of makers of the law as well as of the courts who execute it) is outraged; *a direct promise is broken or evaded.*

Mr. Bate, on the day when he applied, was entitled to receive from the public, to be afterwards enforced against the public, a seventeen-year patent. Two months later he applied in England. That was an act lawful in itself, not mischievous in its consequences, forbidden by no law, counter to no policy. The statute ordered that "on the filing of his application, the commissioner *shall* cause an examination to be made . . . and if on such examination it shall appear that the claimant is justly entitled to a patent under the law . . . the commissioner *shall* issue a patent therefor." The examination has been made, and the commissioner found, and correctly found, that Mr. Bate was justly entitled, and gave him a patent. If the commissioner had "made the examination" "*on the filing*" as ordered, or if he had made it at any time within seven months afterwards, the patent would be good for its face. But because the commissioner took a year to make his examination — because either the work which the statute imposed upon him required a year, or because he was slothful in performing it, the law, it is said, will confiscate the four best years of Mr. Bate's patent. Confiscation is hardly the word; spoliation would be better; for the value of the use during that time is to be taken from Mr. Bate and *given to the public*, and this is to be done *by the public itself;* and done because of *its own* delays.

Is not this monstrous in every sense? And is it not something which the court will refuse to impute to congress, and will refuse to be the tool to accomplish, at least, without a statute expressly *ad hoc*, in words which show that congress knew of the responsibility belonging to such an act and deliberately shouldered it? This court has answered that question as follows:

The Contract Relation between Patentee and Public, and its effect on this case.

In *Grant* v. *Raymond*, 6 Pet. 218, 242, the court defined the nature of a patent right; and language could not more clearly state it as *the price paid for an invention in pursuance of a previous promise to pay it.*

"It is the reward *stipulated* for the advantages derived by the public for the exertions of the individual, and is intended as a stimulus to those exertions. The laws which are passed to give effect to this purpose ought, we think, to be construed in the spirit in which they have been made; and *to execute the* contract fairly on the part of the United States, where the full benefit has been actually received."

The court then pointed out that the inventor had not given nor intended to give his invention to the public, but had disclosed it "in pursuance of law, with the intent to exercise *a privilege which is the* consideration *paid by the public* for the future use of the machine." For the public then to attempt to appropriate the discovery "would be disreputable in an individual, and a court of equity might interpose to restrain him."

This footing of *right* has always been recognized by congress. Sec. 7 of St. 1839, now R. S. 4893, just quoted, made it the "duty" of the Commissioner to issue the patent. St. 1839, s. 9, now, with enlarged remedial provisions, R. S. 4915, affords a bill in equity to compel the United States, through its Commissioner and Secretary of the Interior, to perform this "duty."

Thus congress has recognized that here is an obligation possessing so fully the substantial elements of a contract that its performance by the government ought to be compelled; and it recognized this long before, by the court of claims, it provided for the enforcement of other obligations resting in contract.* Now some important consequences flow from these relations.

The constitution and the patent act, desiring to "promote the progress of the useful arts," offer a reward to those who will supply the public with new inventions. The patent is not intended as

* It was long ago settled in England that the patent law constituted a promise, — a bargain.

Neilson v. *Harford*, 1 Webs. Pat. Cas. 331; 3 Am. & Eng. 247; ALDERSON, B., says:

"Lord Eldon lays down the principle so long ago as 1800. He says patents are to be considered as bargains between the inventor and the public, to *be judged of on the principle of good faith*, by making a fair disclosure of the invention, and to be construed as other bargains."

But there is no bargain if good faith is to be required only of one side, and the other may play fast and loose at pleasure.

simply a recognition of merit or of virtue. It is the *price* which the public pays for the greater benefit it derives from the invention, in the belief that the price offered will induce the creation of what it is offered for.

The statute contains the offer which, when fulfilled by an inventor, constitutes the promissor's part of that well-known kind of contract which arises from the offer of a reward; and the act defines the two terms which are essential to constitute such a contract; what the inventor is to do to become entitled to the reward, and what the exact measure of the reward is.

R. S., 4886, 4888, enact that whoever makes a new invention, and brings an intelligible description of it to the public at its patent office, claiming the reward, shall obtain it. Sect. 4884 defines what this reward is. It is "a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the exclusive right to make, use and vend the invention or discovery." Here we have what is essential to a contract: the definition of what the one side is to produce, and what the other side is to pay.

There must be a time when the offer to give the reward for a thing to be done ripens into a *completed* obligation. The law about this sort of contract tells us when this time is. The inventor's work has been done, and the benefit has been actually received when, the invention having been made, it has been disclosed to the public by the application*; — we use almost the language of Chief Justice MARSHALL. Nothing remains, then, but to pay the reward. It is true that the bare assertion of the inventor that what he has produced is within the offer cannot be unreservedly accepted; so an examination of it is to be made. But the privilege reserved to the promissor of

* It has been suggested that if the inventor does not get his patent, his application will be kept secret, and he will remain *in statu quo*. That is not true in fact, and no law requires rejected applications to be kept secret. The public has a description of the invention in the hands of its officers, and can do what it likes.

But it would not be material if the description were to be kept secret. The inventor has created the new thing on the promise of a patent, and neither to bury it in oblivion nor to publish it without a patent would repay him, nor satisfy the promise made by the public.

an examination for the purpose of identification neither weakens the right nor the obligation. Indeed, as it postpones the day of payment, it imposes an additional obligation to make it as soon as practicable, and to make it in such a way that the making of it shall not diminish the value of the reward to the receiver, nor lighten its burden to the payer. In fact, the examination is ordered by statute to be made "on the filing," and if, "on such examination," the inventor is found to be justly entitled under the law, the patent "shall" issue. That does not mean, and never was intended to mean, that the examination shall in actual physical fact be made on that day; for that is impossible. It means that it shall be made *in law*, on that day, — that is, *as of* that day. It is impossible to conceive that the law-makers intended that the delay of their own officers in ascertaining the inventor's right to the promised reward should be of itself a reason for deciding that he had lost it; or that the failure of the public, for any reason, to grant the patent promptly shall be erected into a legal reason for destroying the right of the applicant to have it granted. Yet that is exactly what our opponents say has been introduced into the law by what at most was a verbal carelessness of revisers which escaped the attention of congress.*

We have pointed out (p. 111, *supra*) that the precise difference between our reading, which takes *application* date as the date which fixes the right to an uncurtailed patent, and the defendants' reading, which takes *issue* date as the criterion, is that the latter makes delays by the public itself, through its patent office proceedings, the source of curtailment. They are delays by the public itself; for when once the application has been filed, the office system takes hold of it; prescribes what shall be done, and how elaborately; invites opponents to come in and initiate contests which cause great delay; makes the rules of practice and selects and supervises the officers on which and on whom it depends whether the work shall be done slothfully or briskly. When the applicant is delivered over to the machinery of a bureau, he cannot compel speed.

* It is no answer to this breach of promise by the public, to say that if Mr. Bate had read the statute as the infringers read it, he might have known that he would suffer this wrong. Indeed, this court has disposed of such an answer (*v.* p. 121, *infra*).

In *Pennock* v. *Dialogue*, 2 Pet. 1, 22, the court summed up the controlling considerations for its interpretation of the statute in words which we invoke;

> "No public policy is overlooked; and no injury can ordinarily occur to the first inventor which is not, in some sort, the result of his own laches or voluntary inaction."

This court has recently had to consider the effects of the delays and accidents of our patent office system, and decided that it would construe the statute so that the rights of the party should not be destroyed by them.

In *Refrigerating M. Co.* v. *Featherstone*, 147 U. S. 209, the patent, in the usual terms, granted the exclusive right to "James Boyle, his heirs and assigns." James Boyle died some time before the grant.

Nothing could more shock a common-law lawyer than the notion that a deed to a dead man, with the usual words of inheritance, could convey a title; and this court had decided that a patent of land to a dead man and his heirs was void. And yet this court held the Boyle patent good in the hands of those who were his assignees, but who had not taken the proper steps to have the patent issue to *them* and thus make it technically good under the statute. There was nothing in the language of the statute which, as mere words, or upon a first blush interpretation, justified this. On the contrary the law expressly provides that in case of an assignee the patent shall issue in his name, and in the case of the death of the inventor it shall issue to the executor or administrator. By a familiar rule of verbal construction, this express provision might be held to exclude any other course. Moreover, the administrator should have seen the defect at once, should have refused to receive the patent and returned it for correction. These were perfect answers verbally, and upon strict technical grounds. But none of them met the substantial justice of the case, and the court refused to be constrained by them.

We quote some passages which sufficiently show how the court looks at questions arising under the patent act, where the inventor merits the patent and the patent has issued — passages which breathe the spirit of *Grant* v. *Raymond*. But what we especially call attention to is the last paragraph we quote. The court points out that

delay in the patent office is so completely *a part of our system* that those delays, and what usually and naturally occurs during them, must be presumed to have been in the mind of congress, and *its enactments are to be interpreted so that the inventor shall not be hurt by such delays.*

The CHIEF JUSTICE, who drew the opinion, discussed the question before the court, and said (221):

"We are to remember that it is to be assumed that James Boyle had made a useful invention and taken all the necessary steps to secure the benefits to be derived therefrom, and that in view of the policy of the government to encourage genius and promote the progress of the useful arts, by securing to the inventor a fair and reasonable remuneration, a liberal construction in favor of those who claim under him must be adopted in the solution of the principal question before us.

"It is also to be observed that, under the practice of the Patent Office, a considerable time necessarily elapses after a patent for an invention is allowed before it actually issues; that the applicants often reside at a great distance; that the cases when an inventor dies between the date of the application and the allowance, and the allowance and the issue, must be of frequent occurrence; and that this may happen when neither the office nor the inventor's solicitors are aware of the death. The reflection is a natural one that congress, which, in framing the provisions of the patent laws, must be presumed to have had these possible occurrences in mind, did not contemplate that all patents issued under such circumstances should be invalidated by the death of the inventor."

The infringers' reading is specifically inconsistent with the Bill in Equity to compel the grant of the patent under R. S. 4915. On the day of filing, Mr. Bate was entitled to the promised seventeen year patent. The examiner refused it. Mr. Bate appealed to the board of appeals which corrected that error. If the board had affirmed the examiner, Mr. Bate would have appealed to the commissioner; and if not then righted, he could have brought a bill in equity to try his right and compel the grant. By such a bill, and by appeals to the Supreme Court of the District of Columbia, and by mandamus, remedies expressly provided by law, the applicant can compel the commissioner, willy-nilly, to do his duty.

But what is his duty? Our opponents assert that the law is to say the commissioner committed a wrong; he ought to have given

you your full patent; that he ought to have done this has now been decided; but the remedies which give you that decision make it illusory; the time required to invoke them has *in law* destroyed your right, and in effect sanctioned the wrong. To assert that the section in controversy means that, is to assert that it is, in the words of *Butterworth* v. *Hoe* (p. 19, *supra*), "inconsistent with the integrity of the system" and therefore a meaning which the court cannot read in it.

Similar reasons are found in the interference section and in the rest of the statutory machinery created to enable the office to ascertain whether Mr. Bate's demand for the patent and his assertion that he is entitled to it, contained in his application, is true. The interference section presents an instance of peculiar aggravation. For, besides an inevitable delay, an interference requires a disclosure to the adversary, by copies and by printed depositions, of the whole invention. The enemy, by sending a few copies abroad, can prevent foreign patents; or if they have been previously applied for, he can prolong the case here until foreign patents have come out, and so curtail the American patent.

The Defendants' Reading is inconsistent with and defeats the provisions in the statute which confirm and define the Right to Assign inventions.

No provision is more important nor a more essential feature of the patent law than *the power to assign inventions*. The first machine of its class is usually crude, and the cumulative "improvements," which the patent law in terms invites, contribute perhaps actually the largest part towards the progress of the arts. It is rare to find a modern machine which does not contain the inventions of half a dozen or a dozen inventors, still under patent. That inventors may get their inventions into profitable use and thus be stimulated to make them, and that the public may at once be furnished with improved machines, there must be aggregated under one ownership, capital, business skill, and the work of many inventors. Probably three fourths, at least, of all patents are assigned. But these results cannot be accomplished, the purpose of assignments cannot be reached, *unless the sale carries a real title to the thing sold;* and

there is no title worth the name, until the inventor who has sold his invention ceases to have power to recall or destroy that which he has sold.

The statute fixes the moment when the assignee is cut loose from the inventor. R. S. 4895 provides that patents may be granted to the assignee, if the assignment has been recorded and "the application made and the specification sworn to by the inventor or discoverer." When these acts have been done, the transaction, by R. S. 4895, is complete. The patent is then to "be granted and issued to the assignee"; he is the only person recognized; he is the one to receive the patent, *as patentee*, or be "debarred" from it. He has not a mere equity to acquire the property; he *has* acquired and is the legal owner. If by fraud or mistake the patent issues to the inventor, even if he be dead, the law deems the title vested in the assignee without further deed (*Gayler* v. *Wilder*, 10 How. 477; *Refrigerating Mach. Co.* v. *Featherstone*, 147 U. S. 209). The statute therefore fixes the **instant of filing**, as the moment when the title may become perfect, and the assignee independent of the inventor.

It is of the very essence of a transfer of ownership that the assignor becomes a stranger in law. His subsequent acts cannot diminish or impair the right which he purports to have conveyed. His admissions cease to be evidence against it. If the grant carries a patent he cannot affect it by reissue or disclaimer. He is not permitted to do any act or even receive any information from the office which could jeopardize the assignee's interest.

Moreover, the contract and promise of the United States, made by the statutes with and to the inventor, becomes from that moment a promise by the United States to give the patent to the *assignee;* and he pays for the transfer on the faith that the United States has now promised the patent to him.

Now how does the section in controversy affect such a case?

The specification is sworn to, the application filed, and the assignment recorded. No foreign patent has issued; none has even been applied for. The right which exists on that day is the right to have a patent to run seventeen years from its date. Office proceedings may delay it; but when it comes it will give a seventeen-year

monopoly. That is what the assignee has bought and has paid for. He has fulfilled the formalities which the statute prescribes to perfect his title to it; what he has acquired is the right and title to the patent which *the United States* by the same statute purports, at least, to *promise to* **him**. On our reading, — that foreign patents after the American application are not to be regarded, — he will get it.

But the *inventor* may, the next week, file a foreign application, and, if he pleases, he can get the foreign patent so quick that it is sure to antedate the American patent. Now, on our opponents' reading, that will cut off at least three and, more usually five, — the five best years of the assignee's promised seventeen — the seventeen years which the United States promised to *him*, recognizing *him* as the owner, and declaring that the inventor, after application and assignment, has no power to affect the property assigned. A law which permits the assignor to so defeat or curtail his grant would be inconsistent with the grant, inconsistent with the statute which sanctions and defines the grant, would nullify that statute and defeat the purposes and intent of congress in making it; and it would put into the inventor's hands an irresistible engine for extortion. The assignee has no possible protection against such a wrong, if this statute puts it into the power of the inventor to commit it. For the inventor has a right to take out foreign patents; and even if the assignee buys that right to protect himself, — and the law does not say that to get a real title to the American patent he must also buy the foreign right, — there is, practically, no precedure which can prevent the inventor from doing what he pleases abroad.

This court has once before had to face such a threatened evil. In *Wilson* v. *Rousseau* (p. 27, *supra*), one construction urged for the statute about extensions (then St. 1836, s. 18) would have put into the hands of the inventor who had sold a machine the right to exact a second price at his pleasure or to forbid the use of it. "A construction leading to such consequences," and "fraught with such unmixed evil, so deeply harsh and unjust in its consequences, was never contemplated by congress" and will not be adopted by the court. Such was the decision there. Such must it be here; and this ground of distinct inconsistency with the assignment section of

the same statute affords here an ample technical ground which was wanting in that case.

In the same case, speaking of the assignment sections, this court said (4 How. 679):

"One object of these provisions found in the general patent system, is to **separate the interest of the assignee** and grantee from that which may be held by the patentee," to the end that it shall thereafter be out of the power of the inventor to affect the rights which the grant purports to confer.

But that is not done unless the right which those provisions pretend to pass to the assignee is a complete and perfected right.

It is true that this inconsistency and contradiction and this particular injustice would be obviated by holding that the inventor after assignment was a *stranger*, and that a foreign patent by him would not come within the statute; and the court would probably be compelled by the rules of law to so hold.* But it would be trifling with the statute to have recourse to that. For if that were all, the statute could be nullified in every case. Nor would there be any justice or reason in the distinction between such a case and ours. Mr. Bate, who did not assign, should have as good a patent as an assignee would. The inventor ought to be enabled to do directly, what might thus be accomplished indirectly. The proper way, therefore, is to so read the statute that when the invention has *reached the application stage*, that is, when the right to the patent is made absolutely salable and a transfer can be legally complete, the right is fixed. Such a construction is necessary in order to reconcile the machinery of this section with the substance of the assignment section; it must, therefore, be given to it.

To say that the inventor was forewarned that delays by the office would destroy part of his right, and that the assignee was warned of what he might be made to suffer, is no answer.

**Kendrick* v. *Emmons*, 2 B. & A. 208, C. D. 1876, p. 284 (SHEPLEY, J.); *R. R. Reg. Co.* v. *North Hudson Co.*, 23 Fed. Rep. 593, C. D. 1885, p. 374 (NIXON, J.), in terms decided, and *Cochrane* v. *Deener*, 94 U. S. 780, 791, expressly assumed, that the foreign patent had no effect if taken by a stranger. This has always been understood to be the law. See p. 74, *supra*.

To these considerations of that injustice and wrong which, between private persons would be characterized as gross dishonesty, the defendants suggest one answer which may be summed up in a common phrase, "I told you so." If the statute, they say, bears their meaning, then every man who makes an invention, and, having asked for a patent here, does the perfectly lawful and proper act of asking for one in England, is forewarned that our public, if through its officers it will only go slow enough in doing its duty, can cheat him and usually will cheat him of the promised reward. As well might a swindler say that his victim cannot complain, because his bad character was a warning in advance of what to expect. Bystanders may scoffingly hint that, but the law does not let the cheat say it. A common carrier may, under fair circumstances, stipulate against almost anything, but he cannot stipulate against his own negligence. Still less can he make his negligence a direct source of profit.

Indeed, the notion that a statute justifies itself against the charge of injustice and oppression because it is a warning that it will inflict them, would banish from the courts the well-settled rule of interpretation that laws are to be so construed as not to work injustice or wrong.

In the *Woodworth Planer cases*, the court met just such an argument. For there, whatever the statute meant, the parties should have known it, and if they made bargains which put it in the power of the inventor to afterwards oppress them, it was their own fault; and the court cannot be asked to let their interests be considered in construing the statute. McLEAN, J., took exactly that ground in his dissenting opinion in *Bloomer* v. *McQuewan*, 14 How. 556. But the court rejected such notions. It concluded that congress did not mean to do that; and it gave to the statute a meaning which disabled the inventor from impairing the value of what he had once sold.

For the public to promise the patent, and reserve the right to defeat the promise by its own delays is not that execution of its promise "fairly" and in "good faith" which Chief Justice MARSHALL and Lord ELDON said that the patent law called for (p. 113, *supra*).

The law of patents is certainly the most philosophical branch of the law. It ought to be, for it is the latest. It first took shape

under the inspiration of the great inventions of Watt's steam engine and the textile machinery of the second half of the last century; and thus escaped the technical narrowness and confining forms still clinging to branches of the law which arose in narrower and more formalistic periods. In England, it came near shipwreck when some judges of the older school for a while applied petty verbal considerations to it. In this country, however, it has never seriously incurred that danger; for the views of this court, voiced by the CHIEF JUSTICE in *Grant* v. *Raymond*, and elaborated by Judge STORY in the appendix to 3 Wheaton, and applied at the circuit, fixed its tendencies.

Its broad character is due in great part to the fact that it is *court-made law*. No statute seriously defined it in England until 1852. Our statutes of 1790 and 1793 hardly more than afforded machinery for the courts to work with. The admirable act of 1836 was really the expression of what had been done or learned from decisions and in practice. This court has always construed the patent statutes, as it has applied its own opinions, in the light of principles and in conformity to them, and has never made itself the slave of words.

In this spirit the patent law has been built by this court and its justices, — by MARSHALL and STORY, who laid its foundations; by NELSON, GRIER, MCLEAN, CURTIS and District Judge SPRAGUE, who, in its middle stage, applied it in that spirit; while the decisions quoted in the earlier part of this brief show that the court, from its riper experience since the great judgments of 1850–1855, knows that the law of patents cannot be administered in any other way. It will be preserved by the same method through which it has been reared.

VIII. The Section in controversy (St. 1870, § 25, and R. S. 4887) Interpreted by Its Own Language and by the other parts of the law which its Language Specially Refers to.

We begin with the fact that we do not invoke any part of the section in question as the source or foundation of our patent. If it did not exist, our patent would have been granted exactly as it has been, and would be valid and for seventeen years; because when he filed his application Mr. Bate had no foreign patent, and there never has been a time at which a foreign patent, or a publication or even public use, anywhere, *after application filed*, could affect the right, — unless this section, of itself, introduces a new disability. The entire contest arises upon the attempt of the defendants to read this section as a disturbing and forbidding section, or rather to read a *proviso* in it as a positive, independent and disturbing and forbidding enactment, destroying that which the granting sections 4884–5–6 and the rest of the statute and the whole frame of the law create, and making an exception to the right expressly given by them.

Whoever asserts that it is such a section must find the most explicit language, directly to the point, stating in terms that its authors intended it as such.

It opens with the words:

"No person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented in a foreign country," etc.

Those words do not, of themselves, *grant* patents. They inform us that the preceding portions of the law which do grant are afflicted with a shortcoming or deficiency, in that, by them, the grant is withheld from certain persons whom congress, upon further consideration, desires should receive it. The section is a bit of supplementary legislation to remove the disability of those persons. Those persons and their interests, therefore, constitute its subject matter; and their relief and the measure of their relief is what the section will occupy itself with.

So much the section itself tells the reader. Upon which *Lord Coke's rule* and the many cases which have applied it (*e. g.* pp. 15, 16, 17, 18, 19, 21, *supra*) tell him to find out who those persons are; and that, when he has found who they are, they, and they alone, come within its provision and control its construction.

We have no difficulty in ascertaining who they are. They are those whose foreign patents were previous to their American applications, *and no one else* (p. 53, *supra*). To them, the law tells us, the whole provision is directed. This legislation was not for the purpose of creating a disability, it was to relieve those who were already held under one. Those persons constituted its subject-matter.*

The curtailing *proviso* is a part of that section. Is there anything in its nature, or in the language in which it is expressed, requiring that *proviso* to be taken out of the operation of the rule that the

* The particular decisions quoted on the pages referred to were made upon the statutes as they existed before 1870. But the general granting and defining claims of the old law are reproduced verbatim in the revisions of 1870 and 1874, save for some difference in the mere distribution into sections and in a few immaterial matters.

Webb v. *Quintard*, 9 Blatch. 352, 357 [BLATCHFORD, J.]. "These provisions, involving the sixth, seventh and fifteenth sections of the act of 1836, have been in substance re-enacted in the act of July 8, 1870."

We need not consider whether, if the patent act of the revised statutes were an entirely original enactment, modern views would or would not make a foreign patent a bar to a subsequent application of the same inventor, or a stringent *indicium* of abandonment under the general sections. It is enough that down to the revision of 1870 it was generally accepted law that it would be a bar. Remedial legislation, forbidding a certain construction, may well be enacted, though this court should now think that it could have avoided the mischief by interpretation without enactment. That remedial legislation *itself* is to be expounded as if the opinion on which the legislature proceeded were the correct one, for it explains the legislative perspective in enacting the statute; and that is what we look to it for. *Bishop*, Wr. L. 350, *Endlich*, Interp. Stats., §375. *Postmaster General* v. *Early*, 12 Wheat. 136.

The *revision*, of course, must accept the situation as it finds it in the old laws, and must be read in view of the situation as accepted.

remedy is confined to that which calls for it and gives scope for it, — a rule which, with certainty, and inevitably, fixes the scope of the *main clause* of the section, and of the section itself ?

In the 1870 form, — and it is settled that the 1874 form has no wider scope (p. 41, *supra*), — the curtailing clause is not only a part of the same section, but is a part of the same sentence as the enabling clause. Its *nature* also especially requires that it shall apply to the same persons as the enabling clause. Congress wished to relieve those who were debarred by the previous sections ; it must therefore not only enact that they shall be relieved, but must also define the measure of relief they are to receive. So the enabling clause says that they may have a patent, and the *proviso*, or qualifying clause, says that it shall be a curtailed patent.

Moreover, the reader who has reached this point perceives that the enabling clause opens the door to delay, because it removes a bar, one element of which is a time element, and it was therefore both sensible and fair that this *new* privilege should be so qualified that wanton delays in the use of it shall not abnormally increase the burden of the public who grants it.

These are considerations which embody good sense in themselves ; and they are imposed upon us as *legal guides for interpretation* by a host of authorities. They express settled rules of law.

But, besides the solid reasoning on which this interpretation rests, and besides the many applications of it as a general, and, indeed, universal rule, which the authorities furnish, — the rule, that is, that each part of a provision aims at the subject matter which the whole is aimed at, — this canon of interpretation, under one set of circumstances which statutes frequently present, has ripened into a technical rule of the most stringent character. This section, by its form and by its wording so explicitly invokes that rule that the court has no course open except to apply it.

Where a granting clause is followed by a *proviso*, the condition, limitation or qualification of that *proviso* attaches to that which is granted by the granting clause and not to that which existed altogether independently of the granting clause and was not even supposed to be derived from it. The granting clause fixes the **scope** or **purview** of the act ; the *proviso* does not. Verbal logic tells us so

much; but the rule stands higher than grammar; it is a legal rule of construction, derived from the universal habits of thought; it is the rule which applies what is said to the subject the speaker is talking about.

The San Pedro, 2 Wheat. 132, 139. "Wherever this term [purview] is used, it is manifestly intended to designate the enacting part or body of the act, in contradistinction to the other parts of it, such as the preamble, the saving, and the proviso."

Wayman v. *Southard*, 10 Wheat. 1, 30. "The proviso is generally intended to restrain the enacting clause, and to except something which would otherwise have been within it, or, in some measure, to modify the enacting clause."

Voorhees v. *Bank of U. S.*, 10 Pet. 449, 471. . . . "a *proviso*, which in deeds and laws is a limitation or exception to a grant made or authority conferred; the effect of which is to declare that the one shall not operate, or the other be exercised, unless in the case provided."

United States v. *Dickson*, 15 Pet. 141, 165 [*per* STORY, J.]. "We are led to the general rule of law which has always prevailed and become consecrated almost as a maxim in the interpretation of statutes, that where the enacting clause is general in its language and objects, and a proviso is afterwards introduced, that proviso is construed strictly, and takes no case out of the enacting clause which does not fall fairly within its terms. In short, a proviso carves special exceptions *only out of the enacting clause;* and those who set up any such exception, must establish it as being within the words as well as within the reason thereof."

The precise question was whether the proviso clause was to be limited to what was done under the main clause, or whether it should extend to what was done under the authority of other acts. The court held it limited, saying:

Minis v. *United States*, 15 Pet. 423, 445 [*per* STORY, J.]. "The office of a proviso, generally, is either to except something from the enacting clause, or to qualify or restrain its generality, or to exclude some possible ground of misinterpretation of it, as extending to cases not intended by the legislature to be brought within its purview."

"A general rule, applicable to all future cases would most naturally be expected to find its proper place in some distinct and independent enactment."

Savings Bank v. *United States*, 19 Wall. 227, 235. "It is argued, however, that savings institutions were relieved by the proviso to the section. That, of course, is to be construed in connection

with the section of which it is a part, and it is substantially an exception. It takes out of the operation of the body of the enactment that which otherwise would be within it. It restrains the generality of the previous provisions."

Washington County v. *Sallinger*, 119 U. S. 176, 183. A statute provided a new mode of electing county commissioners; it also contained the proviso: "*Provided*, however, that the Board of Commissioners shall not have power, etc."

Held that this limitation of power applies only to a board elected under this statute, and **not** to a board then in office but *elected under a previous statute*.

O'Reilly v. *Morse*, 15 How. 62, 128. Speaking of this foreign patent section of St. 1839, GRIER, J., said:

"*To construe a proviso* as applicable to a class of cases not within its enacting clause, would violate all settled rules of construction. The office of a proviso is either to except something from the enacting clause, or to exclude some possible ground of misinterpretation, or to state a condition to which the privilege granted by the section shall be subjected.

"*Here the proviso is inserted to restrain the general words of the section*, and impose a condition on those who accept the privileges granted by the section. It enlarged the privileges of foreign patentees, which had before been confined to six months, on two conditions:

"1. Provided the invention patented abroad had not been introduced into public use here; and, 2. On condition that every such patent should be limited in its terms. The general words, "in all cases," especially when restrained to every such patent, *cannot extend the conditions of the proviso beyond such cases as are the subject-matter of legislation in the section*. The policy and spirit of the act are to grant privileges to a certain class of persons which they did not enjoy before; to encourage the introduction of foreign inventions and discoveries, and not to deprive our own citizens of a right heretofore enjoyed, or to affect an entirely different class of cases, when the applications had been filed here before a patent obtained abroad."

This was not the majority opinion, it is true; but upon the meaning and scope of this provision and as to this rule of law there was no difference of opinion (p. 58, *supra*).

French v. *Rogers*, 1 Fish. 133, 136, GRIER and KANE, JJ., 1851 (p. 63, *supra*). Suit on the Morse patent.

"The *proviso* of 1839 must be interpreted by reference to the enacting words of the section which it limits."

United States v. *Saunders*, 22 Wall. 492. *Head note.* "A statute is to be interpreted not only by its exact words, but also by its apparent general purpose. **If its general purpose have plain reference to one class of persons**, it will not include a single individual in a distinct class, though the mere words might include him."

Lehigh Co. v. *Meyer*, 102 Pa. St. 479. Sec. 3 gave the court stenographer ten dollars a day for taking notes in court, *proviso*, that his whole compensation shall not exceed twelve hundred dollars. s. 4 directed him to write out his notes at a certain rate of compensation when ordered to do so by the court. Decided that the proviso of s. 3 limits only the per diem compensation of *that* section and does not apply to the compensation of s. 4.

Spring v. *Collector*, 78 Ill. 101, 105. A section contained seven sub-divisions. The fifth of these said: "*Provided*, that no tax shall be levied under this section unless," etc. The court noted that it used the word "*section*" but decided that the proviso limited only the *sub-division* of which the proviso formed part, saying: "Provisos are construed as affecting the paragraph to which they are annexed."*

Ex parte Partington, 6 Q. B. 649, 653. S. 28 said: "*Provided* always, that no debtor shall be imprisoned on any process for more than twelve calendar months." Partington came within the words of the proviso, but the court held "that this case does not fall within the proviso, which must be construed with reference to the preceding parts of the clause to which it is appended." Partington was held by virtue of another clause of the statute.

Approved in *ex parte Partington*, 13 M. & W. 679, on a second *habeas corpus* by the same debtor.

In *re Webb*, 24 How. Pr. (N. Y.) 247,249. "The office of a proviso is not to enlarge or extend the act, or the section of which it is a part, but rather to put a limitation and a restraint upon the language which the law-maker has employed. The effect of the proviso in regard to the oath of the recruit must be therefore limited to the subject of the act of Sept. 28, 1850, which is the army and not the naval service of the United States, and does not affect the present case."

Epps vs. *Epps*, 17 Ill. App. 196, quoted and relied on *United States* vs. *Dickson*. It also quoted with approval from *Roberts* vs. *Yarboro*, 41 Texas, 449. "The rule as established [by statute] extends a privilege to parties, while the exception operates to curtail *that* privilege or right, and should not therefore be extended by construction."

*Of course the printer's division into paragraphs is not of itself always conclusive. In the case at bar, however, the section in question is distinct by subject matter as well as by the sections into which the Revised Statutes are broken.

Endlich, Interp. Stats. § 184. "And as to a proviso, it has been said that its function is that of limiting the language of the law-maker, not of enlarging or extending the act or section of which it is a part."

Ibid. § 186. "From a consideration of the office and function of a proviso, it would seem to follow that it can have no existence separate and apart from the provision which it is designed to limit. 'If it was not intended to restrain the general clause, it was a nullity.' *Ihmsen* v. *Nav. Co.*, 32 Pa. St. 153, 157."

"A proviso is always to be construed with reference to the immediately preceding parts of the clause to which it is attached, and limits only the passage to which it is appended, and not the whole section or act, or, at least, only the section with which it is incorporated."

Ibid. § 124. "An act intended to remove the incompetency of parties to suits and other legal proceedings, on the score of interest, to testify therein, cannot have the effect of rendering incompetent one, who before the act, was a competent witness. *Sheetz* v. *Hanbest*, 81 Pa. St. 100; *Packer* v. *Noble*, 103 Pa. St. 188."

The cases cited in *Endlich* fully bear out the proposition; for in them it was held that the restrictive and partially disabling words applied only to those who would not be competent witnesses except for that particular statute, and could not be applied to affect those who were competent irrespective of that statute.

Sutherland, Stat. Constr., § 223. "It [a proviso] is to be construed in connection with the section of which it forms a part, and it is substantially an exception. If it be a proviso to a particular section, it does not apply to others unless plainly intended. It should be construed with reference to the immediately preceding parts of the clause to which it is attached. In other words, the proviso will be so restricted in the absence of anything in its terms, or the subject it deals with, evincing an intention to give it a broader effect. . . ."

Riders to revenue or appropriation bills, of course, stand upon a special ground, arising out of parliamentary history. They are substantive enactments to which the sovereign is compelled to assent as the price of the subsidy he needs.

But in all such cases the provision, as in the well-known instance of the abolition of flogging sailors (9 St. 515), though introduced by the word "*provided*" or the like, has no relation whatever in its nature or subject to the preceding part of the section, so that it cannot for a moment be thought of as qualifying or affecting it; and is expressed as a clear, distinct, substantive and independent enactment, conveying its full meaning, and obviously to be read without any reference to or aid from the rest of the

statute, just as a picture is independent of the frame in which the shopkeeper places it. But that is not the case here.

The section in the navy bill made an appropriation for ocean mail service, and added: "*Provided* that flogging in the navy and on board vessels of commerce be and *the same is hereby abolished* from and after the passage of this act."

So in St. July 2, 1864, § 3, 15 Stat. at L. 351, the enactment that colored persons and interested persons may be witnesses is in a section which appropriates money to prosecute counterfeiters.

There are other instances where a group of congressmen have forced a law on an unwilling majority by an enactment inserted as an amendment, in a section upon a totally incongruous matter. But such freaks of legislation can never be confounded with a *proviso*, though they may masquerade in its colors.

When, therefore, we ascertain what are the patents from which this section undertakes to lift the bar, we shall know what are the patents which are or may be curtailed by it; we say *undertakes* to lift the bar, for legislation is not unfrequently precautionary, and it is to be construed in view of what it shows that the legislature assumed was or might be the law without it, though to-day we might think differently.

Is this curtailing clause a true *proviso*, **and does this rule govern it?** There can be no doubt on that subject. In the revision of 1870, it is in the same sentence as the main clause, and is introduced by the word "*provided*." But, what is more significant in itself, it refers back to the enabling clause for the definition of its subject matter, which cannot be learned except by that reference; for the curtailing clause does not of itself purport to define its own subject. The language is:

"*Provided* **the same** shall not," etc., "and that **the** patent shall expire."

Indeed, the defendants' argument rests on considering the second clause as a dependent clause, without meaning if taken alone, and referring back to the first to get any significance (*v.* pp. 133–4, *infra*).

It is not upon a subject incongruous to and different from that of the main clause, and without connection between them, as in the case of the enactments just referred to. Clearly and confessedly it

qualifies the enabling clause by curtailing the patents which that clause permits. Both sides agree to that. The difference between us is that the defendants contend that it *also* curtails, that is, in part destroys *the patents granted by the previous general sections.*

But we already know that the *proviso* rule applies to this section. In the *Morse* cases the courts applied it to this very legislation, and said that it conclusively fixed the scope of the curtailing *proviso.* When congress *copied exactly the framework which the courts had said carried that rule with it*, and, still more, when in the margin it cited one of the cases which had applied that rule, it adopted that rule for the interpretation of the enactment it made. As this section is a revision, it is difficult for a lawyer to consider its meaning without doing what all lawyers do, that is, looking back to the statutes from which it is compiled. But it is obvious that the consideration from copying the old framework, has full weight without regard to the rule for the interpretation of revisions.

This rule for ascertaining the scope of a *proviso* is not a rule of mere words or grammar; it stands on a much higher plane. It is the application of a *truth* — that whatever a man says when he is talking of a subject is said with reference to that subject, and not with reference to other matters. There is hardly a writing, hardly a speech, hardly a conversation that would not be distorted from its true sense if that rule were not applied. It is the natural rule; we instinctively apply it. This court has declared that even judicial opinions, doubtless the most careful of writings, would be perverted if read without it. "It is a maxim not to be disregarded," said Chief Justice MARSHALL, in *Cohens* v. *Virginia*, 6 Wheat. 264, 399, "that general expressions in every opinion are to be taken in connection with the case in which those expressions are used. If they go beyond the case" they may be disregarded. This was repeated as an essential rule in *Carroll* v. *Carroll*, 16 How. 275, 287, and other cases. It overrides all verbal arguments.

In *Talbot* v. *Silver Bow County*, 139 U. S. 438, the question was whether an act of congress which authorized "States" and "the legislature of each State" to tax shares in national banks, authorized a *Territory* to tax them. The court conceded that the *words* were against giving that authority. "On the face of the language the

word 'State' would seem to refer, not to political communities in general, but to those particular communities which form the States of the Union" (pp. 444–445). From the *nature of things*, it said, the authority ought to extend equally to all legislatures; and *this being so*, before any statute can be construed otherwise (p. 443):

"Its language must *imperatively demand* such construction. . . . No such intent ought lightly to be imputed to congress.

"Further, it is a general rule in the construction of statutes that when in the earlier and declaratory sections the scope and extent of the power and privileges granted are once stated, the character of the grant as thus disclosed controls and interprets all subsequent sections."

The corollary of that proposition is also established; namely, that when the question arises whether a particular provision is to be applied to the subject-matter of pre-existing legislation, and thus *control* or in effect repeal it in whole or in part, or whether it shall be interpreted as *supplementary*, acting upon cases or matters not touched by the more general legislation, the latter construction is to be adopted, so as to give effect to both: because "as Mr. Justice STORY says, in *Wood* v. *United States*, 16 Pet. 342, 563, 'it may be merely affirmative, or cumulative, or auxiliary.'" *Chicago Ry.* v. *United States*, 127 U. S. 406, 409. In the same case Mr. Justice STORY also says: "The more natural if not the necessary inference in all such cases is that the legislature intended the new laws to be *auxiliary*," etc.

How the defendants attempt to meet the rule which defines the scope by the subject-matter. They do not attempt to meet it; they ignore it. They set up, as the sole canon of interpetation, a canon for which they pretend no higher authority than that derived from the dictionary and the grammar. Such a rule cannot stand against the *legal* rule of construction. Moreover, upon examination, it is found that neither the grammar nor the dictionary support them.

They agree, as we do, that *some* rule of construction *must* be applied to the curtailing proviso. It contains no explicit definition of its subject-matter or scope. It is, as all provisos are by their nature, a *relative* clause, sending us elsewhere to learn its subject-matter. But the defendants will not follow the *law* which makes the proviso find its subject-matter in *the subject-matter* of the main clause.

They will look at nothing but individual words, and will take the literal meaning of a single word, and not the meaning of the sentence in which it is found. The relative words of 1870 are "*provided*, the same," and "*first* patented in a foreign country." The phrase of the revised statutes form is "*previously patented in a foreign country*." The eleventh word before this is "*application*"; but they say that by a rule of grammar to be found in the *Century Dictionary*, "*previously*" must refer to the event named by the *nearest words* in the sentence (which happens not to be the word "application"), unless the context calls for some other reference. So they refer "*previously*" and "*first*" (in the two forms, 1870 and 1874) to the words "*patent granted*" or "*receiving a patent*"; words which, they say, point to the manual act of delivering the completed parchment, and therefore *imply*, and *conclusively* imply, as date, the exact date of *that* act.

That is their case.

To attempt on such reasoning, in the face of the rule about *provisos*, to carry a proviso outside of the main clause to which it is an appendage, is, as said by Judge COWEN (p. 89, *supra*), to contend that the court shall "follow the rules furnished by Johnson and Murray instead of the rules of law; shall rest upon a verbal or grammatical construction, instead of a legal one." For, as he pointed out, the one invokes the power of construction as well as the other. Such a contention always fails. The *legal* rule itself is for the purposes of giving to the proviso a meaning which the dictionary and the grammar would *not* give; and the cases cited abundantly illustrate this. Nothing but the most explicit, positive and affirmative words, plainly introduced expressly *ad hoc*, will overcome that legal rule; and there is nothing of the sort here. We submit that the contention is hardly more than frivolous where the attempt is, upon grammar and dictionary *implications*, to construe a revision so as to overturn and reverse not only the old law, but all that which made the old law wise and just, and effective to its ends.

The dictionary and the grammar do not support the defendant's contention. They put it as a rule of words, and it must therefore stand criticism on that basis. In the 1870 form, the phrase is:

"No person shall be debarred from receiving a patent for his

invention . . . by reason of its having been first patented in a foreign country; *provided* . . . that *the* patent shall be limited," etc. It is clear that the proviso refers to the main clause for a definition of what is "*the* patent." That, say the defendants, takes us back, not to the clause as a *whole*, but to *two words* in it, "*first patented*." But those words mean nothing by themselves; "first" before what? is the next inquiry.

The language is, "No person shall be debarred by reason of its having been first patented in a foreign country." Words could not more clearly place before the reader the thought that the foreign patent here designated by the words "*first patented*" is a patent which, but for this section, would have debarred him from receiving the American patent. No, say the defendants (we do not quote from them; we state the tenor of their argument) we will take to pieces the clause "debarred from receiving a patent," — though it is a clause which expresses *but one single idea*, a unit, — and, as "*receiving a patent*" stands nearest to "first patented" on the printed page, we will take the event of manual reception as giving the date which "first patented in a foreign country" is to be prior to.

They apply the same rule to the 1874 form. "*Previously patented in a foreign country*" must, they say, refer to the words nearest on the printed page, — "every *patent granted*," — which, they say, are but a repetition of the opening phrase, "*receiving a patent*."

Now there is no rule that words of relative date are to be referred to the event mentioned nearest on the printed page. In the Romance languages, and to some extent in English, there is such a convention about the words "this" and "that" or "the latter" and the "former," when the two are used in contrast, but never about words of time. They are referred to the event *to which the sense of the whole passage takes them*.

The defendants in their brief below, quoted from the *Vicar of Wakefield;* we repeat it with their comment:

"'We now sat down to dinner, which was almost cold; but *previously*, my arm still continuing painful, Sir William wrote a prescription,'

"where 'previously,' [they say] referring to the immediate antecedent, means 'before we sat down to dinner.'"

Not so: the *immediate* antecedent is "was almost cold;" or, if we disregard that, then "sat down to dinner" is the *only* antecedent, and *then* a rule of *choice* between antecedents does not come into play.

But suppose the sentence were:

"We now sat down to dinner, which, as we were very hungry, was soon consumed; but previously, my arm still continuing painful, Sir William wrote a prescription,"

"previously" would still refer to the sitting down, and not to the disappearance of the dinner, though "consumed" is the immediate antecedent.

Their other illustrations are also cases where there was only one antecedent.

But the *legal* authorities they cite are directly against them. We quote from their brief below:

"*Gillespie* v. *Smith*, 13 Penn., St. 65. A Pennsylvania statute provided 'that it shall be lawful for the plaintiff, on or at any time after the third Saturday succeeding the several return days hereinbefore designated, on motion to enter a judgment by default, notwithstanding an appearance by attorney, unless the defendant shall previously have filed an affidavit of defence."

"Construed to mean that the affidavit may be filed any time before the *motion for judgment* [the italics are theirs], the last antecedent before 'previously.'"

Not so. Three dates are presented: (1) the third Saturday; (2) the motion; (3) the entry of judgment. *The decision took neither the first nor the last of these antecedents, but the intermediate one.* The same *literal* rule applied to our case would refer "previously" to the word "application."

Their only other authority on this topic in their brief below is equally adverse to them. The case was as follows:

Fowler v. *Tuttle*, 24 N. H. 9, 22. The question was as to the meaning of an allegation in a declaration in debt against a trial justice for a penalty, for taking an excess of fees for copies. The *first* paragraph alleged that in the case before him he granted an appeal and took a recognizance. The *second* paragraph alleged that he prepared and certified copies of the proceedings, "for which services" he was entitled to receive $1.68, but charged and received more.

"We think it quite obvious and clear that the relative, 'which services,' found in the last paragraph, referred only to the services previously described *in the same paragraph*," *i. e.*, the copies.

The *third* paragraph averred that he took a greater fee "for said services." This also refers to the furnishing copies in the paragraph next preceding, and not to granting the appeal, etc., of the paragraph before that.

The court then stated the general rule that a relative usually refers to the nearest antecedent, but proceeded to say that as there were *two* previous averments, either *might* be the true antecedent, and the meaning was to be got by a fair consideration of the *real* meaning of the writer. It said (p. 22):

"Here the reference **might** be to the services rendered in granting the appeal and taking the recognizance alone, or it might be to those services, together with the services rendered in preparing the copies, or it might be to the services rendered in furnishing the copies only. But the question is, what was the antecedent to which the *pleading* refers? And we think upon a **fair** and **legal** construction of the declaration, the latter branch of the services mentioned must be taken to be the antecedent referred to by the relative next succeeding it."

So the defendants' authorities bring us back to the true rule; that it is the **sense** of the thing and not the grammar which gives us the true reference.

Endlich, Interp. Stats., § 414, says of the rule of reference to the *last* antecedent:

"But this technical, grammatical rule is liable to be displaced whenever the subject-matter requires a different construction, in obedience to the principle elsewhere discussed, that rules of that character are subordinated to a common sense reading of an enactment."

It is, of course, a general rule that **a phrase twice used in the same section designates each time the same subject-matter**; and especially must it be true that a phrase in a *proviso* or dependent clause means the same as when used in the main clause. Now, in the revised statutes form, the *main* clause declares that

"no one shall be debarred from *receiving a patent* for his invention by reason of its having been *first patented* in a foreign country."

The *proviso* reads:

"But every *patent granted* for an invention which has been *previously patented* in a foreign country," etc.

The phrases are identical. In both, equally, the foreign patent contemplated is indicated by words of relative priority, "*first patented*," "*previously patented*." In both, the phrase to which each time relative refers is, on the defendants' rule, the same, "*receiving a patent*," "*patent granted*." Now we *know* what patents constitute the subject designated by these words in the *main* clause, and what the legislature contemplated as that subject. How is it possible to make them designate *different* patents in the second clause? In the main clause they mean foreign patents which precede the American *application* and do *not* include Mr. Bates' case. How can one say that the same phrase, used a second time in the same section, and used that second time in a dependent *proviso*, has a wider scope, and includes Mr. Bates' case?

Higher elements of interpretation may overrule mere verbal elements. But the defendants' whole argument is based on an alleged compulsory *verbal* construction. They cannot meet this consideration which we have thus insisted upon.

But the defendants are entirely wrong as to the import of those words taken by themselves. For these very phrases '*receiving a patent*," "*patent granted*," on which they rely as *necessarily* carrying the mind to *issue* date, as distinguished from *application* date, because literally they apply to the act of manual delivery, are phrases constantly used, in a general sense, applicable to the process of "patenting" viewed as one whole from application to grant, *and have been repeatedly used both by the courts and by congress when they meant date of application.*

They are so used in this very section. The main or enabling clause in which they are found has for its sole subject-matter patents *applied for* here after the foreign grant. The defendants' case, therefore, depends upon using those words to *give to the relative clause which refers to them a signification not possessed by the clause of which they form a part.*

It is absurd to say that such words *compel* a court to put into this legislation a meaning which carries such consequences.

The following are instances of such use:

Instances where words which literally refer to the manual delivery of a patent have been used to express the application date.

Use in this Court. In every one of the following cases the disability under consideration was one which barred or limited a patent to the true inventor because of matter subsequent to his invention; and in every case the date really referred to was the **date of application,** — this without dispute or question. They are, we submit, absolutely conclusive against the defendants.

Three cases have used the phrases: "*prior* to his American *patent*"; "*patents* for inventions *previously patented* abroad"; "*previous* public use of an invention invalidates a *patent*"; which may be said to be literally the phrases of our section; but in each case the jurists who used them, used them to mean previous to the *application*.

But some of the cases are even closer still. The defendants' entire case is that the revisers and congress *could not* have used those words to re-express the law of 1839, and *must* have used them for the purpose of changing it. Now, learned jurists have several times used *exactly those words* in order to state the law of 1839, understanding the application date to be the date meant.

Thus Justice BRADLEY stated St. 1839, in just such language: "The term of a patent for an invention which has been patented in a foreign country, etc." It is, therefore, impossible to deny that, especially as to a paragraph which is not in any way explicit, congress might well have read the words in a revision with the meaning which justices of this court have used them to express in carefully written opinions.

Pennock v. *Dialogue*, 2 Pet. 1 [1829], *Webster, arguendo:*

"3. That the jury should have been instructed, that, if they found the riveted hose, which was in use by the hose companies, had been all made and sold by Jenkins, and by no one else, *prior to the grant of the patent;* and that he was permitted by the inventors, under their agreement, so as to make and sell the same, etc. (p. 5).

"4. That if they found the hose had not been made or sold, *prior to the grant of the patent*, by any person but Jenkins, then the giving of permission to him, being in itself an assertion of claim, was not a dedication to the public," etc. (p. 5).

Sargeant, arguendo, spoke of a public use "from 1811 to the *time of granting* the patent," "*before the patent.*"

Grant v. *Raymond*, 6 Pet. 218 [1832; MARSHALL, C. J.]. "On the trial evidence was given to show that the patentee had permitted the invention to be used *before he took out his patent.*"

Shaw v. *Cooper*, 7 Pet. 292 [1833]. Head notes:

"By the provisions of the act of congress of the 17th of April, 1800, citizens and aliens as to patent rights are placed substantially upon the same ground. In either case, if the invention was known or used by the public *before it was patented*, the patent is void. In both cases the right must be tested by the same rule."

"No matter by what means an invention may have been communicated to the public *before a patent is obtained*, any acquiescence in the public use by the inventor will be an abandonment of the right," etc. (293).

Paine, arguendo: "Before we *took out our first patent* the invention had never been seen nor heard of in this country" (p. 299).

Emmett, arguendo: "The principle upon which *previous public use* of an invention invalidates a *patent* undoubtedly is that the inventor can no longer give any *consideration* or *equivalent* for the exclusive privilege claimed by him," etc. (p. 306).

"It would appear that, even to the mind of the plaintiff's counsel, this view of the case is conclusive, unless the fact of the invention having got into public use *before the first patent was taken* out can be shaken" (p. 307).

Opinion of the court, per MCLEAN, J. "It would seem, from the above provisions, that citizens and aliens, as to patent rights, are placed substantially upon the same ground. In either case, if the invention was known or used by the public *before it was patented* the patent is void" (p. 316).

"The question arises from these facts, and others which belong to the case, whether there was such a use in the public of this invention *at the date of the plaintiff's first patent*, as to render it void" (p. 316).

"This was a case where a second patent had been obtained, the first being defective, and this, it would seem, was deemed sufficient to protect the right of the plaintiff, though the public had been in possession of the invention for six years *before the emanation of the second patent*" (pp. 317, 318).

"No matter by what means an invention may be communicated to the public *before a patent is obtained*; any acquiescence in the public use, by the inventor, will be an abandonment of his right" (p. 320).

"On this principle it is, that a discoverer abandons his right, if *before the obtainment of his patent*, his discovery goes into public use" (p. 321).

"After his right shall be *perfected by a patent*, no presumption arises against it from a subsequent use by the public" (p. 321).

"A strict construction of the act, as it regards the public use of an invention *before it is patented* is not only required by its letter and spirit, but also by sound policy" (pp. 321, 322).

"There was no legal obstruction *to his obtaining a patent* in the year 1819" (p. 322).

"For three years, *before the emanation of his patent*, his invention was in public use, and he appears to have taken no steps to assert his right" (p. 322).

The opinion also quotes from *Morris* v. *Huntington*, 1 Paine, 354, the following (p. 317):

"No man is to be permitted to lie by for years, and then *take out a patent*.

"If he has been practising his invention with a view of improving it, and thereby rendering it a greater benefit to the public, *before taking out a patent*, that ought not to prejudice him. But it should always be a question submitted to the jury what was the intent of the *delay of the patent*, and whether the allowing the invention to be *used without a patent*, should not be considered an abandonment or present of it to the public."

Two head notes in the case of *Shaw* v. *Cooper*, in the Brodix edition (4 Brodix, 286), are:

"5. Under Act 1793 any acquiescence by the inventor in the public use of his invention *prior to obtaining a patent* is an abandonment, but his acquiescence can in no case be presumed where he has no knowledge of such use."

"8. Patent granted Shaw, June 19, 1822, reissued May 7, 1829, for percussion gun, held to have been in public use with inventor's consent *prior to the grant of his patent*, and was abandoned."

Two head notes to the case of *McClurg* v. *Kingsland*, in Brodix (4 Brodix, 382), are:

"4. Where an inventor permits the use of his invention by his employers, *prior to patenting* it could well be held an abandonment by public use, in view of the decision in *Pennock* v. *Dialogue*, 2 Pet. 7," etc.

"5. *Where prior to patenting* the inventor fully acquiesces in the use of his invention by his employers, it raises the presumption of a license from the inventor to continue its use subsequent to the grant of a patent."

Siemens v. *Sellers*, 123 U. S. 276. The patent was granted before 1870, and came under Sts. 1836 and 1839. Under them, date of application alone was to be considered. There was no dispute about this, and Justice BRADLEY had just stated it in the opinion. On the next page he re-stated this in language which, *grammatically*, made "patent" and not application, the test date (p. 285):

"We are of opinion that the condition imposed by the act of 1839, that the term of a *patent for an invention which has been patented in a foreign country*, shall commence to run from the time," etc.

P. 286, "referring either to the issue of the American patent itself, when no foreign patent had been *previously* obtained, or that of the latter when such a patent had been obtained."

Observe that this statement of the law of 1839, *and the next following, use the precise phraseology by which (we say) the revision restated it.*

Ex parte Siemens, C. D. 1877, p. 41 [SPEAR, *Com'r.*]. "Under the act of 1839, which was amendatory of the act of 1836, *patents* were limited to fourteen years from the date or publication of *foreign patents previously obtained*."

Weston v. *White*, 13 Bl. 364; C. D. 1876, p. 415 [SHIPMAN, J.]. The patent was granted in 1867, under St. 1839, s. 6. Judge Shipman thus described that act:

"The proviso of s. 6, St. 1839, that where a foreign patent had been granted to the patentee, *prior to his American patent*, the latter should be limited to the term of fourteen years from the date of such foreign letters patent," etc.

This again is almost the language of the section we are construing.

Badische Aniline, etc., v. *Hamilton Co.*, 3 B. & A. 235; C. D. 1878, p. 185 [SHEPLEY, J.]. The patent was granted before 1870. The court said:

"The act of March 3, 1839, provided that, in all cases where a patent shall be *granted* after the same invention shall have been patented in a foreign country."

Again, the phraseology of the statute —

De Florez v. *Raynolds*, 17 Bl. 436; 8 Fed. R. 434; C. D. 1880, p. 289 [BLATCHFORD, J.]. The patent in suit was of 1864. Describing the law *before* 1870, the court said:

"*Patents* for inventions *previously patented abroad* to the same inventor were limited," etc.

The exact language of R. S. 4887!

In *Bate* v. *Gillett*, 13 Fed. R. 553, 555; C. D. 1882, p. 426, NIXON, J., said: "It is true that the 8th section of the act of 1836, and the 6th section of the act of 1839, made the date of filing the specifications and drawings in the one case, and the date of the application for the home patent in the other, the point of time from which to reckon the six months intervening between the *issue of* the foreign and *domestic patent*."

Here the date designated by the phrase "domestic patent," or "issue of the domestic patent," whichever way it be read, is the date of *application*. The statute is explicit, and Judge Nixon's opinion shows that he so understood.

Here, then, are a host of cases, where, dealing with the precise subject, eminent jurists have used the phraseology of the revisers, sometimes, it happens, the exact words of the revisers, when they meant *application* date. Some of the judges used them not *alio intuitu*, but **to express the meaning of the very statutes of 1836 and 1839 which the revisers meant to express.** We repeat then:

St. 1870. "No person shall be debarred from *receiving a patent* for his invention by reason of its having been *first patented*," provided, etc.

R. S. 4887 copies the foregoing and also duplicates it in the proviso by the phrase: "*Patent granted* for an invention which has been *previously patented* in a foreign country."

BRADLEY, J. "The condition imposed by the act of 1839, that the term of a *patent* for an invention which *has been* patented in a foreign country, etc."

"Referring either to the issue of the American patent itself when no foreign patent had been *previously* obtained, etc."

SPEAR, *Commissioner of Patents*. "Under St. 1839, *patents* were limited to fourteen years from the date of foreign patents *previously* obtained."

SHIPMAN, J. "The proviso of s. 6, St. 1839, that when a foreign patent had been granted to the patentee *prior* to his American *patent*, etc."

SHEPLEY, J. "St. 1839 provided that, in all cases where a patent shall be *granted* after the same invention shall have been patented in a foreign country, etc."

BLATCHFORD, J. "*Patents* for inventions *previously* patented abroad to the same inventor, were limited, etc."

Consider the weight of these precedents. Our opponents' whole case rests on the proposition that when the revisers used the word "*previously*," with "patent" or "grant," as its grammatical antecedent, they *could* not have meant to restate the old law. Yet these learned judges used exactly that word, in exactly that relation to exactly those verbal antecedents, as a statement of the old law.

Such expressions doubtless lack absolute verbal accuracy; but they mislead no one who reads them with an intelligent knowledge of the subject, as revising statutes are to be read, and as statutes in a long course of legislation are to be read. But the whole argument of our opponents is that they absolutely **compel** the opposite meaning; more exactly, that no educated man, such as a congressman, can be believed to have used them except with a clear intent to reverse the old meaning. We *know* from the proceedings (p. 70, *supra*), that congress did not read them as a reversal; and will any one say that Webster and Sargeant and Chief Justice Marshall and the late Justice Bradley or the other judges were careless in thought or slovens in language; or that it is *impossible* for words to mean what *they* have again and again used them to mean?

In these decisions and others, the phrases *before his patent*, *patenting his invention*, *obtaining his patent*, and even *prior to the grant of the patent*, are used to express the whole procedure, *thought of in general terms as one act*. They are used as general phrases capable of including all dates in that procedure, but in each of these cases referring to application date.

Indeed, it is a natural use of language, where a proceeding occupies considerable time, to express it, as a *whole*, by a word which literally means the culmination of it; and when in such case we connect another thought with it by the word *previously*, we mean previously to the inception. Instances will readily occur to the reader. For example, "I said good-by to my old friend at his house, but previously to doing so, I paid my passage to China." It

is not the utterance of the words at the end of the visit, but the beginning of the visit, that is referred to. The Vicar's prescription, and the Pennsylvania case on pp. 135–6, *supra*, are similar instances.

Moreover, whenever legal writers speak of matters, delay in which may impair or diminish the inventors' right, though the words refer to the *patent* which is the act of the commissioner, they *mean* the act of the inventor — an act the time of which he controls. *That act is the filing of the application.* They are right. **When the inventor has done that, he has patented the invention, so far as in him lies.** That is the only act which is his.

It is not incumbent on us to show that the *words* alone *compel* our reading. It is enough if they do not explicitly and absolutely preclude it.

Use of the Words by Congress. On pp. 107–8, *supra*, we have pointed out several instances in which congress, striving for condensed expressions, — the effort in which the revisers are alleged to have failed, — has given ambiguous or directly erroneous references to dates. There are others.

"Previously" and its alleged grammatical relation back are here relied on by our opponents. This statute repeatedly uses the word "*before*" and other relative words of time, and in every section they are construed according to the nature and justice of the case, without regard to mere grammatical relations.

R. S. 4892 enacts that "the applicant shall make oath . . . that he does not believe that the same was ever *before* known or used." Grammatically, that certainly means before the application to which the oath is attached; and grammatically the word qualifies equally "known" and "used"; but the courts make it read: not known to any one before his *invention*, and not used more than two years before the *application*. See p. 107, *supra*.

R. S. 4926 employs the very phrase our opponents rely on,—"when the patent was granted," — to refer to date of *application*. It permits an extension only if "the invention was *new* and *patentable* when the original *patent was granted*." That means new at the date of *invention*, and patentable, *i. e.*, not barred by public use or the inventor's delay, when the *application* was filed.

Thus, though the statute uses the words "when the patent was *granted*," *neither* of the dates thereby designated is the date of *grant*.

Verbal Comparison of the Originals and the Revision.

It is perhaps not unprofitable to make a comparison of the verbal framework of the older sections and the revision, because that comparison, by showing how the revision came to be what it is, dispels all possibility of finding an intent to change. We omit words immaterial for our present purpose:

St. 1836, s. 8.	St. 1839, s. 6.
Nothing in this act contained shall be construed to deprive an inventor of the right to a patent for his invention, by reason of his having previously taken out Letters Patent therefor in a foreign country	No person shall be debarred from receiving a patent for his invention by reason of the same having been patented in a foreign country
within six months next preceding the filing of his specification.	more than six months prior to his application, *provided*, that the same shall not have been introduced into public and common use in the United States prior to the application for such patent. *and provided also*, that in all cases every such patent shall be limited, etc.

Each old statute has, first, a bar-lifting or *enabling* clause, the language of which, in the part we have separated from the rest, includes *all* cases where a bar previously existed. These enabling clauses are in substance and in effect the same in both. A consolidating statute would therefore copy either of these, and by preference would take the latest form. The revisers did *exactly* this.

Each statute has next a *qualifying* clause. By virtue of these qualifying clauses, St. 1836 relieves those who apply *within* six months: St. 1839 relieves all who apply *after* six months. The two together include everybody: and therefore, adding the statutes together, the universal words of the enabling clause, taken alone, — "*No* person shall be debarred" — express exactly the sum of the two statutes; these two complementary limiting clauses should therefore be omitted. The revisers did *exactly* this.

There remain the final, or *proviso*, clauses of 1839. The first is to

prevent patenting an invention already in public use, and accords with the principle of the general section. It should, of course, be retained; and it was reproduced *verbatim*. Next comes the *curtailing* clause: that clause is to prevent abuse of the right conferred by the enabling clause; it must be retained; and it was retained. In St. 1839 it was couched in a relative form, "provided that in all cases every *such* patent shall be limited." The revisers also wrote it in a relative form, "provided that *the* patent shall expire;" and in each case it relates back to the same antecedent, namely, the patents granted by the enabling clause.

Now let us compare what we have deduced as the exact sum of these two original statutes, expressed in the language of 1839, with the language in which the revisers expressed that sum.

1839.	Revision of 1870.
No person shall be debarred from receiving a patent for his invention by reason of the same having been patented in a foreign country; *provided* that the same shall not have been introduced into common and public use in the United States prior to the application for such patent; *and provided also* that in all cases every such patent shall be limited, etc.	No person shall be debarred from receiving a patent for his invention by reason of its having been first patented in a foreign country; *provided* that the same shall not have been introduced into common and public use in the United States prior to the application and that the patent shall be limited, etc.*

Could a revision speak on its face more anxious care to preserve the old meaning?

But just here, and because of this care, came the verbal variation on which the defendants build their whole argument.

In the old statute, the *public use* proviso happened to contain the defining date *in terms;* and the revisers, copying it *verbatim*, of course reproduced the defining words. No one doubts that there they reproduced the same meaning.

In the old, the *curtailing* proviso does *not* contain the defining

*The committee, by an amendment *eo nomine*, changed "shall be limited" to "shall expire" because O'Reilly *v.* Morse had decided that the latter was the true meaning (p. 62, *supra*).

date in express terms; and the revisers' proviso, copying the old *verbatim*, of course does not contain defining *words*. But the definition was *there*, in the old; can anybody doubt that when the revisers reproduced the old clause *verbatim*, and when congress re-enacted the old clause *verbatim*, they reproduced and re-enacted the *meaning* of the old clause? Did they carefully copy the old words to preserve their *beauty* or to preserve their *effect?* They did more than copy the words; *they copied the whole framework of the paragraph.*

In the old, and in the new, the curtailing proviso identifies the class to which it applies only by relation back to the antecedent or enabling clause. That the patents which the enabling clause touched were those *applied* for here *after* the foreign grant we know, because there were no others on which a bar had ever rested. In the forms of 1836 and 1839, the qualifying clauses, "within six months" and "more than six months," also mentioned the application, in words. When the consolidation omitted, and properly omitted, those clauses, no verbal troubles, even, arose as to the *granting* clause. It still touched the same and no other patents, *because there were no others which could be touched.* But when we come to carry back the relative clause of the *proviso*, we find, says the verbalist, that the antecedent words are "receiving a patent," — the words alike of 1839, and 1870, — but that now the word "application" is no longer to be read alongside of them.

That is not even a verbal argument, but the mere ghost of a dead one! The enabling clause still embraces exactly the same patents as before; **does it not still mean, as antecedent, exactly what it means as grant?** Shall you read it, when you have it in hand, as embracing one class; but when you look back upon it, under the direction of a phrase which in effect is "the aforesaid patents," must you read it as embracing also another class? At least, even the merest verbalist might permit us to hesitate a moment. And that is enough; for these defendants, if they hesitate a moment on the meaning, are lost; because the other elements of interpretation which instantly come in, which we think must always be reckoned with, are overwhelming.

We have already pointed out that what the defendants rely on as

the crucial phrase of the curtailing proviso is copied from the main, enabling clause, and must have the same meaning (p. 137, *supra*). As a verbal criticism this answers any argument based on words. But it is more than mere verbal criticism: that is, it does not depend upon dictionary or grammar. It rests upon the far higher ground of substance (*v.* cases, *supra*).

Still again:

This section of R. S. **makes three comparisons of dates**; that is, it indicates three classes of acts which, if done before a certain date, will, or but for the help of this section would, forfeit or diminish the right.

First patenting abroad, and *prior* public use, it contemplates as two destructive acts, and *previously* patenting as limiting. The first of these certainly contemplates date of U. S. *application* as the date to be prior to, though its words, verbally, might refer to instant of delivering. The second contemplates the same date, and in terms indicates it. The whole system of law made that the crucial date. On that date the legislative mind had been dwelling as the crucial date for this section; certainly it did not, in a proviso, suddenly shift to an act of a different character, done by a different person, — the act of the commissioner in issuing the patent, and not the act of the person who was to be punished for delay.

"**Cogent Words**" — **What they are.** The defendants insist that the words of the section are too cogent to permit of construction. As already pointed out, that argument itself involves construction, and so it fails (*v.* p. 133, *supra*).

But what words are "**cogent**" to override other elements of construction? Is it not enough that the section contains words which, read by themselves alone, convey a plain meaning? Abundant cases are cited on pp. 15-21, 29, 31, 37, 40, 87-97, *supra*, where the court has declared that the words *by themselves* raised no doubt whatever; but other elements have raised the doubt and have compelled an interpretation against the natural meaning of the phrase read alone.

Few cases can show the other elements so strong as here, nor the words so weak. A grammatical rule of reference, it is said, — but the rule they offer is a false rule, — carries us to "receiving a patent"

and "patent granted." These words are relied on to impose on the statute date of *issue* of the American patent.

In *Siemens* v. *Sellers*, p. 30, *supra*, the words were, "*all* patents shall remain in force for seventeen years from *the date of issue*." On the face of the sentence, these words are vastly stronger than those in our section; taken *by themselves*, they are explicit. Yet the court justly held them totally insufficient to change the old law.

This case is a valuable one for us. Congress, with a carelessness not unusual, had failed to define its thought. But there could be no doubt what its thought was. If the court had decided otherwise than it did, it would, in effect, have said to congress: It is perfectly plain what you mean; but we have caught you in a careless use of language, and will turn it against you. And *that* statute was not a revision, around which, as Judge COWEN said, the law keeps all the old lights burning.

In *Gandy* v. *Maine Belting Co.* (p. 20, *supra*), the court declared that the *language* of the statue, taken alone, included public use *everywhere*. But from other elements of interpretation, gathered from other sections, it raised a doubt, and by virtue of those sections in read into the language to be construed a restriction which congress had not placed *there*.

Words are not **cogent,** *because their meaning is plain.* To be cogent, at least to be cogent to control other elements of any strength, they must amount to a positive, and an *affirmative* statement, explicit in terms, obviously introduced for the express purpose of stating the meaning contended for. The omission of a qualifying phrase never makes a sentence cogent against the old meaning, if other elements of any value oppose the change (pp. 25, 28, 38, 93, *supra*). Of course this is especially true of the language of a revision.

IX. English Decisions upon a similar Question under the English Statute.

A most pointed support of the rule of interpretation that forfeitures or curtailment of patents, no matter what be the language of the statute, are to be limited to cases where the act delayed is the inventor's act; and that the application, and not the issue of the patent, is to be so regarded, is found in some recent English adjudications.

We have already pointed out (p. 105, *supra*), that the English statute of monopolies in terms designated "the time of *making* such letters patent and grants" as the critical date. But the interpretors of that law, in order to prevent the injustice of forfeiture during the delay of the public officers, invented a fiction by which they overcame the words of the statute and carried back the critical date to an earlier period. The same spirit has enabled the English courts, in recent times, under statutes, one of which is the analogue of the section here in controversy, to prevent, by interpretation, exactly that wrong which the defendants here ask this court, by interpretation, to inflict upon us.

Under the English Act of 1852, as previously, an application goes through the attorney-general's office, and receives his approval, and then goes to the Lord Chancellor's office where the patent is signed and the great seal affixed. Opponents can, under certain circumstances, raise a contest both in the attorney-general's office and in the Lord Chancellor's office. Sect. 20 provided that no patent shall be valid unless actually granted within the *six* months of provisional protection which runs from date of application,

"save that where the application to seal such letters patent has been made during the continuance of such provisional or other protection as aforesaid, and the sealing of such letters patent has been delayed by reason of a caveat or an application *to the Lord Chancellor* against or in relation to the sealing of such letters patent, then such letters patent may be sealed at such time as the Lord Chancellor shall direct"

In *Johnson's Case* (L. R., 13 Ch. Div. 398; *Goodeve*, 602) the papers were not brought to the *Lord Chancellor's* office until after *seven* months, and the application to seal, which is made in the Lord Chancellor's office, was after the six months' provisional protection had expired; moreover, in *that* office there was no opposition nor delay; so that the case was not within the words of either branch of the section. The delay had been owing to proceedings in the *attorney-general's* office, and was not the fault of the petitioner. But the notion that the petitioner should be made to suffer from a delay caused by the neglect of officials was so odious in the view of Lord Chancellor CAIRNS that he did not hesitate to say that he should

construe the statute as intending to relieve the applicant from the consequences of delay caused by opposition at *any* stage.

Holste v. *Robertson*, L. R., 4 Ch. Div , 9; *Goodeve*, 260. Sect. 24 of the same act provides that a patent sealed on one day may be antedated to the day of application. It, however, carefully distinguished between the "*date*" and the time of actual "*grant*." Thus: Patents are to have the same validity, as against public use or publication, "as if they had been sealed on the day as of which the same are expressed to be sealed and *bear date*"; but no suit shall be maintained "in respect of any infringement committed before the same were *actually granted*."

With this clear distinction between "date" (which, in fact, means date of application) and "actually granted" which means date of issue, s. 25 enacts that an English patent to a foreigner for an invention which he had patented abroad "before the *grant* of such letters patent" in England, becomes void when the foreign patent dies or lapses. Yet the court made "grant," in s. 25, equivalent in meaning to date of application, in order to save the patentee from the limiting effect of a foreign patent.

X. Action of the Patent Office under the Section in Controversy.

On such a question as this, the opinion of a Commissioner of Patents is, of course, insignificant as an authority. The value of the patent office action lies however in its demonstration that the defendants' reading of the section cannot be conformed to by the patent office in carrying out the examination system established by the same statute.

The original belief was that St. 1836 made it the duty of the commissioner to specify the limitation in the patent. In 1853, this court decided that the patent was valid although he had not done so. Nevertheless the patent office has never reconciled itself to issuing a patent purporting baldly to be for seventeen years when, in fact and in law, it was for a much shorter term. So the practice early grew up of appending to the grant a memorandum stating that the term was subject to the limitation imposed by the statute and such and

such foreign patents. In order that this might be done, the inventor has been required to state in his application what patents had then been issued to him abroad. This rule and practice (which had existed for many years previously — the Rules of 1870, the first published after the enactment of the statute authorizing "Rules," contained it) happened to come before the Secretary of the Interior in *Ex parte Tourtillin*, C. D. 1879, p. 4, and was by him pointedly approved.

There was no practical difficulty in executing *this* rule. The applicant would generally know whether he had taken a patent abroad, and, with the usual length of pendency in our office, our officials, before issuing the patent, would know, from the bulletins of the foreign offices, whether the invention had been patented elsewhere before the *application* here. And so the memorandum which the office inserted in the patent could be relied on as telling the truth.

When the *Bate case* in its early stages had given some currency to the notion that the date of American *issue* was the critical date, the office *first* made a rule (April 18, 1888, rule 46, par. 2) that, when the patent was "allowed" and the final fee paid, the applicant shall file another oath stating what foreign patents have been taken out up to that time; because, while the office refused to so limit patents in terms, it felt bound to give the courts the information which any of them said was material.

But it is apparent, and has always been recognized, that the applicant (who may be an assignee) often cannot know, and the office never can ascertain, what patents have issued abroad down to the moment of actual issue here. On the defendants' reading, therefore, it must issue patents, the duration of which *it* cannot know, and the duration of which those who would buy them cannot know. Congress *can* so make the law; but there is a considerable presumption that it has not done so, when for nearly forty years the old statutes embodied an excellent plan, free from that evil.

Congress, perhaps, *can* order such a thing; but one needs to be very sure that congress has done it, before imputing such a folly to it.

Thus the patent office *practically* interpreted the statute as we do. Moreover, in *Ex parte Mann*, C. D. 1880, p. 57, Com'r PAINE

decided that the contrary view was inconsistent with the rest of the statute, and that our view was the correct one. No subsequent decision of any commissioner has reversed this. Afterwards, Mr. Paine, having left the office and resumed practice, wrote, on behalf of a client, to Com'r MARBLE, saying: "I doubt the correctness of my conclusion," and inquiring whether the American patent must refer to foreign patents issued between the American application and the American grant. Commissioner Marble replied rather drily (July 22, 1880) that the rule required a statement of foreign patents existing at the date of application, but no further statement; and his opinion on the subject will best be learned from the fact that, with his attention thus called to the matter, it was not until 1888, after ten formal revisions of the rules, that this rule was changed by a later commissioner to one requiring the additional oath nearer the issue date. What the office actually does is to issue a seventeen-year patent, append a memorandum of the foreign patents it knows of, and let the law and the courts discover the result.

CONCLUSION.

The court is to choose between two interpretations of a section of a revision, which certainly is a loosely drawn section and, throughout, calls for construction.

The older enactments on this precise subject embodied a plan which was fair, sensible, and exactly adapted to meet the need which gave rise to it. This legislation concerned itself with a minor feature of a great system, and was originally expressed in provisions which, not disturbing the general and more ancient provisions of the law, exactly fitted into the gap they left and rounded out the system in harmony with all its leading thoughts, without repugnancy to any of its specific parts and directly in its line of growth towards greater liberality. Its curtailing proviso, expressed as a proviso, confined itself to the subject-matter of the particular legislation of which it formed part, and did not undertake to reach out and interfere with the great, controlling, and older portions of the law. It was so expounded by judges who praised it for these merits. In so doing they pointed out that it possessed them, because, in accordance with the fairness

and wisdom of other parts of the patent law, it took *application* date and not *issue* date as its criterion. And they showed that by its very framework it declared itself to be supplementary legislation, with a *proviso*, limited because it was a proviso, to the same patents its enabling clause allowed, and touching none others.

Revising commissioners, ordered by statute to consolidate but not to change, undertook to perform their office on these enactments — then more than thirty years old. They reported that their draft was a true consolidation, working no change. The revision committee of congress and the patent committees of congress confirmed this; and congress so accepted the revision and enacted it. A comparison of the revision with the old statute shows the care taken to make it truly a consolidation of the old. Its phrases are copied from the old. The framework which the courts had pointed out as giving its special meaning to the old — that meaning which we read in the new — is exactly preserved. Its only omissions were of phrases which the process of consolidation seemed, naturally, to render superfluous.

But the defendants say that the revision has overturned and reversed the law. That it has done it not by changing an unregarded or hidden feature, but by reversing the plan upon exactly that point which earlier decisions — one of them cited in the margin of the Revised Statutes — had shown to constitute the keynote of the plan and of its merits — the selection of the application date as the critical date.

Sixty years before this revision was made, it was laid down as settled law which should be applied to all future revisions, that if the legislature, in making them, wished to change the old law, it must manifest that intent by the most clear, explicit and affirmative language. There is nothing of the sort here. *Implications* from the grammar and the dictionary are all that are relied upon by our opponents. They are elements of construction too weak in their nature to be of any weight against this case. But a simple analysis shows that the strictest rules of verbal construction in most part imperatively call for, and in all other parts permit, our reading.

A clear and affirmative intent to change must be found. This court *knows* with *absolute certainty* that congress intended *not* to

change, and that it read the words which are now to be construed as words which made no change. Even embarrassing language would not compel the court to find such a change. In the words of a great chancellor, it will use the art of the law to give effect to the intent of the parties. The *law* calls upon it, if need be, to be even "curious and subtle to invent reasons and means" to carry out that intent.

The judicial duty and the spirit which should guide its performance in this case are well known in the history of this court. In *Postmaster General* v. *Early*, 12 Wheat. 129, 152, the court, by Chief Justice MARSHALL, said:

"The court has felt the pressure of this part of the case. There is always difficulty in extending the operation of words beyond their plain import; but the cardinal rule of construction is that, where any doubt exists, the intent of the legislature, if it can be plainly perceived, ought to be pursued. It is also a rule that the whole law is to be taken together, and one part expounded by any other which may indicate the meaning annexed by the legislation itself to ambiguous phrases."

In Pennock v. *Dialogue*, 2 Pet. 1, 23, it said, through Judge STORY:

"It is admitted that the subject is not wholly free from difficulties,"

and, having stated its conclusions, it gave its reasons:

"In this view an interpretation is given to every clause of the statute, without introducing any inconsistency or interfering with the ordinary meaning of its language. No public policy is overlooked; and no injury can ordinarily occur to the first inventor, which is not, in some sort, the result of his own laches or voluntary inaction."

In *Wilson* v. *Rousseau*, 4 How. 646, 678, it thus condemned the interpretation it refused:

"The difficulty attending this construction lies in the uselessness of the clause upon the hypothesis, — the failure to discover any subject-matter upon which to give a reasonable operation and effect to it."

If there were no other guides, these must carry the court to our interpretation. By such guides the patent law has been created as a working system; through them it must be preserved.

It has been suggested that, if the court will only give some meaning to this statute, it is of no consequence whether its decision be right or wrong; for future inventors can govern their actions accordingly, or congress can change the law. But it is of great consequence to Mr. Bate whether his valid patent is destroyed or not; and it is of more consequence to this court itself how it decides. The patent law has grown to be what it is, the most philosophical and consistent branch of the law, because this court has felt that on it lay the responsibility of making it so; and it has spared no pains to that end.

The question of the meaning of the extension statute (St. 1836, s. 18) came before this court in 1846. There had then been but few extensions, and if the court made a decision which worked injustice it might be said that congress could change the law; and that was at a time when congress had leisure to pass such laws as it wanted to. But this court, after listening to the leaders of the bar, devoted forty pages to the opinions. The chief consideration which led to the decision it made was that any other would have produced an injustice and wrong foreign to the whole spirit of the patent system. It recognized its own function in the formation of that system, saying (4 How. 684):

"We must remember, too, that we are not dealing with the decision of the particular case before us, though that is involved in the inquiry; but with a general system of great practical interest to the country; and it is the effect of our decision upon the operation of the system that gives to it its chief importance."

Respectfully submitted,

JAMES C. CARTER,
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of counsel for the Bate Refrigerating Co., complainant and appellant.

OCTOBER, 1894.

CHAP. CXL. — AN ACT TO PROVIDE FOR THE REVISION AND CONSOLIDATION OF THE STATUTE LAWS OF THE UNITED STATES. [JUNE 27, 1866; 14 STAT. AT L., 74.]

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That the President of the United States be, and he is hereby authorized, by and with the advice and consent of the Senate, to appoint three persons learned in the law, as commissioners, to revise, simplify, arrange, and consolidate all statutes of the United States, general and permanent in their nature, which shall be in force at the time such commissioners may make the final report of their doings.

SEC. 2. *And be it further enacted*, That, in performing this duty, the commissioners shall bring together all statutes and parts of statutes which, from similarity of subject, ought to be brought together, omitting redundant or obsolete enactments, and making such alteration as may be necessary to reconcile the contradictions, supply the omissions, and amend the imperfections of the original text; and they shall arrange the same under titles, chapters, and sections, or other suitable divisions and subdivisions, with head notes briefly expressive of the matter contained in such divisions; also with side notes, so drawn as to point to the contents of the text, and with references to the original text from which each section is compiled, and to the decisions of the federal courts, explaining or expounding the same, and also to such decisions of the State courts as they may deem expedient; and they shall provide by a temporary index, or other expedient means, for an easy reference to every portion of their report.

SEC. 3. *And be it further enacted*, That when the commissioners have completed the revision and consolidation of the statutes, as aforesaid, they shall cause a copy of the same, in print, to be submitted to Congress, that the statutes so revised and consolidated may be re-enacted, if Congress shall so determine; and at the same time they shall also suggest to Congress such contradictions, omissions, and imperfections as may appear in the original text, with the mode in which they have reconciled, supplied, and amended

the same; and they may also designate such statutes or parts of statutes as, in their judgment, ought to be repealed, with their reasons for such repeal.

SEC. 4. *And be it further enacted*, That the commissioners shall be authorized to cause their work to be printed in parts, so fast as it may be ready for the press, and to distribute copies of the same to members of Congress, and to such other persons, in limited numbers, as they may see fit, for the purpose of obtaining their suggestions; and they shall, from time to time, report to Congress their progress and doings.

SEC. 5. *And be it further enacted*, That the statutes so revised and consolidated shall be reported to Congress as soon as practicable, and the whole work closed without unnecessary delay.

SEC. 6. *And be it further enacted*, That the commissioners shall each receive as compensation for his services at the rate of five thousand dollars a year for three years, with the reasonable expenses of clerical service and other incidental matters, not to exceed two thousand dollars annually for such expenses.

Approved June 27, 1866.

This was "revived" and commissioners directed to be again appointed, by St. May 4, 1870; 16 Stat. at L., 96.

Memorandum for the Bate Co. as to Some Matters in Appellees' Brief.

The question is whether date of American *application* or date of American *issue* is the crucial date under R. S. 4887. We insist that it is the application date.

We are dealing with a revision; the old law takes that date, and in the old law the adoption of that date is not an incident nor a detail, but goes to the very essence of the matter—to that which gave rise to the legislation, gave it character and made it just and sensible. The words do not require any different meaning, and the framework and the words cannot be satisfied by any other. To adopt *issue* date would, obviously and necessarily, give to the statute a meaning and an effect at variance with the history of legislation, repugnant to the rest of the statute, so unjust and senseless that it cannot be imputed to Congress, doing violence to established legal principles, and to the canons of construction always applied to the patent statutes. Such is the general tenor of our argument.

The argument of the **appellees' brief** turns mainly upon certain salient errors of fact and of law already considered in our briefs. It asserts (Point "First;" also p. 57) that the language of the section, taken by itself, is intelligible; that it does not, on its face, call for interpretation to give it a meaning; and, therefore, that the rules of judicial interpretation cannot be applied to it. In other words, because the mere language *per se* gives *some* meaning, the law cannot inquire whether that is the *true* meaning. To this argument there are two answers; one of law and one of fact.

1. It is absolutely settled as a rule of construction that the surface meaning is never necessarily the true meaning. The authorities, including those cited by the defendants, show that if the surface meaning of the words involves injustice, or repugnancy to the rest of the law, or absurdity, the statute peremptorily *calls* for judicial interpretation. That is to say, elements of construction *outside of the mere words* will raise the doubt, though the words, *per se*, do not seem ambiguous (*Our general brief, pp.* 12 *et seq.*, 17–21; *Mr. Carter's brief, pp.* 10–17, 30).

2. The words do *not* present a clear surface reading.

(*a*) The statute does not, *in terms*, specify *nor even purport to specify* whether application-date or issue-date is to govern. The appellees argue that by certain alleged rules the relative words "*previously*" and "*first*" must be referred with verbal absoluteness to the words "*receiving a patent*" and "*patent granted:*" and that those words etymologically and with binding effect confine us to date of manual delivery or issue, and exclude date of application (*Appellees' brief, p.* 9). That is an argument which begins by applying rules of construction, and then asserts that the process of interpretation must be arrested before it is completed; for, if completed, it would destroy their case. The language does not state which date Congress meant. We are to apply study and reflection in order to gather what Congress means; that is, judicial interpretation is invoked by the section itself (*Our General Brief, pp.* 10, 133–5; *Mr. Carter's brief, pp.* 10, 36).

(*b*) Their "rules" are wrong, for it is settled that a relative adverb of time is to find its antecedent, not by measurements on the printed page, but by the sense of the matter and the application of that judgment which is the main element of judicial construction (*Our General Brief*, pp. 133–8).

It is also settled by more than thirty precedents that the Courts and Congress have used exactly those words

to signify equally date of application and date of issue (*Our General Brief*, p. 139).

(c) The clause is *proved* to be ambiguous to the understanding of trained minds, for Justice BRADLEY, not only in the shorthand reports of his remarks, but in his written and published opinion so pronounced it (*Our General Brief, pp.* 4, 36). And the lawyers and committees of Congress, officially called on for an opinion, read the clause with our meaning (*Our General Brief, pp. 75–8*).

II.

The defendants' brief (pp. 24 *et seq.*) argues in substance that St. 1870 is "quite as much an amending as a revising law;" and, therefore, that the very strong rules for construing "revisions" cannot be applied. They ask (p. 28): "*By what right is it to be assumed that the first part of this amendment was intentional and the last part unintentional?*" They print this query in italics, as if it was the crucial question. On pages 55 *et seq.* they elaborate this idea.

They can hardly have read the papers. The draft reported by the revising commissioners was reported as a true revision; amendments were added *as amendments, eo nomine*. Now the phrases of the *revisers* are what this case turns on. The courts always resort to this source of information in order to ascertain what was enacted as a revisional reproduction and what as a change. (*Our general brief, pp.* 70–1, 75–8; *Mr. Carter's brief, p.* 49–59).

They point out (pp. 63–75) that the revision, as drawn by the revisers, did not *literally* reproduce the old law. It should not. The old law was in two statutes, which differed in a detail by which they sought to accomplish the common object. The revision adopted that one of the two modes which was the latest and the best. If the changes necessary to make the

consolidation, which is one of the chief objects of a revision, exclude the revision from the revision rule, then there is no revision rule; for no revisers' work could come within it (*Our General Brief, pp. 34, 80, 146*).

III.

The defendants' brief ("Third," pp. 10 *et seq.*) admits that before St. 1836 "if that knowledge [knowledge of the invention] was open to the public by foreign publication or patent, no patent could be here obtained" (p. 13). On page 32, discussing the "policy of the law" their brief says: "It must be remembered that, from the inauguration of our patent system, a foreign patent was a bar to a home patent unless and by virtue of some exception to that rule affirmatively stated in the Acts of 1836 and 1839."

That is exactly our position. The legislation we are considering, first contained in the Acts of 1836 and 1839, was to remove that bar, and therefore it touched, and touched only, those cases where that bar existed (*Our general Brief*, pp. 8, 53–7, 62, 64, 125).

And those were cases where the foreign patent preceded the American *application*.

Their brief then alleges, and *this is the turning point of their argument*, that the question whether the foreign knowledge "by publication or patent," in order to be a bar must be before American *application* or before American *issue* "is, of course, not solvable. * * * The time most probably would have been the same as the filing of the specification, and the issue or delivery of the patent which the statutes seem to have contemplated would be contemporaneous" (p. 15, near top).

This is utterly wrong. The "specification" was filed with the "petition," and as part of it (our general brief, p. 60, note), and the crucial date was always the date of application and never date of issue. This was abso-

lutely settled law (*our general brief*, pp. 53–7, 62–4, 105–110, 125).

In our case, as always, the specification formed part of the application, and preceded the foreign patents, so that if they were right in asserting that the filing of the *specification* is the critical date, we are within the rule.

The appellees' brief then asserts (pp. 16, 17) that under the law of 1836 a disclosure by a printed publication or foreign patent, during the *pendency* of the American application—that is, after it was filed—and at any moment before the Commissioner of Patents had *completed* his examination and issued the patent, would be a bar to the grant, and that we have "conceded and asserted this." It recurs to this on pages 88, 90, *et seq.*

This is diametrically the opposite of the truth. It has always been settled—and was never questioned—that *application* date is the critical date for this purpose under St. 1836. The adjudged cases were numerous. Our brief below, as here, collected them and insisted upon this (*Our General Brief*, pp. 53–7, 106–110, 125).

And since we are dealing with a *revision*, that is with what is a professed reproduction of the old law, the *true fact* about the old law overthrows the appellees' view and establishes ours.

That is to say, under the general clauses of the law before 1836, a foreign patent barred an American patent to the same inventor when and only when it was prior to the American *application*. St. 1836 somewhat changed the language of these clauses, but, it was held, did not change their meaning in this respect (*Our Brief*, pp. 55–7). The ground for this was that a publication by patent, before application here, was a voluntary disclosure and dedication to the public, and St. 1839, which specifically made abandonment a cause of forfeiture, emphasized that doctrine (*Ib.*, p. 58). Hence the legislation which lifted the bar of a foreign patent was both a recognition of that con-

dition of the law and a relief for the cases affected by it—that is, for cases where the American *application* was *after* the foreign grant (*Ib.*, p. 54; *Mr. Carter's brief*, pp. 33–45).

Now, Statute 1870, in Section 24, exactly and literally copied those claims of 1836 and 1839 which had been held to create the disability; the revisers, therefore, were bound to copy the relieving provision; and this, *we* say, was exactly what they did by Section 25, now under consideration. That Section 25 was therefore written and enacted as a relieving provision, to authorize patents which without it could not be granted (*Ib.*, p. 125); and the curtailing *proviso*, appended to the enabling clause, limited such patents, and only such patents, as owed their existence to that enabling clause (*Ib.*, pp. 57–8, 65–6, 126–132).

The contention on page 81 of the appellees' brief, that the enabling clause was never intended to *enable*, and that the section was enacted solely as a wide and general curtailing clause, is overthrown by established facts. It is also overthrown by the strong rule that the main clause cannot be dismissed without giving some substantial meaning to it (*Mr. Carter's brief*, pp. 78, 84).

The truth is that the appellees' argument, at each step, runs afoul of *facts* or of established rules of law; it is a false argument.

IV.

The appellees place their case on the alleged etymological significance of the words "receiving a patent." On page 22, by what is, of course, an inadvertent error, but a painfully misleading one, their brief represents these words as introduced in 1870 for the purpose of making a change. That is not the fact. *They were copied verbatim from the old law*, and, as we say, for the purpose of reproducing the old meaning (*Our general brief, pp.* 146–150.)

We note that on page 31 they again agree with us that "the Revised Statutes did not alter the law in this respect. Section 4887 substantially re-enacts Section 25 of Statute 1870." And on page 55: "Section 25 of Statute 1870 (with which Section 4887 has been held to be identical in its provisions)." (*Our general brief p.* 41).

V.

The appellees' brief (pp. 33 *et seq.*) as to "policy" advances the notion that an American inventor ought not to have any rewards beyond his American Patent, and that if he makes a profit abroad his profits here ought to be "docked" (p. 37). This is pure imagination. (*See our general brief, p.* 84).

It also alleges that it was a "policy" to encourage inventors to make their first disclosure here (pp. 38, 985). But that policy, as well as the language of the Commissioner's decisions quoted, is fully satisfied if the inventor *applies* here first. To punish him because our Patent Office is slow in making the examination after his disclosure would simply be a piece of injustice; and, *as it is the grantor who makes the examination* it would be an extortion as well (*Our General Brief*. pp. 49, 86, 109–112, 145).

VI.

The appelleets' brief (pp. 42 *et seq.*) goes at some length into the question of *contract right* and of *hardship*. These are very important,—we should be ready to say controlling considerations. But they are not to be dealt with in a narrow nor an evasive spirit.

Their brief says that the price promised is not earned unless and until the last step of procedure is completed; and that it is no more a hardship to the inventor to be punished because his American *issue* is after the foreign patent, than because his American *application* is after the foreign patent.

Nothing could be more untrue. When the American inventor has made and duly disclosed the invention by his application, the *substance* of his work is done. After that Mr. Bate did nothing which was unlawful nor even mischievous. *After* applying here, he applied in England. *That* did not forfeit or curtail his right. The actual fact, on our opponents' construction, is that the *grantor* cuts off a part of the price which for seven months after the application it was admittedly bound to pay, because *it* waited more than seven months before paying it. The defendants want to put their construction on the statute, for the purpose of making lawful that evasion of a promise, and that hard injustice (*Our general Brief*, pp. 9, 48–53, 112; *Mr. Carter's Brief*, pp. 87–105).

It is as if a railroad company sold a through ticket limited for a certain time, and then delayed its train so as to over-pass the limit.

VII.

The defendants' discussion as to the nature of the "revision" of 1870 (pp. 55 *et seq.*) is sufficiently covered by our brief. Its most exultant point is its proposition (p. 79) that the character of a "revision" must be denied to it, because, so they allege, its jurisdictional phrase under consideration in *St. Paul Works vs. Starling*, 127 U. S., 376, greatly enlarged the power of the Supreme Court. It did nothing of the kind. For, as our brief points out, the phrase of the old statute was *the phrase of the Constitution*. Legislation might express its meaning more briefly, but *could not* enlarge it; and this Court, of course, never held that it did (*Our General Brief, p. 98*).

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Supreme Court of the ~~United States.~~

OCTOBER TERM, 1894, No. 687.

BATE REFRIGERATING COMPANY,
Complainant and Appellant,

versus

FERDINAND SULZBERGER, SAMUEL WEIL,
and FREDERICK JOSEPH,
Defendants and Appellees.

BRIEF

In support of Appellant's Contention, filed on behalf of the Chemical Rubber Company, by leave of Court.

Section 4887 U. S. R. S.

BENJAMIN F. LEE,
Of Counsel.

NEW YORK:
DOUGLAS TAYLOR & CO., LAW PRINTERS, 8 WARREN STREET.
1894.

Supreme Court of the United States.

BATE REFRIGERATING COMPANY,
Complainant and Appellant,

versus

FERDINAND SULZBERGER, SAMUEL WEIL AND FREDERICK JOSEPH,
Defendants and Appellees.

No. 687.
October Term, 1894.

ON A CERTIFICATE FROM THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT.

Brief in support of Appellant's Contention filed on behalf of the Chemical Rubber Company, by leave of Court.

STATEMENT.

The single question involved in this case is one of great moment, and probably involves more important interests than any other litigated question remaining unsettled in the law of either real or personal property. It is this: whether, when a citizen of the United States has made due application for Letters Patent in his own country, he can between the date of his application and the actual issue of his patent by the Commissioner of Patents, take out a patent in a foreign country without subjecting himself to the provisions of Section 4887 of the United States

Revised Statutes, thus abridging the duration of the patent which he takes out in his own country.

The facts of this case are briefly stated in the certificate as follows:

A decree dismissing the bill in this cause after a hearing upon the setting down of pleas thereto, having been made in the Circuit Court for the Southern District of New York, and an appeal having been taken therefrom to this Court, and the cause having come on for final hearing, certain questions of law arose concerning which this Court desires the instruction of the Supreme Court of the United States for its proper decision. The facts out of which the questions arose appear from the bill and pleas thereto on file in the cause and are as follows:

On the first day of December, 1876, John J. Bate applied for Letters Patent for an improvement in processes for preserving meats, etc., and after sundry proceedings in the United States Patent Office, including an appeal to the examiners-in-chief, as well as a subsequent contested interference with a patent to one Ezekiel S. Halsted, a patent was issued to said Bate on the 20th day of November, A. D. 1877, the grant being in terms for seventeen years. Afterwards, on the 22d day of November, 1877, said John J. Bate assigned said patent to the Bate Refrigerating Company, the assignment being duly recorded on the 23d day of November, 1877.

After the application had been filed in the United States Patent Office, and before the patent was issued, two foreign patents were granted for the same invention, to wit, one patent granted by the British Government to William Robert Lake on a communication from said Bate dated January 29th, 1877, for the term of fourteen years from said date, said patent being sealed July 13th, 1877, and the complete specification being filed July 26th, 1877, and the said invention was patented or caused to be patented by the said Bate; the other of said patents granted by the Government of the Dominion of Canada to the same John J. Bate under date of January 9th, 1877, for five years. Both foreign patents expired before the expiration of the seventeen years specified in the grant of the United States

patent to Bate. The bill was filed July 25th, 1892, and prayed for an injunction against infringement and for an account.

Upon these facts this Court desires instruction upon questions of law for the proper decision of said cause, namely, whether the invention for which the United States patent was issued to said John J. Bate had been "previously patented in a foreign country," within the meaning of those words in Section 4887 of the Revised Statutes, and whether the said patent expired under the terms of said section before the expiration of the term of seventeen years from its date, and to that end hereby certifies said questions to the Supreme Court.

WM. J. WALLACE,
E. HENRY LACOMBE,
N. SHIPMAN,
Judges of the U. S. Circuit Court of Appeals,
Second Circuit.

The sole dispute is as to whether the United States patent has expired, or whether it will remain in force until November 20, 1894, as stated on the face of the grant.

The appellant claims that the rights of Bate became fixed when his application was filed, on December 1, 1876.

The opinion of the Court below is in the following words (56 Fed. Rep. 713):

"TOWNSEND, District Judge:

"This is a bill in equity for the alleged infringement of Letters Patent No. 197,314, issued to John J. Bate, November 20th, 1877, for an improvement in processes for preserving meats.

"The question raised by the pleas is, whether, under Section 4887 of the Revised Statutes, a United States patent expires with the date of a foreign patent granted prior to the date of the United States patent, but subsequent to the application therefor.

"When this case came up for a hearing in the Circuit, the suggestion was made by counsel that, as the precise question herein had been decided in favor of the defendants in other Circuits, the case should be submitted on

briefs, with the understanding that the Court, in conformity with the rule of comity in such cases, would follow such precedents.

"The following cases involving this question have been decided in favor of the defendants: Bate Refrigerating Co. *vs.* Gillett, 13 F. R., 553; Same *vs.* Same, 31 F. R., 809; Same *vs.* Hammond, 35 F. R., 139; Huber *vs.* Nelson Co., 38 F. R., 831; Pohl *vs.* Anchor Brewing Co., 39 F. R., 783.

"In accordance, therefore, with said practice, I direct that judgment on the pleas be entered for the defendants."

BRIEF OF THE ARGUMENT.

I.—The origin of the doctrine of the Circuit Court and its disastrous effects.

Prior to August 4, 1882, the practice in the Patent Office was perfectly well settled, both under the Act of 1870 and the Revised Statutes, and the construction of these statutes was in accordance with the appellant's contention. (*Ex parte* Mann, Com., Dec. 17, Off. Gaz., 330.) The whole profession had acted upon this doctrine, and it was not dreamed that it would ever be disturbed.

Bate Refrigerating Company *vs.* Gillett (13 Fed. R., 553) was decided by Judge Nixon, on August 4th, 1882, and involved the proposition that where the American patentee obtained a foreign patent in the interval between his application and the grant of his American patent, he brought himself within the provisions of Section 4887, Revised Statutes.

The other cases cited, in the opinion of the Court, are Circuit Court cases, which have followed this decision. It may be remarked here that Mr. Justice Bradley, in deciding the case last referred to, followed the decision in

13 Fed. Rep., 553, with great reluctance (31 Fed. Rep., 814), and that, in a case subsequently brought to the Supreme Court of the United States by this complainant (Bate Refrigerating Company *vs.* Hammond, 129 U. S., 151, 164–5), the question involved in the present case is left an open one.

This Court, therefore, should take up the question anew and decide it according to law, without giving the deference sometimes accorded to previous decisions in lower Courts.

The adoption of this proposition by the Circuit Court in 1882 was a great calamity to American inventors, as well as a great surprise.

A brief outline of the methods pursued in obtaining patent protection in this and other countries, where an invention has been made in this country, will be necessary, in order to understand precisely the effect of this decision. It must be borne in mind that in most foreign countries there is no system of examination such as is provided for by our statutes, and patents issue with little delay, bearing date on the day of the application and furnishing protection to the patentee from that date. In this country, on the other hand, the examination usually extends over months, and frequently over years. Instances can be given where nine years have elapsed between the filing of the application and the final grant of the patent (Smith *vs.* Goodyear Dental Vulcanite Company, 93 U. S., 486). It must also be borne in mind that in most foreign countries a patent cannot be obtained if the invention has gone into public use in the particular country where the patent is sought, or has been described in a printed publication prior to the application therefor. The liberality of our laws, which allows the inventor two years' public use of his invention without impairing his right to a patent, and which does not allow his rights to be affected by any

printed publication that does not antedate his invention, is wanting in most foreign countries.

Prior to Judge Nixon's decision in 1882, it was supposed by patent lawyers and solicitors of patents that the right of the American inventor to a patent for his invention was complete and perfect as soon as he had filed his application, and that his absolute right to protection for seventeen years was fixed by that event. (*Ex parte* Mann, Com., Dec. 17, Off. Gaz., 330.)

The course pursued was therefore as follows: The American inventor filed his application for an American patent. The inventor having thus performed his part of the contract with the American public, the struggle to obtain the patent went on in the Patent Office, while in the meantime patents were taken out in the several foreign countries in which it was desired to obtain protection. As soon as his American patent was allowed, he paid the final fee and received his patent. The process was an easy and simple one and the result attained certain and secure. When, however, in August, 1882, the profession was startled by Judge Nixon's decision (13 F. R., 553), the whole practice of soliciting patents had to be changed wherever the invention to be protected was of such importance and world-wide significance as to make it proper to take out foreign patents.

We will describe the course at present pursued to secure as far as is possible patent protection both at home and abroad for the American inventor. It will be obvious, however, that neither security nor anything approaching it is possible, by any degree of diligence or forethought, so long as the doctrine laid down by Judge Nixon is accepted as law.

The solicitor for the inventor prepares his specifications and claims and files an application for a patent in the United States Patent Office. Thereupon after the

lapse of some months or perhaps years the patent is allowed by the Commissioner. The applicant then takes advantage of the privilege conferred by Section 4885 of the Revised Statutes and refrains from paying the final fee. This delays the issue of the patent for some period less than six months, and in the meantime he prepares applications for various foreign countries and places them in the hands of trusted agents abroad. These agents are instructed to be in readiness to file the applications as soon as they receive advices to that effect from America. All being prepared, the final fee is paid in the United States and it is then known that the patent will, if all goes well, issue and bear date on a particular Tuesday. The patent agents abroad are notified to file all their applications on that particular Tuesday. Thereafter the patents are so issued as to bear date on the same day both at home and abroad, and each patent in every country stands upon its own footing, regardless of what has been done in other countries. Section 4887 is thus supposed to be evaded. Before the application and while it is pending in the American Patent Office, the invention must be kept secret if possible. To such miserable shifts and subtle contrivances is the profession reduced, in order to escape the pernicious consequences of the rule laid down by Judge Nixon

But with all this care there is no security. The more important the invention and the more valuable to mankind, the more likely it is that the allowance of the application will be delayed in the Patent Office. Not only will the examiner scrutinize it with the greatest care, but interfering applications are probable rather than possible, and the ensuing litigation before the Patent Office necessarily involves great delay. If the invention is one of transcendent value, a description of it will be almost sure to find its way into print, or it will be publicly used or

exhibited in foreign countries, while the inventor is contending for his rights in the American Patent Office, and thus he will be effectually barred from obtaining any protection in the more important countries of Europe. If the invention is publicly used or exhibited in the foreign country even without the knowledge of the inventor, the result will be in like manner disastrous. Then again, after all this complicated machinery has been set in motion for the protection of the rights of the American inventor, the whole structure may be crumbled to pieces at the last moment by the American patent being withheld from issue, perhaps on account of the filing of an interfering application, or perhaps by some clerical error in the Patent Office, or some error in the office of the Government Printer. In such case the American patent would not issue on the expected Tuesday, but would be delayed for at least a week and perhaps longer. In the meantime resort would be had to the cable to delay the foreign applications still longer, an attempt which might or might not be successful.

Thus a citizen of the United States, by whose genius an invention has been made of such importance that it should receive patent protection abroad as well as at home, is placed "between the devil and the deep sea," under the doctrine that now rules the Circuit Court. If a foreign patent issues to him too quickly, it abridges the duration of his American patent. If the grant of this American patent is long delayed in the Patent Office, he is likely to lose his foreign protection; and all this without any *laches* on his part or fault of his own.

If the American inventor contents himself with a patent in his own country, he enjoys his full protection of seventeen years, while if he goes abroad as soon as he has applied for the home patent, and gets patent protection

which puts foreigners under tribute, he is to be punished by losing a large part of his home protection!

In view of the doctrine laid down by Judge Nixon, prudent solicitors very commonly advise clients who have made important inventions which promise a sufficient reward from their use in this country, to take out a domestic patent only. For the purpose of insuring full protection in the United States they are *deliberately advised to make no attempt to obtain foreign protection, but to dedicate the invention to public use throughout all the foreign countries of the world!*

In the case of Brush Electric Company *versus* Electrical Accumulator Company, 47 F. R., 56, this question was argued before Judge Coxe in the United States Circuit Court for the Southern District of New York. The case, however, was decided upon another point. The learned Judge, speaking of this statute as construed by the Circuit Courts following Judge Nixon's decision, says:

"Why a meritorious inventor, who is a citizen of this republic, should lose his rights at home because he has tried to protect them abroad, is, on principle, not easy to comprehend. It is said the expiration of the Italian patent threw the invention into the public domain. So it did—into the domain of the Italian public. But if Mr. Brush had taken no patent in Italy the Italian public could have practised the invention from the moment it became known there. Had he taken no foreign patents his invention would have been thrown into the public domain of every land but this. In this country his inventions would have been protected for seventeen years; outside of this country they could have been used with perfect impunity. *The inventor applied for his patent here long before he applied abroad, but through the delay of the patent-office the foreign patents were issued first*

"Assuming the inventions to be similar, *the inventor has been guilty of no fault, the American public has lost*

no rights, and yet, under the provisions of this statute, which it is thought was *never intended to apply to a case like this*, a valuable monopoly is destroyed."

The Court saved the patent by holding that the domestic and foreign patents were for different inventions.

The only conceivable object of this statute and of prior statutes on the same subject, was to induce an inventor who had taken out a patent in a foreign country, or was about to do so, to be *prompt in applying* for a patent in this country, in order that the term of his United States patent might begin to run without undue delay, so far as the matter could be controlled by him.

If the construction given to the statute by the Court below is the correct one, the statute is absolutely absurd and senseless. No reason whatever can be even plausibly urged for the existence of such an enactment. If, on the other hand, the opposite construction be given to it, it becomes at once sensible and it ceases to create a public evil.

II.—Upon well settled principles of law relating to the construction of statutes, Section 4887 must be construed in such a manner as not to abridge the duration of the United States Patent granted to the assignor of the plaintiff by reason of the taking out of foreign patents intermediate between the date of the application and the date of the grant of Letters Patent of the United States.

The language of the section is as follows:

"SEC. 4887. No person shall be debarred from receiving a patent for his invention or discovery, nor shall any

patent be declared invalid, by reason of its having been first patented or caused to be patented in a foreign country, unless the same has been introduced into public use in the United States for more than two years prior to the application. But every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term, and in no case shall it be in force more than seventeen years."

The question is simply this: What is the antecedent of the word "previously." It is a well-known principle in the construction of statutes that "punctuation is no part of the statute." (Hammock *vs.* Loan and Trust Co., 105 U. S., 84 and authorities cited). If the period after the word "application" is stricken out or turned into a comma, then the section is clearly to be construed in accordance with our contention, for the words "prior to the application" and "previously" would obviously refer to the same point of time.

In *ex parte* Mann (17 O. G., 330), Commissioner Paine in 1880 held according to our contention, and according to the general understanding of the profession down to August 4, 1882.

The Rules of the Patent Office providing for a statement under oath at the time of the application as to foreign patents, previously obtained, show the understanding of the office and of the profession on this subject. (Rule 91, 1871 to 1878, Rule 39, 1879 to 1883.)

The decision of the Supreme Court of the District of Columbia in Koechlin *vs.* Marble, Commissioner, 2 MacKay's Rep., 12 (1879), approving of Rule 39, points in the same direction.

The reasoning of Judge Nixon (Bate Refrigerating Co. *vs.* Gillett) is to be found in 13 F. R., on pages 555 and 556. There is no discussion whatever in regard to the

general principle of construction applicable to the statute, nor does the learned Judge seem to realize the terrible inconvenience and mischief that would necessarily result from his construction. He simply construes the statute as he does because, as he says, that is "its plain and obvious meaning." He disregarded the principle *qui hæret in litera hæret in cortice*. He made no attempt to apply to the language of the statute any of the well-known rules of construction, notwithstanding the fact that for many years the understanding of the profession had been contrary to his view, and had been fortified by the decision of the Commissioner and the settled practice of the Patent Office.

When the same case came up before Mr. Justice Bradley, in the Circuit Court of the United States for the District of New Jersey, on petition to dissolve injunction, some of the evils resulting from Judge Nixon's decision had come to be appreciated, and a strenuous endeavor was made to have the whole question reargued and decided the other way. On the argument on behalf of the defendant Mr. Justice Bradley used the following language, speaking of this section of the Revised Statutes:

"Now, suppose you alter the punctuation and put a semi-colon instead of a period there and read on: 'But every patent granted for an invention which has been previously granted.' Previous to what? *Mr. Bennett:* Previous to the first patent. *The Court:* It does not say so. You have to exercise your judgment as to what it refers to, whether it refers to the application mentioned or refers to the granting of the patent. (Stenographer's Minutes, p. 348.)

* * * * *

"The great trouble with the section is the evident attempt of the compilers or revisers to abridge the language —to shorten the words of the enactment, and, in so doing, they have introduced a great deal of uncertainty. Now look at this: 'No person shall be debarred from receiving

a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented or caused to be patented in a foreign country.' See how very general that is. 'First patented.' First patented before what? It is so general that no one can read it without seeing that it is at least doubtful as to what it does refer to.

"There is the difficulty of the whole thing. The generality has introduced ambiguity." (Stenographer's Minutes, pp. 349, 350.)

When Mr. Justice Bradley came to decide the case he used the following language (31 F. R., 814):

"With regard to the construction of our own statute (Section 4887, Rev. St.), if the question were an open one, I might have some hesitation; but, as it is at least a question of considerable doubt, I feel constrained, sitting at the Circuit, to follow the law of the case as held by Judge Nixon, especially as his judgment has been followed in other circuits. It is true that the complainant does not ask the reversal of any order heretofore made, on the ground of its being made on an incorrect view of the law; but asks that the last order may stand, notwithstanding the occurrence of facts which, according to the previous view of the law, would require its revocation. I do not see, however, that this makes much difference in the position of the Court. In view of the Canadian patent, Judge Nixon dissolved the injunction. When it was put out of view, for a time, by certain rubbish, the injunction was revived. That rubbish has now been cleared away, and the patent comes again into view. Not to dissolve the injunction again would be to repudiate the former decision of the Court. In any case, a Judge will be very reluctant to decide the law differently from what has previously been decided in the same case, either by himself or by another Judge, although it has sometimes been done, especially for the purpose of conforming to the decision of an appellate court. But where no such decision has been made, and where the question, to say the least, is quite a doubtful one, it would be very unseemly for one Judge to overrule the decisions of another in the same cause.

"Therefore, without having come to any decided conclusion on the question in hand, considered as an original one, I feel bound to follow the previous rulings of this Court, confirmed as they are by those of other circuit courts, as safe precedents, until the law shall be differently settled by the appellate tribunal. This, of course, will require a vacation of the order of March 25, 1884, and a reinstatement of that dissolving injunction."

In Gramme Co. *vs.* Arnoux Co. (17 F. R., 840), Mr. Justice Blatchford bases his decision upon that of Judge Nixon, already referred to, as according to the rule of comity he was bound to do. Judge Blatchford did not enter into any discussion of the subject.

In Bate Refrigerating Co. *vs* Hammond, already referred to, the whole question was left open (129 U. S., 164, 165). On page 169 of the opinion of the Court, *there is a mistake concerning the previous decisions of the Court* in O'Reilly *vs.* Morse (15 How., 62) and Smith *vs.* Ely (15 How., 137). A similar question arose in O'Reilly *vs.* Morse, under the statute then in force. It was not, however, decided by the Supreme Court, but was discussed, without being passed upon, precisely as in the case of Bate Refrigerating Co. *vs.* Hammond in reference to the present statute. Chief Justice Taney, delivering the opinion of the Court, says (p. 112):

"Nor is it void because it does not bear the same date with his French patent. *It is not necessary to inquire whether* the application of Professor Morse to the Patent Office in 1838, before he went to France, *does or does not* exempt his patent from the operation of the act of Congress upon this subject. For, if it should be decided that it does not exempt it, the only effect of that decision would be to limit the monopoly to fourteen years from the date of the foreign patent. And, in either case, the patent was in full force at the time the injunction was granted by the Circuit Court, and when the present appeal stood regularly for hearing in this Court."

The principal question in that case was as to the validity of the celebrated 8th claim. Wayne, J., Nelson, J., and Grier, J., dissented upon that point and concurred in an opinion sustaining the 8th claim, which was delivered by Mr. Justice Grier. In that opinion, the question before us now, was discussed (p. 125), and the view held was in favor of our contention. That discussion is well worthy of an examination.

Since the decision of the Supreme Court in the case of the Bate Refrigerating Co. *vs.* Hammond, the question has arisen in the Circuit Court a number of times, but it has never been decided upon principle.

Edison Electric Lighting Co. *vs.* U. S. Electric Lighting Co. (35 F. R., 134), was decided by Judge Wallace on May 15, 1888. He states that the question is not an original one, and follows the authorities.

The case at bar (56 F. R., 713) was decided by Judge Townsend, June 7, 1893, and simply followed the previous decisions.

Accumulator Company *vs.* Julien Electric Co. (57 F. R., 605) was decided by Judge Coxe, July 18, 1893. He says as follows, after stating that this question is not an open one in the Circuit Court (p. 615).

"Whenever the able and interesting argument in support of the complainant's contention is presented to a tribunal which is at liberty to consider it, it will unquestionably receive the attention it deserves."

The question, therefore, is entirely open for discussion in this Court, free from any regard to decisions of any of the lower Courts, and the construction of the statute, if not in our favor, is at least doubtful. Under these circumstances, the following cases are in point.

In re Alma Spinning Company, L. R., 16 Ch. D., 686, it was said by Jessel, M. R.: "Then the argument of

inconvenience is adduced. Now I have always said, and I am repeating, I am afraid, what I have been compelled to repeat over and over again, that the argument of inconvenience is a very strong argument where the construction of a document is ambiguous—where it is fairly open to two constructions. Then the argument of inconvenience, like the argument of absurdity, may be used with great force." The Court was construing a company's Articles of Association.

Lau Ow Bew vs. *United States* (144 U. S., 47) came before the Supreme Court of the United States on a writ of certiorari to the United States Circuit Court of Appeals for the Ninth Circuit. In that case it was held, reversing the decision of the Circuit Court of Appeals and of the Circuit Court, that "Section 6 of the Chinese Restriction Act of May 6, 1882, 22 Stat. 58, c. 126, as amended by the Act of July 5, 1884, 23 Stat. 115, c. 220, does not apply to Chinese merchants, already domiciled in the United States, who having left the country for temporary purposes, *animo revertendi*, seek to re-enter it on their return to their business and their homes." The Courts below had strictly and literally construed the statute, but the Supreme Court held that this was erroneous. The Chief-Justice, delivering the opinion of the Court, says (p. 59): "Nothing is better settled than that statutes *should receive a sensible construction*, such as will effectuate the legislative intention, and, if possible, *so as to avoid an unjust or an absurd conclusion*."

In *Holy Trinity Church* vs. *United States* (143 U. S., 457), itwas held that "The Act of February 26, 1885, 'to prohibit the importation and migration of foreigners and aliens under contract or agreement to perform labor in the United States, its Territories and the District of Columbia,' 23 Stat. 332, c. 164, does not apply to a contract be-

tween an alien, residing out of the United States, and a religious society incorporated under the laws of a State whereby he engages to remove to the United States, and to enter into the service of the society as its rector or minister."

The Circuit Court had given a literal construction to the statute, and had rendered a judgment against the plaintiff in error for the penalty prescribed by the act.

Mr. Justice Brewer delivered the opinion of the Supreme Court, reversing the judgment of the Circuit Court. He says (pp. 458–462):

"*It must be conceded that the act of the corporation is within the letter of this section*, for the relation of rector to his church is one of service, and implies labor on the one side with compensation on the other. Not only are the general words *labor and service* both used, but also, as it were to guard against any narrow interpretation and *emphasize* a breadth of meaning, to them is added '*of any kind*'; and, further, as noticed by the Circuit Judge in his opinion, the fifth section, which makes specific exceptions, among them professional actors, artists, lecturers, singers and domestic servants, strengthens the idea that every other kind of labor and service was intended to be reached by the first section. While there is great force to this reasoning, we cannot think Congress intended to *denounce with penalties* a transaction like that in the present case. It is a familiar rule, that a thing may be within the letter of the statute and yet not within the statute, because not within its spirit, nor within the intention of its makers. This has been often asserted, and the reports are full of cases illustrating its application. This is not the substitution of the will of the Judge for that of the legislator, for frequently words of general meaning are used in a statute, words broad enough to include an act in question, and yet a consideration of the whole legislation, or of the circumstances surrounding its enactment, *or of the absurd results which follow from giving such broad meaning to the words, makes it unreasonable to believe that the legislator in-*

tended to include the particular act. As said in Plowden, 205: 'From which cases, it appears that the sages 'of the law heretofore have *construed statutes quite con-* '*trary to the letter in some appearance*, and those statutes 'which comprehend all things in the letter they have ex- 'pounded to extend to but some things, and those which 'generally prohibit all people from doing such an act they 'have interpreted to permit some people to do it, and 'those which include every person in the letter, they have 'adjudged to reach to some persons only, which exposi- 'tions have always been founded upon the intent of the 'Legislature, which they have collected sometimes by con- 'sidering the cause and necessity of making the act, some- 'times by comparing one part of the act with another, *and* '*sometimes by foreign circumstances.*'"

"In Margate Pier Co. *vs.* Hannam, 3 B. & Ald., 266, 270, Abbott, C. J., quotes from Lord Coke as follows: '*Acts of Parliament are to be so construed as no man* '*that is innocent or free from injury or wrong be, by a* '*literal construction*, punished or *endamaged.*' In the case of the State *vs.* Clark, 5 Dutcher (29 N. J. Law), 96, 98, 99, it appeared that an act had been passed making it a misdemeanor to wilfully break down a fence in the possession of another person. Clark was indicted under that statute. The defence was that the act of breaking down the fence, though wilful, was in the exercise of a legal right to go upon his own lands. The Trial Court rejected the testimony offered to sustain the defence, and the Supreme Court held that this ruling was error. It its opinion the Court used this language: 'The act of 1855, in terms, makes the wilful opening, 'breaking down or injuring of any fences belonging to 'or in the possession of any other person a misdemeanor. 'In what sense is the term wilful used? In common par- 'lance, wilful is used in the sense of intentional, as dis- 'tinguished from accidental or involuntary. Whatever 'one does intentionally, he does wilfully. Is it used in 'that sense in this act? Did the Legislature intend to 'make the intentional opening of a fence for the purpose 'of going upon the land of another indictable, if done 'by permission or for a lawful purpose? * * * We

'cannot suppose such to have been the actual intent. 'To adopt such a construction would put a stop to the 'ordinary business of life. *The language of the act, 'if construed literally, evidently leads to an absurd 'result. If a literal construction of the words of a 'statute be absurd, the act must be so construed as to 'avoid the absurdity. The Court must restrain the 'words.* The object designed to be reached by the act 'must limit and control the literal import of the terms 'and phrases employed.' In United States *vs.* Kirby, 7 Wall., 482, 486, the defendants were indicted for the violation of an act of Congress, providing 'that if any person 'shall knowingly and wilfully obstruct or retard the pas- 'sage of the mail, or of any driver or carrier, or of 'any horse or carriage carrying the same, he shall, 'upon conviction, for every such offence pay a fine 'not exceeding one hundred dollars.' The specific charge was that the defendants knowingly and wilfully retarded the passage of one Farris, a carrier of the mail, while engaged in the performance of his duty, and also in like manner retarded the steamboat 'General Buell,' at that time engaged in carrying the mail. To this indictment the defendants pleaded specially that Farris had been indicted for murder by a Court of competent authority in Kentucky; that a bench warrant had been issued and placed in the hands of the defendant Kirby, the sheriff of the county, commanding him to arrest Farris and bring him before the Court to answer to the indictment; and that in obedience to this warrant he and the other defendants, as his posse, entered upon the steamboat General Buell and arrested Farris, and used only such force as was necessary to accomplish that arrest. The question as to the sufficiency of this plea was certified to this Court, and it was held that the arrest of Farris upon the warrant from the State Court was not an obstruction of the mail, or the retarding of the passage of a carrier of the mail within the meaning of the act. In its opinion the Court says: '*All laws should receive a sensible con- 'struction.* General terms should be so limited in their 'application as *not to lead to injustice, oppression or an 'absurd consequence.* It will always, therefore, be

'presumed that the Legislature intended exceptions to its 'language which would avoid results of this character. 'The reason of the law in such cases should prevail over 'its letter. The common sense of man approves the judg- 'ment mentioned by Puffendorf, that the Bolognian law 'which enacted 'that whoever drew blood in the streets '' 'should be punished with the utmost severity,' did not 'extend to the surgeon who opened the vein of a person 'that fell down in the street in a fit. The same common 'sense accepts the ruling, cited by Plowden, that the 'statute of 1st Edward II., which enacts that a 'prisoner who breaks prison shall be guilty of felony, 'does not extend to a prisoner who breaks out when the 'prison is on fire, "for he is not to be hanged because 'he would not stay to be burnt." And we think that a 'like common sense will sanction the ruling we make, that 'the act of Congress which punishes the obstruction or 'retarding of the passage of the mail, or of its carrier, 'does not apply to a case of temporary detention of the 'mail caused by the arrest of the carrier upon an indict- 'ment for murder.' The following cases may also be cited: Henry *vs.* Tilson, 17 Vermont, 479; Ryegate *vs.* Wardsboro, 30 Vermont, 746; *Ex parte* Ellis, 11 California, 222; Ingraham *vs.* Speed, 30 Mississippi, 410; Jackson *vs.* Collins, 3 Cowen, 89; People *vs.* Insurance Company, 15 Johns., 358; Burch *vs.* Newbury, 10 N. Y., 374; People *vs.* N. Y. Commissioners of Taxes, 95 N. Y., 554, 558; People *vs.* Lacombe, 99 N. Y., 43, 49; Canal Co *vs.* Railroad Co., 4 G. & J., 1, 152; Osgood *vs.* Breed, 12 Mass., 525, 530; Wilbur *vs.* Crane, 13 Pick., 284; Oates *vs.* National Bank, 100 U. S., 239."

As the general question will be discussed in detail by other counsel, we will not prolong this argument.

III.—The United States Circuit Court of Appeals for the Second Circuit should be instructed to the effect that the invention for which the United States patent aforesaid was issued to said John J. Bate had not been "previously patented in a foreign country" within the meaning of those words in section 4887 of the Revised Statutes, and that said patent did not expire under the terms of said section before the expiration of the term of seventeen years from its date,

BENJAMIN F. LEE,
Of Counsel.

SUPREME COURT U.S.
FILED
NOV 6 1894
JAMES H. McKENNEY,
CLERK

UNITED STATES SUPREME COURT,

On Certificate from the Circuit Court of Appeals.

IN THE SECOND CIRCUIT.

THE BATE REFRIGERATING COMPANY,

Complainant,

against

FERDINAND SULZBERGER AND OTHERS,

Defendants.

BRIEF FOR COMPLAINANT.

JAMES C. CARTER,

Of Counsel for Complainant.

SLIGHT & KING, 69 WILLIAM ST., N. Y.

ACT OF 1836, SEC. 8.

Nothing in this act contained shall be construed to deprive an original and true inventor of the right to a patent for his invention, by reason of his having *previously* taken out Letters Patent therefor in a foreign country, and the same having been published at any time within six months next preceding the filing of his specifications and drawings.

ACT OF 1839, SEC. 6.

That no person shall be debarred from receiving a patent for any invention or discovery * * * by reason of the same having been patented in a foreign country more than six months *prior* to his application; *provided* that the same shall not have been introduced into public and common use in the United States prior to the application for such patent, and *provided* also that in all cases every such patent shall be limited to the term of fourteen years from the date or publication of such foreign Letters Patent.

ACT OF 1870, SEC. 25.

No person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented or caused to be patented in a foreign country; *provided* the same shall not have been introduced into public use in the United States for more than two years prior to the application, and that the patent shall expire at the same time with the foreign patent, or, if there be more than one at the same time with the one having the shortest term; but in no case shall it be in force more than seventeen years.

REVISED STATUTES. SEC. 4887.

No person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented, or caused to be patented by, in a foreign country, unless the same has been introduced into public use in the United States for more than two years prior to the application. But every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire at the same time with the foreign patent, or if there be more than one, at the same time with the one having the shortest term, and in no case shall it be in force more than seventeen years.

The printed bill (House 1714) was as follows:

"No person shall be debarred from receiving a patent for his invention or discovery by reason of his having first patented it in a foreign country; provided the same shall not have been introduced into public [and common] use in the United States prior to the application, and that the patent shall [be limited to seventeen years from the date of publication of the foreign patent] *expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term, but in no case shall be in force more than seventeen years.*"

"Foreign (patents) *inventions* may be patented.
4 July, 1836, c. 357, § 8.
3 March, 1839, c. 88, §6.
5 McLean, 78, 80.
15 How., 112.

Supreme Court of the United States

on certificate from the Circuit Court of Appeals

FOR THE SECOND CIRCUIT.

THE BATE REFRIGERATING COMPANY,
Complainant and Appellant,

against

FERDINAND SULZBERGER and others,
Defendants and Appellees.

STATEMENT.

This case comes up on a certificate from the United States Circuit Court of Appeal.

The bill was filed by the complainant in the Circuit Court of the United States for the Southern District of New York, for the purpose of procuring an injunction to restrain the defendants from infringing a patent belonging to the complainant for a certain new and useful improvement in the process of preserving meat during transportation.

The substance of the bill, which is admitted by the pleas interposed by the defendants, was that one John J. Bate, on the 1st of December, 1876, applied to the Commissioner of Patents for Letters Patent upon the invention, and that, after sundry proceedings in the Patent Office,

and on the 20th of November, 1877, Letters Patent, numbered 197,314, were issued to the applicant, granting to him and his assigns, for the term of seventeen years, from and after the 20th of November, 1877, the full and exclusive right of making, using and vending throughout the United States the invention above mentioned; and that afterwards, and on the 22d day of November, 1877, the inventor and patentee duly assigned to the complainant all his right, title and interest in and to the said Letters Patent, and the invention covered thereby.

There were further allegations that the said patent had been declared valid by two decrees, one final, of the United States Circuit Court for the Southern District of New York, and the other interlocutory, by the United States Circuit Court for the District of New Jersey, against other persons, and that the defendants in this suit had been, since the 23d day of November, 1877, and still were, infringing said patent by making, using and vending, in the city of New York and elsewhere, the patented improvement.

The first plea set up by the defendants was that the alleged invention had been patented, or caused to be patented, by the same John J. Bate in the United Kingdom of Great Britain and Ireland, by Letters Patent of the United Kingdom No. 382, granted and issued to William Robert Lake, on a communication sent to him by said John J. Bate, under date of January 29, 1877, for a term of fourteen years therefrom, said British patent being sealed July 13th, 1877.

The second plea set up that the same John J. Bate procured Letters Patent for the same invention from the Government of the Dominion of Canada, which Letters Patent were numbered 6,938, and granted a patent for the term of five years from the 9th day of January, 1877.

The point designed to be made by these pleas

was that, inasmuch as these two patents granted in foreign countries were each issued prior to the issue of the American patent, the latter expired at the same time with the foreign patent which had the shortest term, and that the existence of either of the foreign patents had put an end to the term of the American patent prior to the filing of the bill, and that consequently no relief by way of injunction could be had.

The pleas were set down for argument; and the question for argument was whether, under Sec. 4887 of the Revised Statutes, a United States patent issued subsequently to the issue to the same patentee of a foreign patent, although applied for before, expires at the same time with the foreign patent. It so happened that the same question had been raised and decided in favor of the defendants in another Circuit, and it was understood that the Circuit Court of the Second Circuit would, in conformity with the rule in such cases, follow the precedent. The case was therefore submitted without oral argument, and a decree substantially *pro forma* was ordered dismissing the bill.

From that decree an appeal was taken to the United States Circuit Court of Appeals, which certified to this Court the question arising upon the appeal.

The United States patent granted to John J. Bate would not, unless its duration were abridged by the foreign patents mentioned in the pleas, expire until the 20th day of November, 1894. The Canadian patent (even when taken with its extensions not mentioned in the pleadings) expired on the 9th day of January, 1892. The British patent expired on the 29th of January, 1891. These two latter patents were granted before the United States patent was *issued*, but not until after the *application* for the same. If, therefore, the United States patent is one of the *class* described in the last clause of Sec. 4887 of the Revised Statutes, that is

to say, if it was a patent granted for an invention which had "*been previously patented in a foreign country*" within the true meaning of that clause, it could not continue after the expiration of either of the foreign patents, and had expired prior to July 25, 1892, the date of the filing of the bill.

The precise question therefore is whether the words "previously patented" in that section mean patented before the *issue* of the domestic patent, or before the *application* for the same.

This brief statement presents in an abstract form the bare and naked question, but it does not present the *case*. A proper understanding of this requires a statement of the *concrete* facts as they arose, and in connection with what has ordinarily been understood as the system and policy of our patent law.

The patent system of the United States, as has been frequently declared by the highest authorities, is an engagement, or promise, by the public to give to any one, who will by the employment of the requisite trouble and inventive skill produce and disclose to the proper officer a new and useful invention, the exclusive right to use and sell the benefits of it for a specified term of years. Mr. Chief Justice Marshall said at an early period:

"To promote the progress of useful arts is the interest and policy of every enlightened government. It entered into the views of the framers of our constitution, and the power 'to promote the progress 'of science and useful arts, by securing for limited 'times to authors and inventors, the exclusive 'right to their respective writings and discoveries,' is among those expressly given to Congress. This subject was among the first which followed the organization of our government. It was taken up by the first Congress at its second session, and an act was passed authorizing a patent to be issued to the inventor of any useful art, &c., on his petition, 'granting to such petitioner, his heirs, administra-

'tors or assigns, for any term not exceeding 'fourteen years, the sole and exclusive right and 'liberty of making, using, and vending to others 'to be used, the said invention or discovery.' The law further declares that the patent "shall be good 'and available to the grantee or grantees by force 'of this act, to all and every intent and purpose 'herein contained.' The emendatory act of 1793 contains the same language, and it cannot be doubted that the settled purpose of the United States has ever been, and continues to be, to confer on the authors of useful inventions an exclusive right in their inventions for the time mentioned in their patent. It is the reward stipulated for the advantages derived by the public for the exertions of the individual and is intended as a stimulus to those exertions. The laws which are passed to give effect to this purpose ought, we think, to be construed in the spirit in which they have been made; and to execute the contract fairly on the part of the United States, where the full benefit has been actually received; if this can be done without transcending the intention of the statute, or countenancing acts which are fraudulent or may prove mischievious."

The successive statutes have, in the clauses which express the engagement of the government, declared in unequivocal terms that a patent for a specified period should be the reward of the inventor who accepted the offer publicly held out, and produced and disclosed, in the manner pointed out by law, a useful invention. The last form in which this engagement stands expressed, that of the present revision, is

"SEC. 4886. Any person who has invented or discovered any new and useful art, machine, manufacture or composition of matter, or any new and

useful improvement thereof, not known or used by others in this country, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, and not in public use or on sale for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceedings had, obtain a patent therefor."

"SEC. 4893. On the filing of any such application, and the payment of the fees required by law, the Commissioner of Patents shall cause an examination to be made of the alleged new invention or discovery; and if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the Commissioner shall issue a patent therefor."

"SEC. 4884. Every patent shall contain a short title or description of the invention or discovery correctly indicating its nature and design, and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the exclusive right to make, use, and vend the invention or discovery throughout the United States, and the Territories thereof, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof."

The mere declaration indeed of the inventor, that he has produced an invention entitling him to the reward, cannot be at once accepted. The system provides a mode by which the government is to satisfy itself that the terms of its offer have been complied with; and this contemplates an examination, which must always consume some time, and, in some cases, a time considerably protracted.

But no intimation is given by the terms of the grant that the time thus expended by the government in making its examination is to diminish or hazard the reward which has been promised. The patent may not—it cannot—be issued at the moment it is claimed; but the language of the law contemplates that the question whether the claimant is entitled to the reward is to be immediately determined, and, when determined in favor of the applicant, that the patent is to issue at once. This does not mean literally at once; but it does mean that the lapse of time is unimportant in respect to the matter of right, and that the right is regarded as settled by the facts as they exist at the time of the application.

The complainant availed himself of the offer of a reward thus made by the government, and performed the consideration, that is, *did the thing* for which the reward was promised. He made his invention; and, on the 1st of December, 1876, disclosed it to the designated officer, and claimed his patent. At the same time he desired to obtain patents in Great Britain and Canada. To secure these it was necessary to make application with promptitude, inasmuch as any printed information of his discovery reaching those countries before he made his application there, would have made it impossible to obtain one. He could not well have imagined that if his patents in those foreign countries should happen, in spite of everything which he could do, to be issued before the issue on his American application, that any damage would arise to that patent. No hostility had ever been shown by our patent system to the obtaining of patents abroad. On the contrary, that practice, while never disfavored, had been since 1836 distinctly encouraged by our law, both because it furnished an additional stimulus to invention, and prevented that disadvantage to American users, which comes from their being under the burden of

a royalty when the foreign users are exempted from it. A whole generation of inventors and patent lawyers had grown up under and became familiar with the fact that, *after application had been made* to the American Patent office, nothing, except, some fault on the part of the applicant, could prejudice his application, or hazard or diminish the reward promised to him. True, the complainant is to be supposed to have read section 4887 of the Revised Statutes, but unless that changed the law as it had always stood, and introduced a wholly new policy inconsistent with the general system and utterly subversive of justice, he could not regard that as containing a peril impossible to be avoided except by abandoning altogether his purpose to procure the foreign patents. He could not well believe that our patent law had made an application for a foreign patent pregnant with a nearly certain, and possibly ruinous, penalty.

It so happened that his Canadian patent for five years was actually issued to him on the 9th of January, 1877, and that of Great Britain on the 13th of July, 1877, for fourteen years; while his American patent was not issued until the 27th of November, 1877. For this result he was in no manner chargeable. He had done nothing to bring it about, and he could not have helped it had he desired. It arose solely by reason of the fact that our patent law requires an examination into the merits of the application, and thus protracts the period between application and issue longer than the law of Great Britain or Canada, neither of which contemplates that proceeding.

Now, however, the assertion is made, by those who wish to use his invention without paying for it, that the complainant's patent, instead of being what it purports to be upon its face, a patent for seventeen years from November 20th, 1877, that is to say, until November 20th, 1894, expired at the same time with his English patent, that is, on the 13th of

July, 1891, and that he has lost nearly three and one-half years—and the best three and a half years—of his American patent.

This punishment—for it is nothing els—thus visited upon the American inventor, is not because of any wrong, neglect, or fault, either of omission or commission on his part. He did not delay the issue of his American patent, nor could he have hastened it. Nor is it absolutely imputable to his application for his foreign patents. It was *possible*, though not probable, with his action just as it was, that the several patents should have been so issued as to leave his American term unabridged. The penalty fell upon him solely because of the *delay*, proper or improper, occasioned by the time taken by the American office in determining whether the government was bound to issue him a patent; that is to say, the time taken to ascertain whether the government was under an obligation to issue a seventeen-year patent has, in part, *extinguished* that obligation, and, under circumstances which might well enough have happened, and which are sure to happen in many similar cases, would have extinguished still more of the obligation, and perhaps the whole of it! For, if the officers of the Government had *negligently* delayed the prosecution of the examination, such negligence would have subtracted from his reward a further period precisely equal to the length of its continuance; and if an interference contest had been induced by rival applications, even if instituted by those who wished to prey upon his invention, it might have been so protracted as to exhaust the whole of the term to which the law declared him entitled.

In the views of our opponents the nature of the contract between the Government and the inventor is that if the agents and servants of the Government shall be guilty of any culpable neglect or delay in determining whether he is entitled to a patent or not, his reward shall be, *pro tanto*, *diminished!*

First Point.—The defendants, in support of their contention that "previously patented" means patented before the *issue* of the American patent, put themselves upon what is called the rule of *literal, grammatical* interpretation, and insist that such meaning is the *necessary import* of the language; and that it would therefore be to no purpose to show that such a construction would make the law a piece of senseless and mischievous folly, unjust to inventors, prejudicial to the public, and utterly inconsistent with a long settled policy of the Government.

But little examination is needed to show that this position cannot be maintained.

1. Undoubtedly language may be employed which is so precise and clear as to *admit* of but one meaning. In such a case, as there can be *no doubt*, none of those inquiries which are designed to remove doubt are legitimate. It matters not in such a case what the consequences may be. The legislature must be taken to have meant what it has indubitably said. But there are very few such cases as these; and the above-mentioned rule, therefore, as is justly observed by Judge Maxwell, carries us but a short way, and has but a "*prima-facie* preference."

   Statutory Interpretation (edited by Endlich), §§ 25–27.

2. But at what point are we to determine whether the language of a clause of a statute *admits of but one* interpretation? Single sentences often seem quite clear of them-

selves, but become open to doubt when read in connection with something which precedes or follows. And how much knowledge is it lawful to have about the subject to which the statute relates before it is determined whether a doubt exists as to its meaning? With the aid of the dictionary, and the rule of *literal, grammatical*, interpretation, an unlearned person may interpret a clause in a statute and think that but one interpretation is possible; but a lawyer skilled in the subject to which it relates might be immediately perplexed with doubt.

The position of the defendants is that we are *confined to the particular section* inquestion, and if no ground of doubt appears on reading that, we are at liberty to go no further, for this would be to go into the work of interpretation when there is nothing to interpret.

It can hardly be necessary to say that this view, which makes *ignorance* a qualification, and *knowledge* a disqualification, for ascertaining the meaning of statutes is incorrect. If a skilled patent lawyer's opinion, as to whether there is doubt as to the meaning of this section would be better than that of a university professor of grammar, it would be because he knew more about the subject, and it must, therefore, be competent and, indeed, necessary for any one who is to say whether the statute is doubtful or clear, if he does not already possess such knowledge, to gain it. It is not possible for him to know too much.

In short, in order to know whether the statute is open to doubt, it must be intelligently applied to the subject matter to which it relates, and that subject matter is the patent system of the United States, and the law regulating it.

When it is so applied, its language will be the better understood, and it can be the better determined whether it *admits of more than one* interpretation.

Church of the Holy Trinity *vs.* United States, 143 U. S., 457-458.

United States *vs.* Lacher, 134 U. S., 624.

Atkins *vs.* Disintegrating Co., 18 Wall, 272.

3. The precise nature of the defendants' proposition, which we are now considering, should be kept in mind. We sometimes find in the opinions of learned Judges upon the interpretation of statutes expressions to the effect that the language of the legislature is clear, and, therefore, there is no occasion to go outside of it to ascertain its real import. This often means not that it is not *possible* to place upon it a different interpretation, but that the possible doubt is so small, and the reasons for departing from the apparent grammatical meaning so slight, that it is not worth while to consider them.

Our present inquiry is not one concerning the *probability* of a construction different from that asserted by the defendants, but whether a different construction is *possible*. If that should be determined in the *negative* it is the end of the debate, and the case must be decided in the defendants' favor; if, in the affirmative, it will be in order to consider the weight of the reasons offered in support of the interpretation asserted by the complainant.

4. Even if we could look, as the defendants assert, no further than the section itself, we can see that a doubt is possible, and that the statute requires interpretation. Very few words contain their whole meaning in themselves. And words such as "*before*," "*after*," "*previously*," "*subsequently*," &c., &c., never do. We must look at what precedes, and what follows, in order to know *what event is intended* as being the one *before*, or *after*, which some other event is described as taking place, or something ordered to be done; and having ascertained this, we must *read it into* the language under interpretation. In this section the words "previously patented" are preceded by two expressions indicating *acts*. One is "patent granted," the other is "application." Which of these acts is the one in reference to which the language "previously patented" is employed? The appellees will say "patent granted." This may be. At first blush this might seem the more natural and probable reference. But *must* it be so? Is it *impossible* that "application" should rather have been intended? Suppose that the former interpretation involved an unreasonable, and the latter an entirely reasonable, result, is there anything in the order or collocation of the words which should *preclude* a Court from saying that the latter was the true meaning of Congress?

Endlich on Stat. Interpretation, §§ 25–27.

a. Mr. Justice Bradley, before whom the precise question came in Bate Refrigerating Co. *vs.* Gillett (21 Fed. Rep., 809), while he felt constrained to follow a prior decision

in the same case by Judge NIXON, yet said in his decision : " It is at least a question of considerable doubt."

In the course of the argument before him the following colloquy took place, as reported by a stenographer :

" *The Court.*—Suppose you altered the punctuation, and put a semi-colon instead of a period there, and read on : ' But every patent granted for an invention which has been previously patented.' Previous to what ?

Mr. Bennett.—Previous to the first patent.

The Court.—It does not say so. You have to exercise your judgment as to what it refers to, whether it refers to the application mentioned, or refers to the granting of the patent. * * * The great trouble with the section is the evident attempt of the compilers or revisers, to abridge the language—to shorten the words of the enactment– and in so doing they have introduced a great deal of uncertainty. Now, look at this : ' No person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented or caused to be patented in a foreign country.' See how very general that is ! First patented ! First patented before what ? It is so general that no one can read it without seeing that it is at least doubtful as to what it does refer to. There is the difficulty of the whole thing ; generality has introduced ambiguity."

5. But let the section be applied to the subject

matter upon which it is designed to operate, that is to say, the system of United States Patent Law, and very great doubt as to the soundness of the first-blush interpretation immediately arises.

a. Take the first clause of the Section 4887. "No person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented or caused to be patented in a foreign country." The defendants insist that the words "first patented" mean patented in a foreign country at sometime before the issuing a patent in the United States. But why should Congress enact that a prior foreign patent should not be a bar to an American patent when it never was, and was never by anyone supposed to be, a bar. It was only in case the foreign patent had been taken out *prior to the application* for the American patent, that it could have, under the law as it had always stood, any effect to debar, or otherwise injure, the American discoverer.

The mind cannot do otherwise than doubt whether Congress did not by the words "first patented" mean patented before *application;* because the clause then becomes intelligible and reasonable.

b. A glance at *one* of the necessary consequences of the view taken by the defendants should be enough to show that the section is at least *open to interpretation.*

The *policy* of the patent system of the United States is to encourage the taking out

by American inventors of patents in all foreign countries. There are two strong considerations supporting this policy: *First*, it is for the benefit of the inventor, and thus tends to stimulate invention and to carry out the main purpose of the system, namely, "to promote the progress of the useful arts." Second, it is advantageous that American industry should not be handicapped in its competition with foreigners by the imposition of royalties from which the latter are exempt. Now, upon the interpretation of the defendants, no American inventor can safely take out any foreign patent, for if he does as he ought, and makes application with equal promptitude here and abroad, he will, in consequence of the delays arising from examination, interference and otherwise, incident to the American system (delays which do not arise abroad because foreign patents are granted without examination, and, therefore, very soon after application), receive his foreign patent long before—it may be years before—the issue of the U. S. patent, and the life of the latter will be substantially abridged; a damage for which no benefit derivable from foreign patents will furnish compensation. Nay, more, it is quite possible that delays in the American Patent Office which it is wholly impossible for the inventor to prevent, and which adverse interests often have it in their power to bring about, may occur which would bring his possible term to an expiration even before he could gain his patent.

Upon our construction, he must apply promptly here. That he can do; and when he has done it, as we read it, he is

safe and will suffer no loss, and incur no risk from delays he cannot control. But upon the view taken by the defendants he will be punished for the delays of others; and the risk of this will deter him from taking out the foreign patent which it is a part of the policy of our laws (and indeed the sole purpose of this section) to encourage him to take.

Any unjust result or consequence which would flow from a particular interpretation of a statute has always been regarded as a reason which, of itself, should induce a close examination of everything having a bearing upon the meaning of the legislature, that is to say, it justifies and requires the work of *interpretation*.

c. In the case of Wilson *vs.* Rousseau (4 How., 646), there had been a renewal of a patent. Prior to the renewal, the patent had been assigned, and the patentee on the one hand, and his assignees on the other, claimed the benefit of the renewal. The assignees placed their claim on the letter of the statute, which seemed reasonably clear if read alone and by itself: "And the ben-"efit of such renewal shall extend to as-"signees and grantees of the right to use "the thing patented, to the extent of "their respective interests." But the Court at one turned to the *consequence* of this view, and rejected it on the ground that its results were in such conflict with the whole scope and purpose of the patent law, that Congress could not reasonably be supposed to have intended it. Said Mr. Justice Nelson, in giving the opinion of

the Court (p. 680): "Nothing short of the "most fixed and positive terms of a stat- "ute could justify an interpretation so "repugnant to the whole scope and policy "of it, and to wise and judicious legisla- "tion.

"We think this construction not neces- "sarily required by the language of the "clause, and is altogether inadmissible."

6. But, further, Section 4887 is, on all hands, admitted to be a mere revision and re-enactment of Sec. 25 of the Act of 1870, and means precisely what that section means.* The proper question, therefore, is, what is the meaning of Sec. 25 of the Act of 1870? But the Act of 1870 is itself a revision of the then existing law, and this 25th section, if the interpretation of the defendants is correct, changes, in a very material respect, the law which it affects only to revise: for there is no doubt that, by the law as it stood at the time of the revision of 1870, and had stood for a generation, the taking out of a foreign patent had no effect upon the right of the domestic inventor, except when it was taken out prior to his *application*. It is a rule, without exception, that all revisions, when it is suggested that they change the pre-existing law, are *open to examination*, in order that it may be more clearly seen whether the pre-existing law is really changed; and, upon such examination, there is a *fixed presumption* that the prior law is *not* changed, unless there be evidence that such was the legislative intent.

*The two mean the same. *Edison Co.* vs. *United States Co.*, 35 Fed. R., 134 [WALLACE, J.]; *Siemens* vs. *Sellers*, 123 U. S., 276.

a. The reason of this rule is apparent. Revisions are usually the work of one mind, or a few minds, selected for the purpose of improving the *form*, without changing the *substance* of laws; minds, too, which are always endeavoring to express, and thinking they can better express, what another mind has attempted to express. When they are brought before the legislative body for enactment they are accompanied with the declaration, express or implied: "No change has been made by this revising bill in the substance of the existing law as it is settled by statute or judicial decision." The revisers themselves intend no change. The legislative body intends none. But the work of revising laws, of consolidating various statutes, pruning away redundancies, reconciling apparent contradictions, removing ambiguities, &c., is a task for the highest abilities, and is seldom well performed. Changes of language are inevitable, and yet are pregnant with the greatest danger of changing the meaning.

But for the rule above mentioned, every considerable revision would, in the language of Mr. Justice Baldwin (McClurg *vs.* Kingsland, 4 How., 202, 211), by "changing the law according to every "change of mere phraseology, make it a "labyrinth of inextricable confusion."

b. A multitude of authorities have sanctioned this doctrine. Those mentioned below are among them.

August, 1805. *Taylor* vs. *De Lancey*, *2 Caine's Cases in Error*, *143*.

The statute of the State of New York,

revising the prior law in relation to the granting of administration on intestates' estates, declared, "That where any person "dieth intestate, the widow, or next of "kin, or any of them, of the deceased "person, if they, or either of them, will "accept the same, &c., shall be deputed."

It was claimed, upon the language of this statute, that administration should be granted to all coming within the class who asked for it. But the Court, in view of the prior law, which clothed the Surrogate with a discretion to make a selection from those who might ask, held the claim to be erroneous. Mr. Justice Spencer, giving the opinion of the Court, says: "My opinion "is founded on this proposition, that where "the law, antecedently to the revision, was "settled, either by clear expressions in the "statutes, or adjudications under them, "the mere change of phraseology shall not "be deemed or construed a change of the "law, unless such phraseology evidently "purports an intention in the legislature "to work a change. A contrary construc- "tion might be productive of the most "dangerous consequences."

Aug. 1809. *Case of John V. N. Yates*, 4 Johnson, 316:

p. 359. "That the 'mere change of phraseology' in the revised laws was not to work a change in the established interpretation, was the unanimous decision of the Court for the correction of errors, in 1855, in the case of Taylor *ex.* Delancy (2 Caines' cases in error, 150, 151)."

Feb. 1823. *Goodell* vs. *Jackson*, 20 Johnson, 693:

p. 721. "Besides, it had already been

settled, by the unanimous opinion of the Court of Errors in 1805 (Taylor *vs.* Delancy), that even the change of phraseology in the language of a revised act should not be deemed or construed to be a change of the law as it stood before the revision, unless such phraseology evidently purported an intention in the legislature to work a change."

July, 1839. *In the Matter of Brown*, 21 Wendell, 316, *head note*, p. 319. "It is a rule of construction that a mere change of phraseology in a revision of the statutes will not be deemed to alter the law, unless it evidently appear that such was the intention of the legislature."

May, 1840. *Douglass* vs. *Howland*, 24 Wendell, 35:

p. 46. "It cannot be that the formal change meant a change in substance. The transmutation of a principle of the common law, or a rule of practice, into a statute, or an old statute, or its received construction into a new one, *without a palpable design to depart* from the former, *ought not to be considered as a departure.*"

Feb. 1842. vs. *Theriat* vs. *Hart*, 2 Hill, 380:

p. 380. "A mere change of phraseology in the revision of a statute will not alter the law as previously declared, unless it clearly appears that such was the intention of the legislature."

Sept. 3, 1849. *Crosswell* vs. *Crane*, 7 Barbour, 191:

p. 195. "It is well settled that in the revision of statutes an alteration in the phraseology, or the omission or addition of words, does not necessarily alter the con-

struction of the act, or imply an intention on the part of the legislature to alter the law. In a revision of the laws a reform of the language is not necessarily an alteration of the law. The intent of the legislature to alter the law must be evident, or the language of the new act must be such as palpably to require a different construction, before the Courts will hold the law changed upon such revision, merely from the fact of a change of the language employed."

April, 1852, *Elwood* vs. *Klock*, 13 Barbour, 50:

p. 55. "There is no evidence that the revisers or the legislature designed to change the effect of the former statutes upon this subject. The change in the language does not necessarily imply a change in the statute revised."

Jan. 1851. *Dominick* vs. *Michael*, 4 Sandford, 374:

p. 409. "For nearly half a century it has been a cardinal and controlling maxim, that, in the construction of a revised act, a mere change in the language shall not be regarded as evidence of an intention to vary the construction, unless the change is such as to render that intention manifest and certain."

May, 1853: *Taggard* vs. *Roosevelt*, 8 Howard Pr., 141:

p. 142. "I know it is a well-established rule that an alteration of the phraseology of a statute in a revision of it does not necessarily alter the construction, and that the intent of the legislature to alter the law must be evident to render a different construction proper."

April 16, 1878. *Jenkins* vs. *Fahey*, 73 N. Y., 355:

> p. 362. "A difference in the phraseology or verbiage of a statute in a revision does not necessarily call for a different construction, or import a change in the law."

January, 1878. *The Schooner "L. W. Eaton,"* 9 Benedict, 289:

> p. 301. "Undoubtedly, where the language of any section of the Revised Statutes is so clearly different from the language of any prior provision referred to in the marginal note to such section, as to make it impossible to give to the new language the same meaning and interpretation which were given to the former language, the new language must receive a different meaning and interpretation. But the presumption is against any intention that new language should have a different meaning and interpretation. The presumption is that the new language is the result merely of revision, simplification, re-arrangement and consolidation, with a view to the re-enactment of the same substance and meaning."

April, 1879. *The Bark "Brothers,"* 10 Benedict, 400.

> p. 402. "While in the construction of the Revised Statutes, the presumption is against an intention to change the law, yet when the language used in the revision cannot possibly bear the same construction as the revised and repealed Act, full effect must be given to the new enactment."

7. These well-settled rules have been vigorously

applied to the work of the Commissioners of Revision upon this very section.

This section of the statute of 1870 (s. 25) declared that "the patent shall expire" with the foreign patent. R. S. 4887 enacted that "the patent shall *be so limited as to* expire," etc. It was contended that under the R. S., the *patent* would be *void* unless it was so limited by its terms. The words added in the R. S. were apt to convey this meaning, and, if they did not effect this, their insertion was totally without effect. Undoubtedly the fact was that the commissioners intended this change, though their report did not call attention to it, and that Congress voted without noticing the change, or actually intending to make any. Thereupon the Courts held that a change of plan or policy was not to be deduced from a revision, unless the language was not only apt, but so "plain and unequivocal" as to "demonstrate that intention beyond a doubt." In other words, the use in a revision of language plain enough, if taken by itself, to effect a change in the law, will not be allowed to have the effect, *unless the Court is satisfied that Congress in fact realized that effect, contemplated it and actively intended it.*

This decision was made in *Canaan* vs. *Pound Mfg. Co.*, 23 Bl., 173 (WALLACE, J., 1885). In *Bate* vs. *Hammond*, 129 U. S., 151, 169, the Supreme Court, deciding the same question the same way, referred with approval to this very decision and reasoning in *Canaan* vs. *Pound*.

The Supreme Court, in *U. S.* vs. *Bowen*, 100 U. S., 508, approved this rule, and their application of it is instructive. It appeared that the statute which created the Soldiers' Home required all regular army soldiers to

contribute to it by stoppages from their pay, and gave them its benefits without charge. It also provided in another section, that soldiers who had not contributed might have its benefits upon assigning to the Home their invalid pensions during residence there. A later army appropriation bill contained language which seemed to require *all* occupants to transfer their pensions. R. S. 4814 and 4820 copied the provisions of the original Act which established the Home. Bowen, a regular army soldier, who had contributed by stoppages, refused to transfer his pension. The Court held that he need not. It approved the rule of construction we have quoted, but pointed out the clear justice of the distinction which the R. S. made, and that its view did not rest upon the meaning of a single word, but upon the whole frame work of the chapter.

The case of *Blake* vs. *National Banks*, 23 Wall., 307, elsewhere cited, is a further instructive illustration.

Meyers vs. *Car Co.*, 102 U. S., 1, is another instance of the application of the rule.

And it has been applied to cases where the statutes were rather by way of *amendment* than revision. *Butterworth* vs. *Hoe*, 102 U. S., 50, 58, where the Court observed: "We are led, therefore, to inquire whether such a construction of phrases * * * is justified by a view of the whole legislation *in pari materia*, and consistent with the integrity of the system of the statutes in relation to Letters Patent for new and useful improvements."

c. The argument of the appellees is that, because in this revision the language of

the prior law has been changed, it must be presumed that a change in the law was intended. This argument is thus dealt with in a recent very accurate English work on Statutory Interpretation, edited by an American, Mr. Endlich:

"The presumption of a change of intention from a change of language, of no great weight in the construction of any documents, seems entitled to less weight in the construction of statutes than in any other case, for the variation is often to be accounted for, not only by a mere desire of improving the graces of style and of avoiding the repeated use of the same words, but from the circumstance that Acts are often compiled from different sources; and further, from the alterations and additions from various hands which they undergo in their progress through Parliament" (Endlich on Statutory Interpretation, Sec. 378). And the American editor says, in Sec. 381: "The importance of the principle which attaches slight weight to mere changing of phraseology is particularly manifest in the construction of statutes that are substantially re-enactments, or that are intended as revisions, or consolidations, of others. As to such enactments, it is well settled in this country that, in the absence of an intention to change the law sufficiently clearly appearing from other guides of interpretation, or unless the change is such as in itself to render such an intention manifest and certain, mere variation in the language of such enactments from the language of former statutes on the same subject, under which the law has become settled, will not be regarded as intended to call for a different construction."

8. The presumption against change in a revising law is comparatively weak where the change is unimportant, or confined to some matter of detail, for the reason that such changes are a common and proper part of the work of revision. Changes of this sort are made in the section under consideration. But where the alleged change is one of *substance*, and affects the *policy* of the law, the presumption is strong, because this is beyond the proper office of revision. The present alleged change is one of this character. It *reverses* a long-settled policy, and reverses it contrary to the plainest dictates of reason and justice.

9. If there could still be any doubt that the section under notice is open to interpretation, it would be dispelled by a brief reference to the numerous adjudications, other than those interpreting revising statutes, upon the question when Courts will go beyond the particular language in which a statutory provision is expressed to ascertain its meaning, even when the language of the provision, taken by itself, seems plain.

It so happens that many of the most instructive instances are to be found in the judicial interpretation of the same kind of legislation as that now under notice, namely, the statutes relating to patents. We need not go outside of these for illustration.

a. In the case of Pennock *vs.* Dialogue (2 Pet., 1), the words in the first section of the Act of 1793, "not known or used before the application," were held to mean, not known or used *by the public* before the applica-

tion. The statute taken literally would have made any knowledge or use by any persons other than the inventor, and, indeed, even by him, prior to the application, fatal to the patent; but the Court held that such a construction would be unreasonable, because it would make knowledge or use by the assistants of the inventor, or even by a pirate, grounds for invalidating a patent. It, therefore, read into the statute the words, "by the public."

And it declared, also, that the words "by others" must be read into the expression "not known or used before" in the prior Act of 1790. This liberality of interpretation was based upon the reasonable ground that, even if the language of a statute seems clear when taken literally and by itself, still, if such an interpretation would impute an intention to Congress which it could not fairly be supposed to have entertained, the statute will be open to interpretation, and a meaning will be given to it consistent with reason, and in harmony with the general object of the law, unless the literal construction is absolutely required.

b. A very striking instance is presented in the case of Siemens *vs* Sellers (123 U. S., 276). The Act of 1861, introducing several changes into the patent system, enacted: "That all patents hereafter granted shall "remain in force for the term of seventeen "years from the *date of issue*." A prior law, that of 1839, had provided in cases of the issue of a patent, where the inventor had previously taken out a patent in a

foreign country more than six months before the application, "that in *all* cases every "such patent shall be limited to the term "of fourteen years from *the date or publi-* "*cation of such foreign Letters Patent.*"

It would seem extremely difficult to hold that this latter provision remained in force after the passage of the Act of 1861, but it was so held; and not only that, but that it was to be treated as *amended* by the Act of 1861, and that "seventeen" must be read into it in place of "fourteen." And the reason assigned was that, when the Act of 1861 was passed, the substitution of seventeen instead of fourteen years, the ordinary duration of a patent, "was the "only point before the legislative mind. "Seventeen years was substituted for "fourteen years. That was all that was "intended or thought of" (p. 285).

The argument we are answering was much pressed in this case. It was insisted that the language, "all patents hereafter granted shall remain in force for the term of seventeen years from the date of issue," were susceptible of but one interpretation; and this is true, if the words are taken by themselves. But, in view of the results which such an interpretation involved and the prior history of the law, the Court declared that this interpretation could not be accepted. It said, "No doubt the words "of a law are generally to have a control- "ling effect upon its construction; but "the interpretation of these words is often "to be sought from the surrounding cir- "cumstances and the preceding history."

c. Moreover, the use of such phrases as

"*the date of the patent*," "*before a patent* "*is obtained*," "*before it is patented*," "*before taking out a patent*," and many others *prima facie* referring to the act and date of the *issue* of a patent, to indicate the act and date of the *application*, is extremely common among lawyers and Judges, and especially with the Supreme Court.

See instances, pp. 71 – 73, *infra*.

10. But the question whether the section *admits* of but one construction will not be decided until the Court has before it the whole argument embracing the history and policy of the legislation. It is but a small part of that which we have thus far employed for the purpose of showing at the outset that there is a question of interpretation in the case. The rest will be best reserved for the main discussion.

It is quite probable that this *preliminary* argument is wholly superfluous. The main question in this case, and upon the same patent, was before this Court in the case of Bate Refrigerating Company *vs.* Hammond (129 U. S., 151). A decision of this question alone would have fully disposed of that case. But it so happened that there was another point in the case, a decision of which, if in favor of the complainant, would also dispose of the case. This was whether the American Patent would *expire*, within the meaning of the section, upon the expiration of the term to which the Canadian patent was limited at the time of the *grant* of the American patent, or not until the expiration of the *extensions* of that

term. The Court decided this second question in favor of the patentee and reversed the decree below, and expressly *declined* to decide the first.

It is not probable that the Court would have *avoided* this question by selecting another and making a decision which involved a reversal of the rulings of five Circuit Courts, unless it had regarded the question as one of doubt.

Second Point.—The statute (Sec. 4887) is, therefore, *open to interpretation*; and the inquiry is what Congress intended by the words "*first* patented or caused to be patented in a foreign country"; and by the words "*previously* patented in a foreign country." Do they mean patented in a foreign country before the *issue* of the patent here, or before the *application* for it? A review of the course of legislation upon the subject, in the light of justice and reason, and the clear policy of the law, will leave no reasonable doubt that the latter meaning was the one intended.

1. It will be agreed that the true method of inquiry is to ascertain what the law was upon the point in question prior to the employment of the particular language under interpretation, to the end that we may see whether there were any, and what mischiefs or difficulties in the pre-existing law which the language was calculated to correct.

And, as the point in controversy turns upon the effect of taking out a foreign patent upon the rights in this country of the in-

ventor, it is important to have a clear understanding of what that effect was prior to the employment of the language referred to.

2. Inasmuch, however, as the section in question was substantially framed by the same hands, in the prior revising statute of July 8th, 1870, and must be taken to have the same meaning as the corresponding provision in that statute (Edison Co. *vs.* United States Co., 55 Fed. Rep., 732; Siemens *vs.* Sellers, 123 U. S., 276), the inquiry should be directed to what the law had been, and was, at the time when the revision of 1870 was framed. We proceed, therefore, upon that inquiry.

3. One of the incidents of our patent law, as originally framed, was that a foreign patent, being a *voluntary disclosure* by the inventor of his discovery, would, when taken out prior to his application in this country, debar him from a patent here. This result was not consistent with reason, justice, or sound policy; nor had Congress ever affirmatively intended it. When its mischiefs, not at first apparent, came to manifest themselves, a remedy was called for; and by suitable provision, in the legislation of 1836 and 1839, a plan was adopted designed to place, and which did place, the matter upon a just and reasonable footing.

a. The first statutes of the United States bestowing patents for useful inventions were framed in exceedingly brief and sim-

ple language. Their *object* was correctly expressed in their titles to be "To promote the progress of the useful arts." The *means* adopted to carry out this object was to bestow a limited property right upon such inventors as might give to the public the benefits of an invention which it did not already possess. The Act of 1790 described the persons entitled as being those who "have *invented or discovered* any useful art, manufacture, engine, machine or device, or any improvement therein, "*not before known or used.*" That of 1793 making but little change in language other than to limit the privilege to citizens of the United States, and to express, and thus to make certain, what was before implied, namely, that the point of time to which the word "before" in the prior statute related was the time of the application, declared the persons entitled to be those who "have *invented* any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement on any art, machine, manufacture, or composition of matter, *not known or used before the application.*"

b. These statutes received an exposition by this Court in the cases of *Pennock* vs. *Dialogue*, *2 Pet., 1*, and *Shaw* vs. *Cooper*, *7 Pet., 291*, and their meaning in respect to the important questions, who should be entitled to a patent, and how the right to a patent originally existing might be lost, was fully explained.

The following points may be gathered from this exposition :

First.—The meaning of the Act of 1790 and that of 1793 was the same. The more careful wording of the latter only served "to clear away a doubt and fix the orig-"inal and deliberate meaning of the legis-"lation."

Second.—The Statute of 1793, properly read, imposed four requirements on the inventor in order to entitle him to a patent:

(*a.*) He must be the *original* inventor; that is, the device must have been the product of his own mind.

(*b.*) He must be the *first* inventor: that is, the invention must not have been *known* at the time of his *discovery*.

(*c.*) It must not have been *publicly* known or *used* before his *application*: that is, his application must precede any other public disclosure.

(*d.*) He must not have *abandoned* it, a presumption of which would arise if he used it for profit (even though he did that in such a way as not to disclose such knowledge as would enable others to use it), and applied for a patent only when his secret was in danger of discovery.

c. It follows that any *voluntary* disclosure of the discovery by the inventor, before his applicatfon, would have *debarred* him from gaining a patent; and a disclosure abroad would have been as fatal as one at home. In respect of knowledge, the world was taken as a unit. The public would already *have*, and with the assent of the

inventor, that knowledge, to gain which was the sole motive of bestowing the patent. The inventor could not pay the consideration for a patent, namely, the *first knowledge* of the invention.

Consequently, *the taking out of a patent in another country, before application for a patent here, would effectually defeat that application*, not because it was a *patent*, but because it would be a voluntary and complete *disclosure*, as much as a publication of the discovery abroad by the inventor would be.*

d. And inasmuch as the law in other countries was, presumably (as it was, indeed in fact) substantially similar, the consequence was that, in the absence of special legislation, a patent in any country would be a bar to the obtaining of a patent in any other country. So far as an inventor had a privilege of applying in different countries for patents, it was for him to determine in what country it was most expedient for him to apply. So far as obtaining a patent was concerned, the world was not one country; but in respect to the transmission of knowledge it was. What was to be kept as a secret in the United States could not be published in Europe.

e. This result was in no sense a part of our public policy. There could not have been any design to prevent our citizens from ob-

* Such was accepted and judicially declared to be its effect. *Pennock* vs. *Dialogue*, 2 Pet., 1, 22 [1829]; *Shaw* vs. *Cooper*, 7 Pet., 292, 313, 316, 319 [1833]; *O'Reilly* vs. *Morse*, 15 How., 62, 127; *Siemens* vs. *Sellers*, 123 U. S., 276, 284. All the legislation on the subject assumes that such was the effect of the law prior to 1836.

taining patents abroad. This disability followed as an *incident* from the requirement that the invention should not have been "known or used before the application." Of two applications in different countries one must precede the other; and when one had been made, it could no longer be said that the invention was not known.

This undesirable consequence, was, however of little importance in the infancy of our patent system, and when the products of invention were few. At that time the taking out of foreign patents by our own citizens was not, to any appreciable extent, even thought of. It might well enough be dismissed from attention in the framing of any scheme of legislation; and the taking out of patents here by foreigners was not permitted by the statute of 1793.

f. But, in the course of subsequent years the conditions became changed. The exclusion of foreigners from the privileges of our patent system was reconsidered and done away with in respect to such as had resided in this country two years, and had declared their intentions to become citizens (Act of April 17, 1800). And by the Act of July 13th, 1832, the requirement of a two years' residence was abrogated. The motive to this legislation was not that of generosity to foreigners. The object was to encourage foreigners to make efforts to introduce their useful inventions into the United States. Patents issued under the Act of 1832 to foreign citizens were to be void in case the patentee should fail to introduce his invention into public use in the United States.

At the same time inventions by citizens of the United States had become prodigiously multiplied, and in many instances it was very desirable for American inventors to obtain patents abroad. There could be no objection to this; on the contrary, all reasons of policy were in favor of it. It enabled the American inventor to obtain a further reward for his ingenuity without imposing any additional burden on our own citizens; and, moreover, it tended to relieve our own industries from the handicap they were under when obliged to pay royalties from which their foreign competitors were exempt.

g. But the native inventor could not obtain a patent here without forfeiting his right to procure one abroad, nor could he obtain one abroad without forfeiting his privilege here. Such a condition of the law was most unwise and even discreditable. It could not escape attention when the new system established by the Act of 1836 was framed, and provisions were embraced in that Act which set the matter entirely right.

h. The Act last referred to made no distinction between citizens and foreigners in respect to the privilege of applying for a patent. It adopted, in the main, the simple and excellent language in which the essential requisites of a patentable invention had been framed in the prior statutes. It made, however, the language "not before known or used" refer, not to the date of the *application*, but to the

date of the *discovery;* and it used other words to indicate that sort of possession by the public of a knowledge of the invention which should defeat the application, and referred this to the date of the application; thus, "and not at the time of his application for a patent, in public use or on sale, with his consent or allowance as the inventor or discoverer."

Compare Sec. 1 of Chap. 7 of Statute of 1790; Secs. 1, 3 and 6 of Chap. 2 of Statute of 1793; Secs. 6 and 7 of Chap. 357 of Statute of 1836.

i. A slight further change of policy was introduced by the Act of 1836 in respect to the requirement that the applicant should be the *first* inventor. It was, to some extent, the practice of foreign inventors to refrain from taking out a patent, but to withhold from the public and *secretly use* their inventions. It was thought expedient in such cases to allow one who was the first inventor in the United States, and who had made the discovery originally and without aid from such secret use, to still take out a patent, although he might have been preceded by some foreign inventor. This was effected by requiring from him an affidavit that he believed himself to be "the original and first inventor," and then, providing that the patent should issue to him, in case it should not appear on the examination in the Patent Office which was created by the act, "that the same had been invented or discovered by any other person *in this country* prior to the alleged invention or discovery thereof by the applicant, or that it had been *patented or described*

in any printed publication in this or any foreign country, or had been in public use or on sale with the applicant's consent or allowance prior to the application" (sec. 7; sec. 15, first provision).

This allowed the application to be defeated by any prior foreign patent or printed publication before the applicant's discovery, because it would show that he was not the first inventor, but deprived a mere *secret* foreign use or knowledge of its effect as a bar. It also left a *public use* at any time before the application to defeat the patent, as showing that the public was already in possession of the invention; but it required that this public use should have been, as the Courts had already in substance decided, without such words, that it should be, with the consent or acquiescence of the applicant.

Pennock *vs.* Dialogue, 2 Pet. 1, 11.

k. The provision made by this statute for the case where an inventor desired a patent in the United States and in foreign countries also, which, under the operation of the prior law, he could not have, was quite simple, although it was, rather inaptly, placed in the same section with a matter to which it had no relation, namely, that of *interferences*. Congress could not compel an inventor to take out a patent abroad; but it could leave the natural inducement to do so to operate upon him by relieving him from the danger involved in that step. It could declare that a foreign patent should not operate as a disclosure here, and thus prevent a patent here. An obvious possible

mischief was, however, to be guarded against, namely, that of a delay, possibly a long one, and, it might be, brought about by the inventor himself, after the foreign patent and before the patent here.

Such a delay would be against the settled policy of the law which was to induce the inventor to give to the public in the United States the benefit of his invention as soon as possible. And the mischief might go further and enable the inventor to exploit his discovery abroad for a great length of time, and then, when foreign industries were about to be relieved from the burden of the royalty, to impose it for a long additional period upon our own. The obvious way of guarding against this mischief was to induce the inventor to apply for his patent here within a short limited time after obtaining his foreign patent, and thus make the patents substantially synchronous. Accordingly the bar of the foreign patent was lifted only as to inventors who made application here within six months after obtaining their patents abroad.

m. The language in which this intended provision was expressed, although somewhat awkward, was well adapted to attain the object. It was: "But nothing in this act contained shall be construed to deprive an original and true inventor of the right to a patent for his invention by reason of his having previously taken out Letters Patent therefor in a foreign country, and the same having been published at any time within six months next preceding the filing of his specification and drawings."

3. The foregoing review of our legislation down to 1836 makes the following points very clear:

First.—That the earlier statutes of 1790 and 1793, by making it, among other things, essential to a patent that the invention should not have been "known" by others than the inventor before the application, rendered a foreign patent issued to the same inventor, prior to his application, a bar to a patent here. This was a result not agreeable to justice or sound policy; but at that early period when there was little, if any, disposition to take out foreign patents, it was not of sufficient consequences as an evil to attract notice and call for a remedy.

Second.—Prior to 1836 it had become otherwise. There was a growing advantage to inventors to be derived from foreign patents, and no reason why the taking of one should be made to involve a forfeiture of the inventor's privilege here, or any other punishment. The practice of taking them, so guarded as not to be the source of incidental mischiefs, was, on the contrary, one which our law should encourage.

Third.—It was the intention of Congress in 1836 to do away with this objectionable incident of our patent law, as it then stood, and to *encourage* the taking out of patents in foreign countries. To this end, while by Section 6th of the act of that year careful provision was made to insure that the applicant for a patent should be the *first inventor*, clauses were inserted in Section 7, apparently designed to prevent

mere *knowledge* of the invention prior to the application, as distinguished from *use* from being a bar. Patenting, or description in a printed publication, if after the discovery by the applicant, was no longer to be a bar, unless the invention had been "in public use or on sale, with the inventor's consent or allowance, prior to the application." Mere *disclosure* before application was apparently to be no longer fatal. It would seem, however, that some one who had a hand in shaping the statute was, apparently, not sure that this result was secured by Section 7; and, perhaps, it was not *secured*; for the choice of a foreign patent in preference to an American one may furnish, in some cases, material support to the vague and uncertain doctrine of *abandonment*. To remove all doubt upon this point, and it being at the same time thought important that one who had taken out a patent abroad should not long delay in making his application in this country, a clause was framed and introduced into section 8, designed to have the double effect of making it clear that a foreign patent should not bar a patent here, and that the application here, thus encouraged, should not be long delayed. This clause is the one beginning with the words, "But nothing in this act contained shall be construed to deprive."

Fourth.—This language must be construed as if the supposition, or assumption, upon which it proceeds were really the fact, and then the effect of the provision becomes, what no one will doubt it really is, a liberty to a *certain class of inventors* to take out patents abroad without affecting their privilege of taking out patents in this country.

That *class* is those who use diligence and *apply* for a patent here within six months after obtaining the foreign patent. Any *later* applications would, as the framer of the clause supposed, be absolutely defeated by the foreign patent. That is, they would be left to what was supposed to be their fate under the old law.

It will be observed that this provision, designed to secure promptitude on the part of the inventor, did not make the period of six months immediately precede the time of *taking out the patent*, but the time of the *application*. If the former point of time had been adopted, the privilege designed to be given would have been a barren one. Few inventors who preferred the American field —and every American inventor would fall within that class—would have hazarded the taking out of a foreign patent on the chance of actually obtaining an American one within six months. Nor would he, had the margin been made very much larger. The possibility —indeed, the probability—that circumstances quite beyond his control would defer the issue of the American patent, would promptly decide him not to avail himself of the privilege offered.

4. This provision gave much reasonable facility for patenting abroad; but Congress, apparently thinking it that might well be further extended, it was amended by the Act of March 3d, 1839, and by a section especially given to the particular matter. *It did not operate at all upon the class of persons* to whom the privilege was given by the Act of 1836; but *upon those out-*

side of that class. Nor did it enlarge *that class* by bringing any of those outside *within* it; nor touch or affect those who already were within it. It did not, in any manner, either expressly, or by any implication, repeal or alter the provision of the Act of 1836, or affect its results. On the contrary, the new provision was declared to be "additional" to that. It created a *new class* of persons who, after patenting abroad, might still receive patents here.* This was the willfully *tardy* class, those who might *neglect* to apply here within six months after obtaining patents abroad. And to these it did not give such a patent as it awarded to the first and diligent class; but abridged it by limiting its duration to the term of fourteen years from the date of the foreign patent.

5. The condition of the law upon the point of the effect of a foreign patent after the Act of 1839 was entirely clear. Those who applied for the American patent, within six months after obtaining a foreign patent, were entitled to receive one for the same period as patents ran in other cases. Those guilty of *laches* and not making application within this period, might still apply, provided their inventions had not got into "public and common use"; but, even when thus entitled to *apply*, the patent granted was to be limited to a period of fourteen years from the date of the foreign letters.

The plan was to *encourage* patenting *both here and abroad*, and not to grudgingly permit it. Congress intended to accomplish this by

* See cases under next paragraph.

making patenting in both countries easy, and free from risk of forfeiture in either. Curtailment of the patent was not made the rule; it was not desired. It was the consequence of *willful, unnecessary, pernicious* delay. And although the curtailing provision did not, in terms or in law, distinguish between citizens and aliens, yet, from the nature of the case, as was well understood, *it bore chiefly on foreigners:* because the American would naturally apply here first.

This interpretation of the statutory law, as it stood upon the enactment of the Act of 1839, has been fully agreed to by the authorities:

Fisher, Com. in *ex parte* Cochran, C. D., 1869, p. 60.

Holt, Com. (quoted in above case).

Kendrick *vs.* Emmons (Shepley, J.), 2 B. & A., 208; C. D., 1876, p. 204.

6. A well-settled procedure grew up under this construction of the law. The ordinary course was to apply here and hold back the proceedings, take out the foreign patent meantime (and, therefore, without risk of losing it from premature publication), and then complete and take the U. S. patent.

O'Reilly *vs.* Morse, 15 How., 62, 126.

Third Point.—After this plan had stood without objection for more than thirty years, the Commissioners appointed to revise the laws of the United States completed a revision of

the laws relating to patents. This was reported to Congress in 1870, with the explanation that it was a revision working no change in substance. It was enacted without any change affecting the present argument and became what is herein referred to as the Act of 1870. It was re-enacted in the general revision of 1873, without any change, save a slight and wholly unimportant one in mere phraseology. The provision contained in it relative to foreign patents is easily susceptible of an interpretation which makes it, what it was declared to be, a re-enactment of the prior law without material change of plan or substance. It is our contention that it is such a re-enactment. It is, nevertheless, insisted by the appellees that another interpretation *must* be put upon it, which reverses the just and reasonable policy of the prior law, and substitutes in place of it a plan repugnant to reason, unjust to inventors, and injurious to the public.

Such a proposition is erroneous upon its face, and is, besides, refuted by a great number of separate, but concurring, reasons:

1. We say it is erroneous upon its face, *first*, because it wholly ignores a settled rule of law relating to the interpretation of *revising* statutes. This consideration has been already alluded to; but only for the purpose of showing that the statute *is open to interpretation*. It is equally pertinent upon the question of interpretation after that is declared to be open for debate.

   What *is* the business of *revising* statutes? It is the work of eliminating the repetitions and redundancies and reconciling the in-

congruities which have crept into the law chiefly by reason of its having been made the subject of legislative action by different hands, at different times and for different purposes, ~~as well as of~~ simplifying language and putting the law into a clearer and more accessible form. In the case of a statute having no other purpose than amendment, *change of language* generally imports a corresponding change in the *law*; but in *revisions* it is otherwise. The meaning of *revision* is change of language *without* change of substance; and hence, the reasonable rule that, in the case of revisions, it is to be *presumed* that a mere change of language was not intended to effect a change in the law. This presumption may, indeed, be displaced by evidence tending to show that the legislature designed to do something more than merely to revise; that it intended also to *amend*. This evidence may be furnished by showing that there was some recognized injustice or imperfection in the operation of the prior law which the change of language was well calculated, and, therefore, presumably designed, to remedy; or by showing from the debates, or other proceedings, on the framing or passage of the law, that the legislative mind had in view the matter upon which the changed language bears.

and especially for the purpose of merely

Nevertheless, the appellees insist, and their interpretation cannot be justified unless they are right in insisting, that every change of language necessarily imports a corresponding change in the law, and that Sec. 25 of the Act of 1870, and 4887 of the R. S., are to be interpreted as if they were pieces of original legislation.

If such a canon of interpretation were followed, the work of revising laws, so far from

removing prior doubts and difficulties, would be the fruitful source of a multitude of new ones. It would throw the law into inextricable confusion.

2. But in the present case we have not only the *presumption* above mentioned, that no change in the law was intended in the *particular under notice*, but the history of the Statute of 1870, and the incidents attending its passage, demonstrate with a certainty which leaves no room for doubt that the words "*first patented*" mean and only mean, patented "*before application*."

a. The act providing for the revision of the laws of the United States, passed June 27th, 1866 (14 Stat., 74), made it the duty of the Commissioners to "bring together all "statutes and parts of statutes which from "similarity of subject ought to be brought "together, omitting redundant or obsolete "enactments, and making such alterations "as may be necessary to reconcile the con- "tradictions, supply the omissions, and "amend the imperfections of the original "text." "And they shall arrange the "same under titles, chapters and sections, "or other suitable divisions and sub- "divisions, with head notes briefly ex- "pressive of the matter contained in such "divisions: also with side notes, so drawn "as to point to the contents of the text, "and with reference to the original text "from which each section is compiled, and "to the decisions of the Federal Courts, "explaining or expounding the same, and

"also to such decisions of the said Courts "as they may deem expedient." And they were in substance directed that whenever they might make changes amounting to alterations of the law they should distinctly indicate that such was their character. "They shall also suggest "to Congress such contradictions, omis- "sions and imperfections as may appear "in the original text, with the mode in "which they have reconciled, supplied "and amended the same" (Sec. 3.) The work of *pure revision* could not be better described than by the foregoing language. No power was given to improve, amend or change, except as above stated.

b. By the early part of the 41st Congress this Commission had completed its revision of the Patent Laws, and reported it separately to Congress, and this report was, in the House of Representatives, referred to the Committee on the Revision of the Laws. It was examined by that Committee and found "*to embody all the pro-* "*visions of existing law* in brief, clear "and precise language." It was then referred, at the request of the same Committee, to the Committee on Patents. (*Cong. Globe*, 2d Series 41st Cong., Part 3, p. 1069–1079, 2680.)

c. It was reported back from the Committee on Patents on the 14th of April, 1870, with certain proposed amendments, and was brought up for discussion and action on April 14th, 1870, by Mr. Jenckes, the Chairman of that Committee, and was by

him explained to the house in an oral report. (*Cong. Globe, supra*, p. 2679, *et seq.*) It was in relation to these amendments that the bill was entitled as one to *amend* as well as to revise and consolidate the law.

d. In his oral report to the House explaining the bill, Chairman Jenckes spoke as follows:

"Mr. Speaker, if the House will indulge "me, I think they will obtain a sufficient "idea of what is proposed by the bill, "from a statement in explanation of the "provisions, without reading it in full.

"The bill now reported from the Com- "mittee on Patents is based upon the revis- "ion of the laws relating to patents and "copyrights made by the Commissioners "of Revision appointed under the statute, "authorizing a revision of the laws of the "United States. That revisal of those par- "ticular statutes was reported to the "House early in this Congress, and re- "ferred by the House to the Committee on "the Revision of the Laws of the United "States. *It was examined by that Com- "mittee and was found to embody all the "provisions of existing law, in brief, "clear and precise language.* They sub- "sequently reported it to the House, and "recommended that it be referred to the "Committee on Patents.

"In prospect of the proposed revision, "the Committee on Patents had already re- "ceived numerous communications from "those interested in the subject, and also "numerous bills and petitions that had "been filed in the House and referred to

"that committee, proposing various amend-
"ments to the existing laws. They had
"taken all these into consideration, and in-
"vited the presence of persons interested
"in the different subjects to which the
"amendments were intended to apply, and
"encouraged discussion from those inter-
"ested and from those proposed amend-
"ments. They were heard at great length,
"and the committee were very careful to
"give a hearing, either orally or by written
"communication, to any and every person
"who supposed that there were defects in
"the existing laws which ought to be
"remedied, or who could make plain and
"clear the practice under the laws, so as to
"secure more perfectly the rights which
"these laws were intended to protect. The
"result of all those hearings and discus-
"sions has been the adoption by the com-
"mittee of certain propositions of amend-
"ment to those laws, which they have
"embodied in the bill now before the
"House.

"The bill is so printed *as to show the*
"*law as it now is*, in the form in which it
"came from the hands of the Commis-
"sioners of Revision. Every provision
"*which is now in force has been printed*
"*at length in the bill*, although it is pro-
"posed to strike out by way of amendment
"many of them. All those which it is pro-
"posed to strike out are printed, and the
"amendments, many of which are substi-
"tutes for the parts proposed to be omitted,
"are also printed separately, and in italics,
"so that they may be clearly distinguished
"from the law as it now is. *The House,*
"*therefore, now have before them in the re-*
"*ported bill the exact state of the law,*

"those provisions of the law which it is "recommended shall be dropped, and of "the new provisions which shall be substi- "tuted in their place, and also of the "various amendments which are proposed "to different parts of the bill. It can be "seen, therefore, at once what has been the "law, what is the law, in what respect the "existing law is supposed to be defective, "how that defect is proposed to be "amended, and how the law will be read if "the amendments should be adopted.

"Having thus stated the history of the "bill, and the state in which it is presented "to the House, I will consider the general "provisions of the act, without at the "present time going into details."

c. This explanation by Chairman Jenckes enables us to ascertain at once, by examining this *rejected bill*, what the Commission of Revision and the Committee on Patents concurred in believing, and what the Chairman of the latter Committee authoritatively declared to the House, to be *the existing law*, as it stood prior to this revision, although the phraseology in which it was expressed might be different from that of the actual law on the statute book. It appears also by this reported bill that wherever the Commissioners proposed to *leave out* any words in the existing statutes, which leaving out might be thought to change, in the smallest particular, the existing law, or where their proposed amendments were *substitutive*, and thus required such leaving out of any words, the words to be left out were included in brackets.

f. With these guides, let us now see what the revising bodies above referred to, and, presumably, Congress also, regarded as the *then existing law*. It is to be found in what is printed in Roman letters, and *that* part of Sec. 25 is as follows: "No "person shall be debarred from receiving a "patent for his invention or discovery by "reason of his having first patented it in a "foreign country, provided the same shall "not have been introduced into public and "common use in the United States prior to "the application, and that the patent "shall be limited to seventeen years from "the date or publication of the foreign "patent."

g. Comparing this with Section 6 of the Act of 1839, the law as it then stood on the statute book, and bearing in mind that the part of the proposed Section 25 above quoted was intended and declared to be a revised statement of that precise law, we find that the Commissioners in their effort for brevity and simplicity, perceiving that the statute of 1839 really removed the prior limitation of six months, so that that limitation could be dropped from the language of the law, substituted for the words "the same having been patented in a foreign country more than six months prior to his application," the words, "his having first patented it in a foreign country;" and the *authoritative declaration* was that the substituted words *meant the same thing* as the words which they replaced. And this declaration was entirely correct; for, whereas before the Act of 1836, all foreign patenting before ap-

plication was a bar, and by that act the bar was *partly* lifted, so as to let in all who might take out foreign patents, except those who should have taken them out more than six months before application here, the Act of 1839 took away this remaining obstacle.

We now perceive with entire certainty how it was that the words "*first patented*" got into the Act of 1870, and that if they are made to mean anything different from "patented before the application," it will be a result which no one having anything to do with the passage of the act last above mentioned ever intended.

h. That part of Section 25 which, and only which, was intended to effect a change in the law, and which was to be substituted in place of the words, "be limited to seventeen years from the date or publication of the foreign patent," was as follows: *expire at the same time with the foreign patent, or if, there be more than one, at the same time with the one having the shortest term, but in no case shall it be in force more than seventeen years.*"

This proposed change was strictly limited to the class of *willfully tardy* applicants. This was introduced by the Committee on Patents. The slight change introduced by the Revising Commissioners to simplify the law by abolishing the distinction in respect to curtailment between the cases where application was made before, and those where it was made after six months from the taking out of the foreign patent, was viewed by them as an unimportant de-

tail. It had been before officially declared as "too small a fraction of time to require its introduction."

Commissioner Holt; quoted in C. D. 1869, pp. 62, 63.

i. In the course of the discussions in the House no amendments going to the substance of the patent law were offered. A few changes relating to details and to administration, proposed either in Committee, or in the House, were adopted; others of the same sort were rejected; and the bill was passed in all substantial respects as it came from the hands of the Commissioners of Revision (Cong. Globe, *supra* 2679 *et seq.*, Part 4, 2872 *et seq.*).

The bill was introduced into the Senate, referred, reported, discussed and passed, with certain unimportant amendments, as to which there was a disagreement on the part of the House, and which was settled by a Committee on Conference. A slight and unimportant change in the section in question was made by the Senate.

As it was a House bill, it went to the Senate in the same form in which it was before the House, and thus communicated to the Senate the same information which the House had.

The proceedings in the Senate will be found in *Congressional Globe*, *supra*, Part 6, pp. 4819, 4827, 4978, 4979, 5113.

The language and the clauses which we have to construe stand in the statute exactly as the Commissioners of Revision reported them; and Congress voted for them with the authoritative declaration, both of the Commissioners of Revision and of the

House Committee on The Revision of the Laws and the House Committee on Patents, that "first patented" meant "patented before application."

k. We now perceive, with a clearness which admits of no doubt, precisely by whom, and how the words "first patented" came to be introduced into Sec. 25 of the Act of 1870; and nothing can be more certain that the Revising Commissioners, who first employed them, and the Congress which enacted them into law, meant by them, and only meant *patented before application.*

This reference to the history of the legislation has never before, in any of the cases in which the question has arisen, been presented. It is believed that if it had been, its unmistakable significance would have had a decisive effect, and that the Supreme Court, in the case of Bate *vs.* Hammond, 129 U. S., 121, had that case, under such circumstances, have been brought before that tribunal, would not have been divided in opinion upon the point in question, and have preferred to withhold a determination, and dispose of the case upon the other point raised by it.

3. The method above pursued of ascertaining the intent designed to be expressed by the language of Section 25 of the Act of 1870, is in accordance with the rules of legal interpretation. It is true we cannot ascertain the views of the *body upon a question before it* from the views which happen to have been

expressed by individual members. Other members may have entertained quite different opinions. But we can, and must, avail ourselves of authentic evidence to ascertain *what the question before the body really was.* The Court must place itself, so far as possible in construing a statute, in the same position which the legislature occupied in enacting it. The bill itself does not always enable us to do this. In the case of revising statutes, particularly where the revision covers a large body of the law, legislatures habitually rely upon the assurances by committees of their own body, or commissioners appointed by them, as to the particulars, if any, in respect to which the law is changed, and give their attention to those alone. Such laws cannot be properly interpreted except upon the assumption that legislatures regard the statements of committees or commissioners whom they have appointed for the purpose of lightening their own labors. It is on this ground that the petition or other application upon which legislation is sometimes had may be properly resorted to for the purposes of interpretation. It is to enable the Court to place itself in the situation of the legislature. It is to enable the Court to learn the point "before the legislative mind" (Bradley, J., in Siemens *ex.* Sellers, 123 U. S., 276, 285; Furman *ex.* The Mayor, 5 Sand., N. Y. Sup., 516; affirmed, without discussing this point, 10 N. Y., 567; United States *ex.* Lynde, 11 Wall., 632).

In the State of New York, where the revision of statutes has been had upon the largest scale, the reports of the Commissioners of Revision are constantly regarded in all the Courts as a means of ascertaining the position in which the legislature stood, and its inten-

tions, when adopting revisions of the statutory laws. (Cutting *vs.* Cutting, 86 N. Y., 522, 527.)

But such resorts as these as aids in interpretation are conclusively sanctioned by this Court.

In the case of Blake *vs.* National Banks (23 Wall., 307), a certain construction was insisted upon by the defendants of a statutory provision imposing taxes upon the incomes of corporations. It was based upon the *literal* interpretation of the language employed. The result of it would be that, whereas Congress imposed a tax upon the incomes of individuals during the whole of the years 1870 and 1871, yet, in the case of corporations, there would be a hiatus from August 1 till January 1, 1870, during which no tax was imposed. This result was no more unreasonable than the interpretation insisted upon by the defendants of Section 25. The Court said:

"It is impossible to believe that Congress "intended to make this discrimination. It "is entirely unreasonable, and is not in har- "mony with the well known views of Con- "gress on the subject."

It thereupon recurred to the history of the framing and passage of the act by an appeal to the same evidence as that which we have above resorted to, and from that evidence came to the conclusion that the intent of Congress was not what it was asserted by the defendants in the case to be.

The justification in this case of an appeal to the proceedings before Congress, and to the report of the Revising Commissioners is much stronger, for it is fully justified by the language, above quoted, of the act providing for the revision of the statutes.

4. It is for the advocates of that interpretation which introduces a change into the law, apparently so unreasonable, unintended and unjust, to show that it really was intended, and to point out some *probable motive* which influenced Congress to make the change—some *evil* growing out of the pre-existing law, or which the pre-existing law was not calculated to reach. The notion mainly relied upon by them that the interpretation is so clear that it must be accepted without reference to reason, and even against reason, has already been shown to be erroneous.

5. They are not absolutely insensible that this burden may be upon them, and have made a faint effort to meet it. Their ingenuity has given birth to two suggestions; *first*, that under the former law a vicious practice had grown up of allowing delays in the Patent Office after the application, and before the issue of patents, which delays were often brought about by the applicants themselves for various improper or selfish purposes, and that inventors *might* desire to first exploit a patent in a foreign field, and afterwards to impose the monopoly here, and thus continue a burden upon our industries after foreign industries were released from it; and, *second*, that a policy had been already adopted to make domestic and foreign patents expire simultaneously, and that Congress designed in the Revision of 1870 to give a *wider extension* to this policy. Neither of these suggestions has any just foundation.

6. As to the first of these suggested objects, that of delays which might be brought about by inventors, there are several answers:

a. The evil, so far as it had any existence, was not particularly, if at all, observable in cases where a foreign patent was sought. It was attributable to other motives than a desire to first exploit a foreign patent. It is not likely that Congress, in seeking a remedy for a general evil, would confine the remedy to a small class of cases, and to cases where it did not often, if ever, manifest itself.

b. And still less likely that, in contriving a remedy, it would frame one, not directed against the guilty alone, but involving the innocent in a common punishment with the guilty. There might be some reason for saying that an applicant who had, after making his application, worked for delay in the issue of his patent, should be made to pay a penalty; but why should an applicant who had pressed in every way for a prompt issue of his patent, but had, against his will and his efforts, been delayed by the acts of others, or by the neglect or fault of the Patent Office, be subjected to the same penalty? And, especially, when the delays against the will of the applicants were far more numerous than the others? No such unreasonable action can be imputed to legislators unless it appears from some evidence furnished by the debates, or other proceedings in the course of the enactment of the law, that they really designed it; and this is not pretended.

To hold out to an inventor the promise of a patent for seventeen years as a stimulant to effort, to call upon him to apply with promptitude in this country, to encourage him also to make application abroad, and then, when he has accepted the invitations, to punish him by shortening his term because, in consequence of delays for which he is in no manner responsible, but which have been caused by the neglect of the government itself, or, it may be, the fraudulent acts of others, the foreign patent is first issued, is very much like the conduct which Chief Justice Marshall, speaking of a suggestion that the public might take advantage of its own administrative carelessness in the Patent Office, declared "would be disreputable in an individual, and a Court of equity might interpose to restrain him." It should not be imputed to a government.

Grant *vs.* Raymond, 7 Pet., 218, 244.

c. But the subject of delays after application, and of delays of the character suggested, *engaged the attention* of the Committee on Patents and of Congress prior to the passage of the Act of 1870, and a special section was framed to prevent them (Sec. 32). The whole subject was provided for by this section, with a proper and just discrimination, which would touch *all* who willfully delayed and would prevent any harm to those not guilty of wrong-doing. This was one of the *two* provisions which were declared by the Chairman of the Committee to introduce changes into the substance of the law. The other related to fees. There were no others bearing upon the rights

of patentees. And a proposal during debate in the Senate, to introduce an amendment affecting the substance of the law, was rejected on his statement that it was "*foreign to the whole principle of this revision*, and that is *to destroy or impair no existing rights*, but to enlarge and make clear the remedies which have heretofore been given by law."

To suppose that Congress at that time doubted the sufficiency of its own carefully devised remedy, and resorted to the crude and unjust device suggested, a device which would not reach one case in ten of those which were proper subjects for it, and would reach many which it ought not to touch, and thus confound the innocent with the guilty, and operate to defeat a long-settled and just policy, would be grossly irrational.

6. The other suggestion concerning the purpose of Congress, namely, that it designed to extend a prior policy of making domestic and foreign patents expire simultaneously, is equally unfounded.

a. In the first place, there never was any such *general* policy. Prior to the Act of 1870, and under the Act of 1839, the penalty imposed upon an inventor who desired to obtain a patent both here and abroad for a willfully tardy application here after patenting abroad, was to limit his patent here to the period of fourteen (after 1861, seventeen) years from the date of the foreign patent. Inasmuch as patents

in England run fourteen, and in France fifteen, years from date, this provision insured that the American patents, in cases affected by it, would expire at *about* the same time, or probably earlier than *most* foreign patents, but would not have this effect in cases where the foreign patent ran for a shorter period than fourteen years. The *policy* thus adopted was not the *simultaneous expiration* of patents, but the *shortening of the term* of the American patent to an extent corresponding to the delay in application in order to discourage delays in applying. The Act of 1861 (Ch. 88), extended the period of American patents generally to seventeen years. The Courts, and the Commissioner of Patents, by that sort of interpretation which the defendants condemn, construed this provision as operating to extend the period of fourteen years mentioned in Sec. 6th, of the Act of 1839, to seventeen: in other words, they read "seventeen" into that section in place of "fourteen."

But this supposed *policy* of Congress to make a discrimination disadvantageous to inventors taking out foreign patents was not *general*, but limited to the special case of *willful neglect* to apply here promptly after taking out a patent abroad. It was limited to *the cases affected* by Sec. 6th of the Act of 1839, that is, the cases of willful neglect.

b. It is not pretended that there is any evidence outside of the legislation itself, such as that afforded by the debates and proceedings, showing that such a purpose was in the legislative mind; and the

notion of the actual existence of such a design is founded solely on the supposed *tendency* of such a device to accomplish the indicated purpose. But it has no such *tendency*. Indeed, *it would defeat the very object*, which, it is suggested, was sought to be advanced by it. That object is that foreign industries should not be free from monoply while our own are burdened by it. Now, if an inventor chooses, or prefers, that that condition should exist, all he has to do is take out a patent in this country alone. The foreign industries in that case are free and ours are burdened, not for a part, but for the *whole*, of the time the American patent runs. If Congress had a *policy* to prevent our industries from being burdened when foreign industries were free, the only way in which it could carry that policy into effect was by *encouraging* the taking out of foreign patents. The interpretation of the appellees makes Congress adopt a provision which would tend directly and strongly to *defeat* the very object which they allege it had it view.

c. The construction insisted upon by the defendants would make possible, and encourage a very mischievous and fraudulent practice.

In the application of the benefits of invention and discovery to the business of life, there are successive stages or steps at which different groups of persons intervene. The original inventor has not, generally, either the capacity, or the capital, to bring his discovery into actual and beneficial use. This is a work which re-

quires a different order of ability, and discoveries are usually exploited by men who have capital, or the means of procuring it, and the capacity to induce the public to accept and use them. Such assistance is ordinarily procured by the sale or assignment of the patent by the inventor, either for a fixed sum or for an interest in the future proceeds of the invention. Again, it is comparatively seldom that a new discovery in the arts can be made to yield its useful results without the aid of one or more, and sometimes numerous, subsidiary or associated patents, and the control of these must, therefore, be acquired, and the necessity for assignments is further manifested.

By reason of these considerations, the practice of inventors to make assignments of their patents may be said to be universal, and, indeed, to be necessary in order that inventions may benefit the public by coming into commercial use. Thus, the *rights of assignees* become as important a subject of consideration as the rights of the original inventor.

Our law has fully recognized this condition of things, and made the most complete provisions for the assignment of patents; and the effect of the assignment of a patent right for the whole of the United States is intended to be, and in fact is, to make the assignee the absolute legal owner. Even when it is made, as it often is, before the issue of the patent, the law (R. S., 4895) requires that the patent shall be issued to the assignee. The application, indeed, must be made by the inventor, but it is made and delivered to the assignee, together with the assignment, as

one of the papers necessarily incident to the assignment. It is filed in the Patent Office by the assignee, and he is thereafter regarded as the sole party having any legal interest in the patent, while the assignor becomes in all respects as if he were an absolute stranger. He is not entitled to receive, and does not thereafter receive, any notice or recognition in the Patent Office.

He may, however, still obtain a patent in any foreign country, and it is entirely within his power to obtain patents abroad, much sooner, perhaps many years sooner, than his assignee can obtain one on the application in this country. He has therefore the power, if the interpretation of the defendants is correct, to greatly abridge, and perhaps wholly destroy, the right which he has assigned, and may thus make upon his assignee, as a condition for forbearing to obtain patents abroad, the severest exactions. He could hold him entirely at his mercy.

In short, this construction of Sec. 4887 makes it a most effective instrumentality for simple blackmail by the inventor against the assignee, whose rights against the former another section of the statute purports to make secure.

Fourth Point. The interpretation asserted by the appellant is supported by every just consideration, and is in harmony with every rule of construction. It should be unhesitatingly accepted.

1. It is an easily *admissible* interpretation. There is nothing in the language employed which excludes it. It is entirely consistent with the rule that to justify a particular interpretation of a statute it must be *expressed*. The *event* in reference to which an invention is said, in Sec. 25 of the Act of 1870, and Sec. 4887, of the R. S., to be "first *patented*," and the event in reference to which an invention is said in the latter to be "previously patented," are not in terms *expressed* in those enactments. They are left to be supplied. There is no difficulty arising out of grammar, or otherwise, in making that event to be the *application*.

a. It is argued that this would be to read into the statute words not found there. Let it be so. Nothing is more common. There are thousands of instances where it is necessary. It is allowed and enjoined by a familiar rule of interpretation.

b. The objection, if it were one, would equally apply to the interpretation of the appellees. *They* read into the statute an event, namely, that of the *issue* of the American patent. Words must be read in upon either view. The question is, *what words* a proper construction requires to be supposed, or supplied.

2. It is in conformity with *reason* and *justice*. That an applicant for an American patent who has satisfied every requirement of diligence and promptitude in making his application, and thus entitled himself to a patent

for his invention for the full term of seventeen years, should be subjected, in consequence of something *thereafter* happening over which he has no control, to the penalty of having his patent abridged for a period, it may be, of many years, and even, as is possible, of losing it altogether, is repugnant to every sentiment of justice.

The defendant's counsel in the Circuit Court of Appeal, sensible of the force of this view, and of the necessity of making some sort of an answer to it, put themselves upon the ground that under the patent system of the United States a *contract* was created between the government and the patentee according to which the patentee was to receive in case he had, before the issue of the American patent, taken out a foreign one, a term equal in length only to the unexpired period of the foreign patent; and that the relations being those of *contract*, no injustice could be done, because no man could be obliged to enter into the contract. This is a most unfortunate argument for the defendants.

a. It is a palpable begging of the whole question. No doubt the relations between the government and the inventor are those of *contract*; and if the statute admitted of but one construction, that is to say, if the terms of the contract were *clear*, and such as the defendants allege them to be, the complainant could allege no injustice, for there is no obligation resting upon him to exercise his inventive powers, and he may employ his faculties in other directions. In that case the argument of the defendants would be conclusive, and at the same there would be no occasion to make it.

for no such suit as the present would be brought.

But the whole question is what are the terms of the contract? This is the matter in dispute, and the discussion is not aided by a cool assumption that there is no dispute about it. The argument of the complainant is that from the day of the establishment of a patent law in 1790 down to the revision of 1870, the terms of the contract were clear and indisputable that the inventor should have a patent for the full term unaffected by any foreign patent not existing *at the time of the application.* This was the *offer* of the government. It was for this that the inventor employed his skill and his talents. It was this which he *earned*, by making his disclosure and application. It was this which made our patent law a just scheme "For the Promotion of the Progress of the Useful Arts." It was this which moved Congress to take care, when it adopted the policy of encouraging foreign patents, to make it clear that no such patent should affect the reward of the inventor under our laws unless it preceded the American *application.* It was this which made the American system consistent with the true principles of contract, and not a snare and a swindle. Upon these reasons the complainant's argument is, that we are not to conclude that the law was changed and the contract changed by the revision of 1870, unless cogent evidence appears showing that Congress intended the change. The very question is whether the contract is as it always was down to 1870, or changed to the illusory thing which the defendants assert. To *assume* that the change was made is the answer of the defendant to this argument.

b. But this ground thus taken by the defendant's counsel, based upon the theory of *contract*, furnishes an opportunity to the complainant of putting its case in another and unanswerable form. Use will be made of it at a later stage in this argument.

3. It is in conformity with the general *rationale* of the law. Whether a man has a right to a particular grant or legal remedy should depend, as it generally, if not always, is made to depend, upon the *state of things existing at the time he applies for it.*

a. What would be said of the justice, or the policy, of a statute of limitations which should be made to bar an action, not only when the cause had accrued more than six years before the action was brought, but also when it has accrued more than six years before the trial? Would this be a suitable device for securing diligence in the prosecution of suits?

b. The rule that the right of an inventor is fixed on the day of his application, and that the delay of the office does not affect him, is so much the dictate of common justice that it has become ingrained into the law and shaped our habits of thought and modes of speech, and led to the habitual use in statutes, judicial decisions, and the language of lawyers generally of the word "patent" when *application for the patent* is really intended.

The following are illustrative instances:

In *Shaw* vs. *Cooper* (7 Pet., 292), the Court was dealing with the effect of use before the *application*—there being no dispute that that was the crucial date.

The word "patenting" was judicially used by the Court to express *that* date, *i. e.*, date of application; indeed, it used the words "patent" and "application" indiscriminately to express *date of the petition*, which was the date expressly named in the statute it quoted and was dealing with.

P. 316. "If the invention was known or used by the public before it was *patented*, the patent is void." "Whether there was such a use in public of this invention at the *date of the plaintiff's patent* as to render it void."

Pp. 317, 318, "before the emanation of the patent."

P. 320, "before a patent is obtained."

P. 321, "before the obtainment of his patent."

P. 322, "use of an invention before it is patented": "before the emanation of his patent."

P. 320, it quoted from an opinion in 1 Paine, 354, "before taking out a patent."

Emmet, arguendo, used similar phraseology when referring to date of application, or the act of applying.

P. 306. "Previous public use of an invention invalidates a patent."

P. 307. "In 1819, therefore, he might and ought to have taken out his patent." "Public use before the first patent was taken out."

P. 309. "Unreasonable delay in taking out his patent."

The head notes in the original edition containing the following :

"If the invention was known or used by the public before it was patented, the patent is void."

"No matter by what means an invention may have been communicated to the public before a patent is obtained."

"The public use of an invention before it is patented."

P. 297. The Court charged the jury that "the rights of the plaintiff were to be determined by the state of things which existed in 1822, when the patent was obtained."

The head note in the Brodix edition says : "Public use prior to the grant of the patent" (4 Am. and Eng., 286).

In *Pennock* vs. *Dialogue* (2 Pet., 1), upon the same question there was the same use of language. Webster, *arguendo*, twice says "grant of the patent," and "delay in obtaining Letters Patent," "delay in patenting" ; Sargent used the phrase "before the patent"—all meaning, in each case, date of application.

In *Kendall* vs. *Winsor*, 21 How., 322, and which turned on the same question, CURTIS, J., in the bill of exceptions, used the phrase "take Letters Patent" to express the fact of application.

It will be observed that many of the expressions above referred to, although designed to refer to the date of the application, are substantially equivalent to, if not precisely identical with the words "first patented" and "previously patented," employed in the section under construction.

Thus it is impossible to say that Congress might not use one word to signify the other date. To the legal mind the later thing expresses the right which exists at the earlier date. As regards the *right*, both speak from the same date. Such is the entire spirit of the law and of the decisions under it. *The hostile construction would make this section the sole exception.*

In these decisions, and others cited in this brief, the phrases "*before this patent*," "*patenting his invention*," "*protecting his invention*," "*obtaining his patent*," are used to express the whole procedure, thought of *as one act*. Whenever they speak of matters, delay in which may impair or diminish the inventor's right, though the words refer to the *patent* which is the act of the Commissioner, they *mean* the act of the inventor—the act the time of which he controls. *That act is the filing of the application.* They are right. When the inventor has done that, he has patented the invention so far as in him lies. That is the only act which is his.

c. The Patent Act treats everything in the Patent Office, when done, as if done the moment the application is filed. The main clause, to which everything else about the Patent Office is a mere accessory detail, is:

R. S., 4893. "*On the filing* of any such application, and the payment of the fees required by law, the Commissioner of Patents *shall* cause an examination to be made of the alleged new invention or discovery; and if on *such* examination it shall appear that the claimant is justly en-

titled to a patent under the law, and that the same is sufficiently useful and important the Commissioner *shall issue* a patent therefor."

The statute is violated if a delay in making the examination ordered to be made "on the filing" forfeits the patent to which the claimant was "justly entitled" on the day of filing. Any construction of any clause which leads to that result is inconsistent with this primal section.

That the right is always to be determined as of the date of the application is declared by the Courts to be an inherent rule of law, not requiring the aid of any statute. This was decided, and language was judicially so used before 1870; Congress must be presumed to have known this. The following cases will illustrate this:

Adams vs. *Jones*, 1 Fish., 527, 530, GRIER, J., 1859. "The delay afterwards interposed (after application), either by the mistakes of the public officers or the delays of the Courts where gross laches cannot be imputed to the applicant, cannot affect his right. * * * Involuntary delays, not caused by a laches of the applicant, should not work a forfeiture of his rights."

This last sentence was quoted with approval in *Planing M. Co.* vs. *Keith*, 101 U. S., 485.

Root vs. *Ball*, 4 McLean, 179 [1846]. "*Independently of the statute* [1839, § 7], the plea would have been bad, as the application for a patent must protect the right of the inventor, and the delay which

may occur in the Patent Office in making out the patent cannot operate to the injury of the applicant."

This agrees with that universal rule which Courts have adopted, because not to adopt it would punish a party for delays which were not his fault, and, indeed, no one's fault.

Gray vs. *Brignardello*, 1 Wall., 627, 636. "A *nunc pro tunc* order is always admissible when the delay has arisen from the act of the Court. *Fishmongers' Co.* vs. *Robertson*, 3 Man. Gr. & Scott, 970."

Mitchell vs. *Overman*, 103 U. S., 62, 64. "The adjudged cases are very numerous in which have been considered the circumstances under which Courts may properly enter a judgment or a decree as of a date anterior to that on which it was in fact rendered. It is unnecessary to present an analysis of them some of which are cited in a note to this opinion. We content ourselves with saying that the rule established by the general concurrence of the American and English Courts is, that where the delay in rendering a judgment or a decree arises from the act of the Court, that is, where the delay has been for its convenience, or has been caused by the multiplicity or press of business, or the intricacy of the questions involved, or for any other cause not attributable to the laches of the parties, but within the control of the Court, the judgment or the decree may be entered retrospectively, as of a time when it should or might have been entered up. In such cases, upon the maxim *actus curiæ neminem gravabit*—which has been well said to be founded in right and good sense.

and to afford a safe and certain guide for the administration of justice—it is the duty of the Court to see that the parties shall not suffer by the delay. A *nunc pro tunc* order should be granted or refused, as justice may require in view of the circumstances of the particular case. These principles control the present case. Stutzman was alive when it was argued and submitted. He was entitled at that time, or at the term of submission, to claim its final disposition. A decree was not then entered because the cause, after argument, was taken under advisement. The delay was altogether the act of the Court. Its duty was to order a decree *nunc pro tunc*, so as to void entering an erroneous decree."

This case was cited and confirmed in *Coughlin* vs. *Diet. Co.*, 106 U. S., 7, 11; Opinion per GRAY, J., S. P. *Clay* vs. *Smith*, 3 Pat., 411.

4. It is in conformity with the *prior law* established for more than thirty years prior to the time of the asserted change.

5. It is in conformity with *a wise and settled policy of the government*, which seeks to encourage the taking out of foreign patents, both for the benefit of the inventor and of the public, in the only way in which that step can be promoted, namely, by removing every disadvantage or obstruction which may deter the inventor from taking that course.

6. It is the only interpretation consistent with the policy, real or supposed, to put foreign industries under royalties, because the opposite construction directly and strongly discourages Americans, who are the chief inventors, from ever patenting abroad.

7. It provides a *just discrimination* against those who would seek to make an improper use of the privilege extended by *willful delay* in accepting it; and in this respect it exactly copies and continues the sole purpose and policy of all previous legislation on the subject of curtailment.

8. It is in conformity with the fundamental rule which governs *the interpretation* of *revising statutes*, and which enjoins that the prior law be deemed to have been continued by the revision, notwithstanding changes of language, unless it appear affirmatively that there was an intent to change it.

a. No such intent is shown, either by suggesting the existence of an evil to be remedied, or by showing from the statutes that the particular suggested change was before the legislative mind, or that the language is so positive as to compel a belief that a change was designed.

b. And on the other hand the clearest evidence is produced from the debates and proceedings showing that the intent, so far

as the point in question is concerned, was to *revise* only and not to change.

9. It is in harmony with that prime rule of interpretation which enjoins us to *assign a meaning*, if it be possible, *to all* the language which a legislature employs. We may not in all instances be able to give *effect* to every clause; but we should be able to *account for its introduction*. Says Mr. Justice Harlan in Montclair *vs.* Ramsdell (107 U.S., 147, 152). "It is the duty of the Court to give effect, if possible, to every clause and word of a statute." See also Endlich on Statutory Interpretation, § 23. The interpretation of the appellees is inconsistent with this rule.

a. The full force of this consideration will be perceived by contrasting the rival interpretations. Upon the interpretation of the defendants the whole first part of section 25 down to the second branch of the *proviso*, beginning with the words "and that the patent" *has no effect*; and not only this, but *no reason or excuse appears for its introduction*. The prior granting clauses of the act had fully destroyed all the *debarring* effect that foreign patenting had ever had, and the same granting clauses had made public use prior to the application a bar in all cases to any patent.

b. An attempt may be made to answer this by saying (it is all that can be said), that this prior part of the section *does* have *some* effect, because the section would not

clearly mean what it now does mean, if such prior part was dropped. It is indeed true that the second branch of the *proviso* is so tied to the former part of the section that we cannot grammatically drop the former part; but absolutely all that the appellees can, or do, pretend to get out of it is a meaning for the words "the patent," that is to say, it serves, in their view, to indicate that "the patent" refers to all patents which are granted for an invention which had, prior to the date of the grant, been patented in a foreign country.

But this answer, should it be attempted, would serve to make the position of the appellees still more absurd; for if this be the effect, and the only effect, of the prior part of the section, it must, on their view, have been its *designed* effect, and *the only excuse for its introduction*, unless something else is pointed out, which is not done. Does, or can, anyone believe that the only purpose of all this language about no person being *debarred* was to give a meaning to the words "the patent" in the second branch of the *proviso?*

The appellees say, as we understand them, that the design of the Revising Commissioners in framing section 25 was not to remove an existing bar, but to *change the law* in respect to the curtailment of patents where prior foreign patents had been issued, so as to make the curtailment apply to *all* cases, as well as those where the prior foreign patent might be issued *after* the application here, as those where it was issued *before* such application. But if this was the sole object, as by the construction of the appellees it is admitted to be the sole effect, why should all this

language about not being *debarred* have been employed? Surely, if this had been the design, the draughtsman would have proceeded in the simple and direct form to give it effect by saying: "In case any foreign patent shall have been issued prior to the issue of the patent in this country, the latter shall be limited to seventeen years from the date or publication of the foreign patent."

It will be observed that the framer of Section 4887 of the R. S. did *untie* the second branch of the proviso in the 25th section of the Act of 1870, and thus made the utter uselessness of all that preceded it clearly manifest.

c. The appellees may endeavor, not, indeed, to *give effect* to (for this they admit they cannot), but to *account for the introduction of* the first part of Section 25, by saying that the revisers *borrowed* the form of it (which it is quite certain they did) from the provisions of the Acts of 1836 and 1839, particularly the latter, upon the same subject, and that those provisions would be subject to the same criticism to the effect that the language about *disbarring* is used superfluously; but such a resort would be equally unfortunate for them; for, *first*, they would be running counter to that reasonable rule of interpretation which teaches that, when a statute borrows the form and the substantial language of a clause in a prior statute upon the same subject, it must be deemed to be for the same purpose, and in order to *express the same thing*, which the legislature in the former instance had in

view; and, *second*, it is not true that the language about being debarred in the former statutes was used either incorrectly or superfluously. What those old provisions describe as a bar really *was* a bar, or in danger of being considered a bar, when they were respectively framed. They were drawn on the theory *of removing a bar*, of bringing within the reach of patentability inventors whom the general provisions of the Patent Act seemed to exclude; and it was eminently proper that the new section which brought them within the fold should annex all the qualifications and limitations thought desirable. But when we attribute to the framer of the *new*, an intent to copy the *phraseology* of the *old*, as we do, we attribute to him an intent to copy the *meaning* of the old.

The *whole* point of the appellees' case, however, compels them to attribute to this new section an intent to *differ* from the old; an intent to include by the descriptive phrases of the first clause (carried, as they say, by implication into the curtailing proviso), not only what the older acts treated as a bar, that is to say, foreign patents before the American application, but also all foreign patents prior to the American *grant*, that is, those issued during the *pendency* of the American application, which were not at the time those pieces of legislation were framed, nor at any other time a bar, and which it was distinctly *not* their purpose to make a bar.

d. But if we try the complainant's interpretation and read "first patenting" as meaning patenting first *before the application*,

we comply with the rule above mentioned; both statutes become intelligible, all parts of them have their due meaning and effect, and we see very clearly how the Revising Commissioners came to give the statute the form in which we find it. Let us, upon this interpretation consider what their task was, and how they would naturally proceed to execute it.

In framing Sec. 25, they were to re-enact the existing law with such changes in the form and details as they might think within the scope of their powers and duties. There was but one alteration which they had in view. This was to drop the six months' limitation. That limitation, as a *disbarring* one, no longer existed in the law. It had been destroyed by the Act of 1839, except that it still operated to make a slight and unimportant distinction in respect to the extent of curtailment. There seemed to be no very good reason for retaining this any longer.

Their obvious course, therefore, was the one which they followed, namely, to proceed, just as the framers of the acts they were revising proceeded, to deal with prior foreign patenting as if it were a *bar*, *remove* that bar, and then state the condition upon which the removal was to be operative, and the sort of patent to be issued where it was operative.

They therefore began by saying, "That no person shall be debarred from receiving a patent for any invention or discovery by reason of"; but by reason of what? Not, surely, something by reason of which nobody ever *was* debarred, but something which had always operated as a bar, except so far as special provisions of

the law afforded relief from it; and that was obtaining a patent here when, *at the time of the application*, there was an existing foreign patent. This was described in the Act of 1839, which they were revising thus "the same having been patented in a foreign country more than six months prior to the application." They were obliged to change this, for they were to drop the six months' limitation. They adopted the words "first patented" to describe, what it does well enough describe, patenting abroad before application here. They did not mean to change the clause they were revising in any other way, or to any further extent than by simply dropping the six months' limitation. They therefore completed their sentence as follows: "Its having been first patented, or caused to be patented, in a foreign country." And these are the very words which were declared by the manner in which the bill was introduced into the House, as explained by Chairman Jenckes as reenacting the existing law. All that there was left for them to do was to state the conditions under which this removal of the bar was to be operative, and the terms of the patent to be issued when it was operative.

This the draftsman did by saying, "provided the same shall not have been introduced into public and common use in the United States prior to the application, and that *the* patent (that is, the patent issued in the relief cases) shall be limited to seventeen years from the date or publication of the foreign patent.

To say that the draftsmen undertook by the first clause to describe, not simply what

had originally and at all times constituted a bar to a patent, but also to embrace in that description, and thus treat as a bar, something which had never before been so regarded, something which could not be so embraced without a violation of reason and justice, and without defeating a well settled prior policy, and all this without showing any reason or explanation other than that the words "first patenting" *must* mean patenting at any time before the issue of a patent in this country, seems in the highest degree irrational.

g. The old law relieving against the bar conferred a new benefit upon every inventor whom it touched. Is it possible that a mere revision of it should be held to have been designed, and to have the effect, not of changing in any particular the nature of the benefit in respect to those upon whom alone it was bestowed, but *of imposing a new and unjust burden upon those upon whom the benefit was never conferred because they never stood in need of it?*

It is quite manifest that the draftsman, in framing the proviso to the Act of 1870, had before him, and intended to revise and consolidate, the two successive provisos of the Act of 1839. As contained in that act, they touched the inventor who had taken out a foreign patent prior to his application, and him alone. He simply, for the sake of brevity, consolidated them under one proviso. What evidence or reason is there for a belief or supposal that he intended to give them a meaning which had never before been attached to them, and to make them affect an entirely different class of persons?

The former statutes applied the curtailment only to those from whom a bar had really been removed, and is it possible that a revision, or re-statement of a like curtailment, is to be taken as intended to apply to a wholly different class of persons, to whom it would be most unjust, and contrary to the prior policy of the law to apply it?

c. We have dealt in the above explanation with the section as it left the hands of the Revising Commissioners. Before its enactment an amendment was introduced into it by other hands, those of the House Committee on Patents. This amendment consisted in striking out the words "and common," which did not alter the sense, and substituting, in place of the limitation of the term, an expiration of the term simultaneously with that of the foreign patent. It was, therefore, only the second branch of the proviso that was changed, and this, of course, did not affect, and was not intended to affect, in any way the meaning of the words "first patented" in the first part of the section.

In the revision of 1873 a change was made, not at all affecting, or designed to affect, the sense. The framers of the provision in 1870 had placed their clause limiting the term of the Patent under the *proviso* as if it were a *condition*, like the first clause under the *proviso*, which it was not. The Committee on patents in making their amendment did not change this; but the Revisers in 1873 apparently thought this to be inartificial, as it was, and sought to improve it by dropping its conditional

form, and stating it according to its true nature, as something modifying the character of the patents to be issued. In doing this they placed the matter in an independent sentence, and thus *untied* it from the first part of the section.

This obliged them to define anew the class of patents to which the limiting clause referred, which they did by saying "every patent granted for an invention, which has been previously patented in a foreign country," but meaning the same thing as was intended by "first patenting" in the first part of the section. And having thus broken the grammatical tie between the two parts of the section, the first part becomes, on the interpretation of the defendants, wholly nugatory. All that was ever needed on that view is the last part. But, on our interpretation, this first part, both as it stands in the law of 1870, and in the Revision of 1873, has full effect. It is an adoption, not only of the substance, but of the *form*, of the provisions of the acts of 1836 and 1839, with the intended modification of dropping the six months' limitation and stating the terms of the patent to be issued.

f. This explanation, instead of leaving these pieces of legislation incoherent and confused jumbles of what is necessary with what is superfluous, working a change in the law, where it was avowed that no change was intended—a change repugnant to reason and to prior policy—gives meaning and effect to all parts of the enactments, makes them consistent, harmonious and not inelegant. They are per-

fectly adapted to secure the object we have assigned to them, and they are adapted to no other purpose.

Fifth Point.—*The Contract Theory.*—Our opponents, in the Circuit Court of Appeals, took the ground that the patent system of the United States was designed to create, and did create, a *contract* between the Government and the inventor. We have already made some observations upon that view. But we desire to avail ourselves of this correct position taken by the defendants, for it furnishes an impregnable defense to our interpretation. The patent system *does* create, or give rise to, contract relations; they are of its very gist and substance. Our reading of the statute gives force to those relations. The defendants' reading destroys the obligations and the substance of any contract relation; indeed, it is absolutely inconsistent with the *existence* of any contract relation, whether the matter be looked at in its general substance, or whether we clearly and nicely consider those elements which in legal apprehension must be present in order to constitute a contract.

The Patent Act, fulfilling the duty imposed by the Constitution, and desiring to "promote the progress of the useful arts," offers a reward to those who will supply the public with new inventions. The patent, as the learned counsel for the defendants rightly insisted, is not intended as simply a recognition of merit or of virtue. It is the *price* which the public pays for the greater benefit it derives from the invention, in the belief

that the price offered will induce the creation of what it is offered for.

The statute contains the offer which, when accepted by an inventor, constitutes the promisor's part of that well-known kind of contract which arises from the *offer of a reward*, and the act defines the two terms which are essential, to wit: what the inventor is to do in order to become entitled to the reward, and what the exact measure of the reward is.

The Revised Statutes, Secs. 4886, 4888, enact that whoever makes a new invention, and brings an intelligible description of it to the public at its Patent Office, claiming the reward, shall obtain a patent. Sec. 4884 defines what this reward is. It is "a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the exclusive right to make, use and vend the invention or discovery."

The bare assertion of the inventor that he has earned the reward, of course, cannot be unreservedly accepted. So Sec. 4893 provides that "on the filing" of the description and claim, the promising party, that is, the public, will make an examination through its special agent; "and if, on such examination, it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the commissioner *shall* issue a patent therefor."

In contracts of this character (those initiated by the offer of a reward) the acceptance of the offer is made by the *performance* by the offeree of the *consideration*. It is this performance which *converts* the offer into a binding contract. (Langdell's Summary of the Law of Contracts, § 4). And,

under the Patent Law, this performance is fully effected by the filing of the application, accompanied with the required fee. This is a *delivery* to the party offering the reward of the thing desired. Nothing remains but the duty of payment.

The right of the one party and the obligation of the other are fixed and completed. The privilege reserved to the promissor of an examination for the purpose of identification neither weakens the right nor the obligation. Indeed, as it postpones the day of payment, it imposes an additional obligation to make it as soon as practicable, and to make it in such a way that the making of it shall not diminish the value of the reward to the receiver, nor lighten its burden to the payer.

In Grant *vs.* Raymond (6 Pet., 218), the Supreme Court, through Chief Justice Marshall, expressed, in language worthy of its author, this obvious view of the transaction and of the obligations which it cast upon the public. The particular question in that case was well calculated to elicit a consideration of the nature of the relations between the inventor and the public, and should be stated. An inventor had made his application and obtained a patent. He subsequently found that it did not enable him to successfully prosecute against infringements in consequence of a defect in the specification, occasioned by an inadvertency on his part. The Government accepted from him a surrender of his patent, and issued to him a new one for the full term of fourteen years, dating from the date of his original patent. For this proceeding there was no express warrant in the statute. In an action prosecuted by the inventor for subsequent infringements, the defence was that the re-

issued patent was void, as being without authority in law. The Court held that the question was to be determined, not wholly by the strict letter of the statute, but also by reference to the scope, object and purpose of the Patent Law; and that, viewing the question in this light, the public had no right, after receiving the full benefit of the performance of the consideration by the inventor, to withhold the stipulated reward; that if the error had arisen from the neglect of its own officials there could be no question concerning the obligation to issue another patent; and that the circumstance that the innocent fault was on the part of the inventor, though it presented a difficulty, did not disentitle him to the relief which the reissued patent afforded. Said Chief Justice Marshall p. 240 (The italics in this quotation are ours):

"To promote the progress of the useful "arts, is the interest and policy of every "enlightened government. It entered into "the views of the framers of our constitu- "tion, and the power 'to promote the pro- "gress of science and useful arts, by secur- "ing for limited times to authors and inven- "tors the exclusive right to their respective "writings and discoveries,' is among those "expressly given to Congress. This subject "was among the first which followed the "organization of our Government. It was "taken up by the first Congress at its second "session, and an act was passed authorizing "a patent to be issued to the inventor of "any useful art, &c., on his petition, 'grant- "ing to such petitioner, his heirs, adminis- "trators or assigns, for any term not exceed- "ing fourteen years, the sole and exclusive "right and liberty of making, using and "vending to others to be used, the said in-

"vention or discovery.' The law further "declares that the patent 'shall be good "and available to the grantee or grantees, "by force of this act, to all and every intent "and purpose herein contained.' The amen- "datory Act of 1793 contains the same lan- "guage, and it cannot be doubted that the "settled purpose of the United States has ever "been, and continues to be, to confer on the "authors of useful inventions an exclusive "right in their inventions for the time men- "tioned in their patents. *It is the reward "stipulated* for the advantages derived by "the public for the exertions of the individual "and is *intended a stimulus* to those exer- "tions. The laws which are passed to give "effect to this purpose ought, we think, to "be construed in the spirit in which they "have been made; and *to execute the contract "fairly* on the part of the United States, "where the full benefit has been actually "received: if this can be done without "transcending the intention of the statute, "or countenancing acts which are fraudu- "lent or may prove mischievous. *The public "yields nothing which it has not agreed to "yield; it receives all which it has con- "tracted to receive.* The full benefit of the dis- "covery, after its enjoyment by the discoverer "for fourteen years, is preserved; and for his "*exclusive enjoyment of it during that "time the public faith is pledged.* That "sense of justice and of right, which all "feel, pleads strongly against depriving the "inventor of the compensation *thus solemnly "promised*, because he has committed an "inadvertent or innocent mistake.

"If the mistake should be committed in "the department of State, no one would say "that it ought not to be corrected. All

"would admit that a new patent, correcting "the error, and which would secure to the "patentee the benefits which the law in- "tended to secure, ought to be issued. And "yet the act does not in terms authorize a "new patent, even in this case. Its emana- "tion is not founded on the words of the "law, but is indispensably necessary *to "the faithful execution of the solemn promise* "made by the United States. Why should "not the same step be taken for the same "purpose, if the mistake has been innocently "committed by the inventor himself?"

It was urged on behalf of the defendants in the suit that the specification upon which the first patent had been issued had put the public in possession of the invented machine, and that they could not afterwards be deprived of it. This was the answer of Marshall:

"It has been urged that the public was "put into possession of the machine by the "open sale and use of it under the defective "specification, and cannot be deprived of it "by the grant of a new patent. The machine "is no longer the subject of a patent.

"This would be perfectly true, if the "second patent could be considered as inde- "pendent of the first. But it is in no re- "spect so considered. The communication "of the discovery to the public has been "made in pursuance of law, with the intent "to exercise a privilege *which is the con- "sideration paid by the public for the future "use of the machine*. If by an innocent "mistake, the instrument introduced to "secure this privilege fails in its ob- "ject, the public ought not to avail it- "self of this mistake, and to ap- "propriate the discovery without paying

" the stipulated consideration. The attempt " would be disreputable in an individual, " and a Court of equity might interpose to " restrain him."

2. But not only does our patent law, by the nature of its fundamental provisions, initiate a contract, but it contains special provisions which affirm the existence of contract relations. It affords the remedy of *specific performance.*

This was done to a certain extent by the Act of 1836, and the privilege was by the Act of March 3, 1859 (Sec. 10) in terms substantially the same with those now embodied in Sec. 4915 of the R. S. These steps, taken long before the act establishing the Court of Claims, were the first recognition of the justice of compelling the Government to perform its own obligations where they possessed all the substantial elements of a contract.

3. In all cases of rights resting in contract, there must be a *time* when such rights must be viewed as ripening into completion. This time, in the case of the obligation to issue a patent, is left in no manner of doubt. The plain sense of justice tells us that a man to whom an offer of a reward is made for giving, or doing, a particular thing, is entitled to the reward the moment he has done it; and this, in the case of an inventor, is when he describes and discloses his secret to the Government. Nothing remains but to pay him. Some time, indeed, may be requisite

and some labor, perhaps much time and much labor, to *identify the thing* and make sure that it conforms to the terms of the offer; but, as already observed, this neither weakens nor postpones the obligation, but rather adds to it another, that it be done as speedily as possible.

The strict rule of the law of contracts, founded upon the same principle of justice, teaches precisely the same thing. One of the most accurate of legal writers says: "As the performance of the consideration "(which in our case is the giving to the "Government the description of the inven- "tion) is what converts an offer into a bind- "ing promise, it follows that the promise is "made, in legal intendment, at the moment "when the performance of the consideration "is completed" (Langdell's Summary of the Law of Contracts, § 4).

And in every stage of the Patent Law the language of the statutes has indicated the same point of time as the one at which the right to the patent becomes complete. The first act, that of 1790, declared in its first section, "That *upon the petition* of any person "or persons to the Secretary of State, &c., "&c., setting forth that he, she or they, "hath or have invented or discovered any "useful art, manufacture, &c., &c., not be- "fore known or used, and praying that a "patent may be granted therefor, it shall "and may be lawful to and for the said Sec- "retary of State, &c., if they shall deem the "invention or discovery sufficiently useful "and important, to cause Letters Patent "to be made out, &c., &c., which Letters "Patent shall be delivered to the Attorney- "General of the United States to be exam- "ined, who shall, within fifteen days

"next after the delivery to him, if he shall "find the same conformable to this "act, certify it to be so at the foot "thereof, and present the Letters Patent so "certified to the President, who shall cause "the seal of the United States to be thereto "affixed, and the same shall be good and "available to the grantee or grantees by "force of this act, to all and every intent and "purpose herein contained, and shall be "recorded, &c, &c., and delivered to the "patentee," &c., &c. The second section of the act provides "That the grantee or "grantees of each patent shall, at the time "of granting the same, deliver to the "Secretary of State a specification in "writing," &c., &c. All this supposes that the right is fixed and completed at the time of presenting the petition which discloses the invention. The provision of fifteen days for the examination by the Attorney-General is not so much a postponement of the completion of the right as a recognition that it is complete, and that the price must be paid at the earliest practicable moment.

The Act of 1793, by its first section, somewhat differently framed, re-enacted substantially the same provisions; but, perhaps, this act, by its third section, connected more closely the perfection of the right with the filing of the specification. This third section enacted, "That every inventor, before he can "receive a patent, shall swear or affirm that "he verily believes that he is the true in-"ventor, &c., &c., and shall deliver a written "description of his invention," &c., &c. Nothing could more clearly declare that the right is finally perfected upon the filing of the specification.

Prior to 1836 no provision had been made

for an examination of the invention before the issuing of a patent. The act of that year created the Patent Office with most of its present duties. The seventh section provided, "That *on the filing* of any such application, description and specification and "the payment of the duty herein provided, "the Commissioner *shall* make, or cause to "be made, an examination of the alleged new "invention or discovery; and if *on any such* "*examination* it shall not appear that the "same had been invented by any other per-"son, &c., &c., it *shall be his duty* to issue "a patent therefor." An immediate examination is here peremptorily ordered. Such examination might require no time at all, or a little time, or a great deal. This is viewed as wholly immaterial, as in fact it is, provided the right has become fixed by the application. And the time thus incidentally required is simply for the purpose of identifying the thing as it existed at the time of the application and ascertaining whether it then conformed to the terms of the offer.

The revision of 1870, by Sec. 30, substantially re-enacted the same provision, making slight alterations in the phraseology as follows: "Sec. 31. *On the filing* of any "such application and the payment of the "duty required by law, the Commissioner "shall cause an examination to be made of the "alleged new invention or discovery; and if "*on such examination* it shall appear that "the claimant is justly entitled to a patent "under the law, and that the same is suffi-"ciently useful and important, the Commis-"sioner *shall issue* a patent therefor." This section stands unaltered as Section 4983 of the Revised Statutes.

It appear from the foregoing that the patent

system of the United States, at its origin in the statute in 1790, in perfect accordance with the elementary law of contracts, and with the plainest sense of justice, regarded the right of the inventor as ripening at the time of the filing of the application; that the Supreme Court, prior to the reorganizing statute of 1836, declared that the delivery to the public of a new invention *effected by the filing of the application* placed the Government under a solemn obligation to give the inventor the reward which it had promised him; that Congress, acting upon the hint thus given, at the next revision and enlargement of the patent system in 1836, furnished a specific remedy for the enforcement of the obligation, and subsequently enlarged and perfected it; and that in every stage of the patent system down to the time of the Revised Statutes the right to the patent was regarded as perfected at the time of the filing of the application.

No doubt the Government should be permitted to have resort to any reasonable instrumentalities for the purpose of identifying the invention (the thing delivered) and determining whether it is the precise thing for which the reward was promised, just as any purchaser of goods should have reasonable opportunity and time for inspection; but requirements, whether expressed or implied, which are designed only to make it certain whether the obligation has been incurred, cannot, without an utter perversion of justice and of the presumed intention of parties, be made a source of danger to the obligation itself. If it should be suggested that in the offer, that is, in the statute which contains the explicit and peremptory promise, there are words

which serve to put it in the power of the promisor, by his own acts, done by his own volition, to escape payment for the property created by toil and labor on the faith of his promise, and delivered to him with a claim for the reward, the reply would be that such words, or at least, such a meaning of any words, must be rejected as inconsistent, not only with the particular nature of the promise, but with the legal existence of any promise whatever; just as restrictions and conditions inconsistent with a grant are constantly considered to destroy themselves, and not to destroy or diminish the grant.

Such, for example, would be the case if it should be alleged that the promisor's own delay in exercising his privilege of examination (whether the delay was by misconduct, or because the examination itself was laborious), could relieve the promisor from the obligation to pay, or could diminish the amount he was otherwise bound to pay. Indeed, the attempt to accomplish that would, in the words of Chief Justice Marshall, be both disreputable in morals, and preventable by a Court.

Now, that is exactly what our opponents say Congress did (or attempted to do) by the language of 1870, as contrasted with the older legislation.

When the inventor has lodged the description of the new thing with the designated officer, he has forever delivered the property, and the other party has the benefit of it. The public never pretends to put him back in *statu quo*, and it could not if it would. He has disclosed it to the representative of the public. It is no longer even his secret. If, indeed, it necessarily remained secret (which is not the case, either in law or in

fact), that would be immaterial, for, in reliance on the promise he has, as Chief Justice Marshall observed, created the new thing; and neither to bury it in oblivion, nor to publish it without a patent, would repay him for the genius and toil and money he expended in creating it.

To curtail the promised reward, even upon the defendants' reading, two things must concur: (1.) The inventor must take out a foreign patent. (2.) The public must defer its grant until after the foreign patent.

If the inventor does not *ask* for his American patent until after he has got his foreign patent, then, whether it be wise and fair to punish him or not, the difficulty is of his own making, and not much sympathy need be bestowed upon him. But the difference which separates the defendants' view and ours is quite other than that. The inventor delivers the property to the commissioner and claims the reward. Then he goes abroad to try to make some money out of it abroad, an act which is not injurious to our public, nor against the terms or the policy of our law, but encouraged by both. If the representative of the American public exercises his privilege of examination speedily—as quickly, for example, as foreign governments exercise theirs—the exact reward promised by the statute, that is a seventeen years' patent, is paid; but if the promisor of the reward is slow in identifying the property, *his own delay* diminishes the price. Whether that can be done, or cannot be done, is exactly the difference between our reading of the statute and the defendants' reading.

It is of no consequence whether the delay be one due to the elaborateness of examination which the statute contemplates in some

cases, or whether it be because Congress does not provide officials enough to do the work, or whether because those whom it selects are incompetent or derelict. In whatever way the question between the two readings be turned over and examined, it comes to this: Shall an inventor, who was entitled to a seventeen years' patent on the day when he brought in the property and claimed the reward, have it refused to him because the examination as to whether he is entitled, made by the promisor itself, has been more or less delayed? Shall the examination which determines that he was entitled to the reward when he claimed it, create of itself a reason for refusing it? Shall the time employed by the promisor himself to determine that the obligation exists relieve him from the force of it?

Such a reading would render the statute no longer a contract, nor the basis of one. Indeed, it makes it a swindle.

Now the proposition of the defendants' is, that the rearrangement of the words in the revision of 1870, which the commissioners and two committees both intended and read and reported as creating no change, demonstrates, beyond a doubt, an intention to produce just this effect!

The very gist of the Patent Law is that it constitutes a standing offer which ripens into a contract imposing a *binding*, and not an *illusory*, obligation when the thing offered for is produced, delivered, and the reward claimed.

A contract implies an obligation, the binding effect of which is completed when the consideration has passed, and the force of which cannot be weakened or affected by the act of the party on whom rests the duty to

pay. It implies also a moment when the obligation has ripened and ought to be performed; and although Courts cannot compel performance on that day, they determine the rights *as of* that day, and do not allow the one party to suffer nor the other to gain by delay. And when is that day here? Clearly, as we have already shown, when the description of the new invention is furnished and the reward claimed.

Such is the contemplation of the statute itself. The sole delay is for examination. Yet the statute in terms says that the examination is to be made "on the filing." That does not mean physically on the day of filing, for that is obviously impossible; but it means *in law* on that day; that is, as of that day. And every patent statute and every decision fixes the rights for all purposes (unless the appellees' reading makes the sole exception) as of that day.

4. Let the defendants view be subjected to the test of the operation of the provision for a specific performance. Let it be supposed that the application is refused by the Commissioner on the ground that the invention was *not patentable*, and that then the inventor takes out a patent in Canada, for instance, and, besides, files a bill for a patent in the proper Circuit Court of the United States, and that after a delay of two years in bringing the case on for hearing and procuring a decision, it is decreed that the decision of the Commissioner was erroneous; that the invention was new and useful, and that the Commissioner, instead of refusing, ought to have issued a patent. The United States

now appeals to the Supreme Court, and circumstances, involving no fault on either side, prevent a decision until the lapse of three years more. The Supreme Court then affirms the decision of the Circuit Court, and the complainant presents himself at the Patent Office and demands his patent. That office, if it acts on the defendants' interpretation, must refuse to grant it on the ground that although he was entitled to it on the day when the Commissioner first refused it, he is no longer entitled to it; that is to say, that the delay of the Government in ascertaining his right—its delay in correcting its own wrong decision—has effaced the right itself! It will not help the case to say that this was not the effect of the delay of the Government, but of the act of the inventor in taking out the foreign patent during that delay. That taking out of the foreign patent was *a part of the inventor's right as decided by the Court*. If the patent had been issued to him by the Commissioner at the time when it was first refused, he could, of course, have taken it out without detriment to himself. Have his rights been diminished by the wrongful denial of them? The taking out of the foreign patent was not *inconsistent* with his right, it was in perfect harmony with it. Indeed, it was simply an *exercise* of the right which by the decision of the Court he then had; and according to the appellees' reading of the statute, the simple *exercise* of a right may operate to extinguish the right itself!

Can any system of jurisprudence grasp such a thought, or embrace such a proposition?

Long before our examination system was enacted, it had been the universal rule of

Courts that the time which they took for examination should not destroy the right they examined; for otherwise a trial would not vindicate a right but efface it. How much the more must this rule apply when the examination is not made by a third party, or tribunal, but by the defendant himself.

It is common in insurance policies to provide that the insured shall bring in his proofs and make his claim within a limited time, or lose it. But what would be thought of a provision that the insurers need not pay if their own adjuster delayed examining the papers?

It cannot be said that taking out a foreign patent is an act injurious to the value of the property the public offers for, or even contrary to its interests or desires. The United States does not wish to enjoy a secret: it desires the creation of the invention and publicity of it. The first thing it does when it grants a patent is to publish it; and it contemplates that the inventor may publish the invention, by use and otherwise, even two years before his application. A foreign patent by a stranger before the American inventor's application does not hurt it. A foreign patent by him coming out simultaneously with the American patent is not objected to. It is no part of the policy of our laws, says GRIER, J. (15 How., 125), to prevent an American inventor from taking out patents abroad; and there is no reason why there should be. He may even *apply* abroad before he applies here, and there is no objection to that even on the defendants' reading. The alleged curtailment is inflicted in the cases which constitute the difference between our opponents' reading and ours,

not because the foreign act of the inventor is injurious or objectionable, but solely because of the greater or less time which the party bound to pay spends in identifying the property after he has got it.

Of course it would be perfectly just and entirely consistent with the nature of contractual obligations to make any act on the part of the inventor after his right to a patent had become perfected by filing the application, and thus delivering the thing for which the offer was made, but before he had received his patent, *inconsistent* with his attitude as an applicant in good faith for the reward the ground for a destruction of his right. If, in the necessary work of examination he should unduly delay to comply with any requirement designed to facilitate that work, or in any way delay to receive his patent when he might have it, such conduct might be justly made a reason for refusing it.

We are not dealing here with the subject of abandonment or delays on the part of an inventor which may serve to *abrogate* contractual rights. Acts of this nature furnish the proper subject of special statutory provisions and have been so treated in our patent system; and they may, aside from such provisions, have, on general principles of contract, the effect of impairing rights otherwise perfect. But any suggestion that the particular form of the statutory provision under interpretation was designed to punish or prevent delay must, surely, after the foregoing observations upon the necessary consequences and incidents connected with the proposition of the defendants (to which we fully accede) that the patent law creates relations of solemn contract and obligation,

be seen to be wholly destitute of foundation. If that suggestion ever had any plausibility, which it never did have, it has now disappeared. To the objections heretofore made, that this provision in the statute is one of those relating to fundamental policy and not to incidental precautions; that it does not purport to be a remedy against inventors' delays and does not make any reference to such delays; that such delays are made the subject of special attention in another part of the statute; that it would be extremely unreasonable to impute to a Government, perfectly able to prevent such delays by just and appropriate remedies, the employment of a crude and ill-adapted device which would punish the innocent much oftener the guilty, must now be added the high degree of improbability that the Government would, for the purpose of checking abuses in the patent system arising from delays by inventors, utterly abrogate the solemn promise which had always been the foundation of its patent system and substitute in place of it a vague and illusory expectation containing no element of right capable of enforcement; and yet leave its provisions for specific performance wholly untouched.

Sixth Point.—The whole argument in support of the interpretation of the defendants finally reduces itself to the small contention that, at the *first reading*, "first patented" and "previously patented" more naturally and logically relate to the time of the *issue* of the foreign patent. Let it be so; it is safe to say that this argument has never been allowed to prevail, particularly in the case of revising

statutes, where either reason, or justice, or the policy of the law, or the history of prior legislation on the same subject, has justified a *well-grounded doubt* whether such *prima facie* interpretation was correct. To press such an interpretation when *all* these considerations *concur* in rejecting it is to set reason at defiance.

1. Such a rule of construction would wipe out of existence nearly the whole of the law of interpretation. We should indeed have much less law to study, but both the laws which men pass and the agreements they make would become, in large measure, unintelligible absurdities. The principal mass of our rules of interpretation is framed upon a recognition of the fact that *prima facie*, *first blush*, interpretation would throw both the public and the private affairs of men into inextricable confusion.

2. Such a rule has never been acted upon. Text writers and Judges alike always enjoin in any doubtful case a resort to reason, to justice, to policy, to the antecedent, and surrounding circumstances. Human language, though the best, is by no means a perfect exponent of thought, even when used by the clearest and most skillful minds; as employed by ordinary men, it is full of imperfections. Mankind can never be *taught* to use language with perfect accuracy by simply subjecting them to inconveniences. That failures in clearness of expression will forever take place must be accepted as a fact,

and it is one of the highest functions of the judicial office to ascertain the true meaning of the language actually employed by bringing to bear on it those *other* lights and guides which are to be found outside of the language.

To exhaust the teachings upon this point would require a volume, and they are almost too familiar to justify any citations, but some may be profitably referred to.

In the case of the United States *vs.* Kirby (7 Wall., 482), one of the head notes is:

"All laws should receive a sensible con-
"struction. The general terms should be
"so limited in their application as not to
"lead to injustice, oppression or an absurd
"consequence, and it will always be pre-
"sumed that the legislature intended excep-
"tions to its language which would avoid
"results of this character."

This language is borrowed from the opinion of the Court as given by Mr. Justice Field.

In the case of the United States *vs.* Babbitt (1 Black, 55), a certain result was insisted upon as flowing from the obvious language of the statute taken literally; but the consequence appeared to the Court unreasonable and it said:

"If this were so, the result claimed would
"not necessarily follow. In that case we
"should find no difficulty in holding it to be
"clearly implied that the same rule of com-
"pensation should apply to their successors
"as to the then encumbents and their pred-
"ecessors. What is implied in a statute,
"pleading, contract or will is as much a part
"of it as what is expressed." And many authorities were cited, and among them the following maxim from the case of Zouch *vs.*

Stowell (Plowd, 366). "The thing within the "intention of the makers of the statute, is "as much within the statute as if it were "within the letter."

Wilson vs. *Rousseau*, 4 How., 646 [1846], turned upon the relative rights of inventor and assignee in the extended term under statute 1836, Sec. 18. The language presented no ambiguity to the reader. But in applying it to cases likely to arise its apparent meaning led to deplorable consequences. In one view, the extension enured solely to the inventor's assignee. In another, it enured solely to the inventor, who then could stop the further use of machines he had already sold and been paid for. The Court concluded that Congress meant primarily to benefit the inventor, but intended also to prevent such an abuse by him of his newly given right; and it "construed" the statute so as to secure that result.

It did not pretend to reach this conclusion by any verbal criticism, but by (p. 377): "a due regard to the great object and intent of Congress as collected from the context and general provisions and policy of the patent law" for "the intention of the law makers" is to be resorted to "to fix and control their meaning so as to reconcile it, if possible, with the general policy of the law."

P. 684. "The consequences of any different construction than the one proposed to be given are always to be regarded by the Courts, when dealing with a statute of doubtful meaning. For between two different interpretations, resting upon judicial expositions, of ambiguous and involved phraseology, *that which will result in what may be regarded as coming nearest to the intention of the Legislature should be preferred.*"

Upon one construction of the extension statute a purchaser of the machine during the original term would be, said the Court (p. 684) "left to the discretion or caprice of the patentee. A construction leading to such consequences and fraught with such unmixed evil, we must be satisfied was never contemplated by Congress, and *should not be adopted, unless compelled by the most express and positive language of the statute.*"

P. 680. "We cannot but think a Court should hesitate before giving a construction to the cause, so deeply harsh and unjust in its consequences, both as respects the public and individual rights and interests, upon so narrow a foundation."

Thus the Court reached what it concluded was in conformity to the general intent of Congress, though it had to mould the plan to be other than what Congress specifically thought of, in order to meet difficulties which Congress did not see.

Bloomer vs. *McQuewan* (15 How., 539) [1853]. Here the Court read into the special act extending the Woodworth planer patent, provisions in favor of grantees which Congress had put into other acts, but had not put into this, saying that in those other cases "the attention of the legislature was more particularly called to the subject and the rights of the purchaser recognized and cautiously guarded," but that they should construe this as if Congress had done the same here.

The lay mind would call this a correction of the oversights of Congress, but it is quite within those powers of judicial construction which the Courts have long used and found absolutely necessary.

Paper Bag Co. vs. *Nixon*, 105 U. S., 766, referred to these decisions as "*well*-settled law."

Siemens vs. *Sellers*, 123 U. S., 276, 285. Before 1861, United States patents were of two classes: one ran fourteen or twenty-one years from date of U. S. issue; the other fourteen or twenty-one years from the date of a foreign patent for the same invention. St. 1861 enacted that "*all* patents shall remain in force for the term of *seventeen* years from the *date of issue*." Here was no ambiguity of words. Language could not more plainly make "all" patents alike in duration. But the Court refused so to read it, on the ground that it would not permit a long established policy and classification to be disturbed, in spite of the sufficiency of the words, and for the sole reason that it did not believe that Congress actually had that change of plan in view. It boldly asserted (p. 285):

"Seventeen years' limit was substituted for fourteen years. That was all that was intended or thought of. That was the sole point before the legislative mind."

The other view "can *hardly be supposed* to have been the intention of Congress."

The Court added, so little did it trouble itself about words:

"No doubt the words of a law are *generally* to have a controlling effect upon its construction; but the interpretation of these words is often to be sought from the surrounding circumstances and preceding history."

In short, in construing a statute, as in construing a contract, the Court will always use what in *Nash* vs. *Towne*, 5 Wall., 689, 699,

and *Mobile R. R.* vs. *Jurey*, 111 U. S., 584, 593, it called, "*the strong light of surrounding circumstances.*"

It applies to all writings the common sense rule of *Canal Co.* vs. *Hill*, 15 Wall., 94, "Where the essential thing which they have in view can be gathered from the whole instrument, it will control mere formal provisions *which are intended only as a means of attaining the substance.*"

3. An acceptance by this Court of the defendants' rule of interpretation would be a *reversal* of the method it has uniformly adopted in the construction and administration of the patent law from the time when it was first called upon to construe it to the present hour.

The defendant's rule simply consists in elevating the importance of *first blush, grammatical*, interpretation above that founded upon a regard for the objects and puposes of the law, and reason, justice and consistency in its administration.

It is most noteworthy with what constancy this Court has rejected this method and acted upon the contrary one. So true is this that it would be entirely just to say that our system of patent law to-day, although embodied in specific and minute legislation, is in large measure not the creature of such legislation, but the creature of this Court in construing it. The Court has from the first proceeded upon the view that the main object of Congress was to promote the progress of the useful arts by promising a sure and certain reward to inventors, and in keeping

that promise. The language which Congress has employed to carry out this design has often been obscure, contradictory or otherwise ill-adapted. The Court, without violating settled principles of interpretation, has construed the language employed very freely to the end that the object should be secured. Its successive interpretations have been followed and adopted by Congress by the introduction of amendments, and the system is thus in large decree the creation of the Court.

The reports are full of interesting proofs of this. A few illustrations may be selected.

a. The words of the Statutes of 1790 and 1793, "not known or used," before the application, were considered and interpreted in Pennock *vs.* Dialogue (2 Pet., 1). The Court, in view of the purpose of the patent law and the dictates of justice and sound policy held that "not known or used" must be interpreted as not known or used by the public.

The Act of 1836 enacted this interpretation by changing "known or used" to "in public use or on sale."

It was further intimated in the same case that any use by others who had gained their knowledge by fraud or pirating from the inventor would not avail to bar a patent.

The Act of 1836 enacted this suggestion by providing that the public use which would defeat a patent must be "with the consent of the owner."

b. The original patent acts of 1790 and

1793 made no provision for the issue of a new patent in cases where, by some inadvertence or mistake, a defect had crept into the form of the letters patent, which would prevent the inventor from prosecuting for an infringement. The Supreme Court held, in Grant *vs.* Raymond (6 Pet., 218), that, notwithstanding this, the Government must be assumed to be clothed with power to correct the error, and, by the issue of a new and amended patent, to assure to the inventor his merited reward. Congress, by the Act of July 3d, 1832, conformed the statutory law to this judicial declaration, and gave express authority to the Secretary of State to accept a surrender of the erroneous patent, and issue a new and corrected one.

c. In Shaw *vs.* Cooper (7 Pet., 292) it was much considered whether a piratical or surreptitious use of the invention before the application would bar the inventor's right—a matter upon which the statutory law was silent. The Court expressed the view that it would not. This view was enacted in the 7th section of the Act of 1836 by the language, "or had "been in public use or on sale *with the* "*applicant's consent or allowance* prior to the application."

d. In Wilson *vs.* Rousseau (4 How., 646) the entire benefit of a renewal was asserted as belonging to assignees, under that clause of the statutory law, which was in these words: "And the benefit

"of such renewal shall extend to as-
"signees and grantees of the right to
"use the thing patented to the extent
"of their respective interests therein."

This contention was rejected by the Court in a masterly opinion by Mr Justice Nelson, in which he turned from the particular language of the statute to a consideration of the general system and policy of the law and of the unjust results which would flow from an adoption of the asserted contention, and held that the clause in dispute was designed to secure the rights of those using the invention to a continued use. In the revision of 1870, Congress omitted the word "respective," which had been greatly relied upon by Mr. Justice Woodbury, in a dissenting opinion, as sustaining the contention which the Court rejected, thus indicating its intention that the written law should correspond to the judicial declaration.

4. But the most pointed support, both of the *rule* of interpretation insisted upon in this brief, and of its application to the precise case under discussion is to be found in some recent English adjudications.

a. The 20th Section of the English Statute (Stat. at Large, 1852, Chap. 87), is as follows:

"XX.—Provided also, that no Letters Patent (save Letters Patent issued in lieu of others lost or destroyed) shall be issued or be of any force or effect, unless the same

be granted during the continuance of the provisional protection under this act, or where a complete specification has been deposited under this act, then unless such Letters Patent be granted during the continuance of the protection conferred under this act by reason of such deposit, save that where the application to seal such Letters Patent has been made during the continuance of such provisional or other protection as aforesaid, and the sealing of such Letters Patent has been delayed by reason of a caveat or an application to the *Lord Chancellor*, against or in relation to the sealing of such Letters Patent, then such Letters Patent may be sealed at such time as the Lord Chancellor shall direct." Sec. 24 provided, in substance, that a patent sealed on one day, but antedated to the day of application, shall, generally speaking, be of the same force and validity as if sealed on the date named. It, however, distinguished the *date*, and the time of actual *grant* for some purposes. Thus the same Sec. 24 provided that no action for infringement should reach any act done before the patent was actually granted, using these words to express the day of sealing.

In Johnson's Case (L. R., 13 Ch. Div., 398), the petition for sealing was not brought to the *Lord Chancellor's* office until after *seven* months, so that the case was not within the words of the section. The delay had been owing to proceedings in the *Attorney-General's* office, and were not the fault of the petitioner. But the notion that the petitioner should be made to suffer from a delay caused by the neglect of officials was so odious in the

view of Lord Chancellor Cairns, that he did not hesitate to say that he should *construe* the statute as intending to relieve the applicant from the consequences of delay caused by opposition in *any* public office.

b. Section 25 of the same act enacts that an English patent to a foreigner for an invention which he had patented abroad "before the *grant* of such Letters Patent" in England becomes void when the foreign patent dies or lapses. Section 24 is as follows:

"XXIV.—Any Letters Patent issued under this act, sealed and bearing date as of any day prior to the day of the actual sealing thereof, shall be of the same force and validity as if they had been sealed on the day as of which the same are expressed to be sealed and bear date. Provided, always, that save where such Letters Patent are granted for any invention in respect whereof a complete specification has been deposited upon the application for the same under this act, no proceeding at law or in equity shall be had upon such Letters Patent in respect of any infringement committed before the same were actually granted."

In spite of this clear demonstration (so far as words go) that "grant" meant the day of actual sealing, unless in the cases specially excepted, which did not include the case at bar, the Court, in Holste *vs.* Robinson (L. R., 4 Chiv. Div., 9), made "grant" in Section 25 equivalent in meaning to "date of application," in order to save the patentee from the limiting effect of a foreign patent.

Seventh Point.—The appellees seek to show there is a large assent to their view among the officers of the Patent Office and Judges of the Circuit Courts. If this really existed it would go not very far to support their contention; but it does not. Instead of general *concurrence, doubt and dissent* are everywhere exhibited.

1. The only real determination by a Circuit Court upon this question was in the case of Bate Company *vs.* Hammond (13 Fed. Rep., 553), in 1882. In that case three questions arose upon the section now under discussion, and the decision by Nixon, J., was adverse to the patentee upon each of them. In respect to two of them, although he had been followed by other Circuit Court judges, his decision has since been reversed by the U. S. Supreme Court. (Bate *vs.* Hammond, 129 U. S., 151.) In respect to the third question, which is the one now under discussion, Judge Nixon seems to have given the point very insufficient attention. This is evidenced from the brevity with which he deals with it, and from his observation that he was "at "a loss to understand what the time of "filing the application has to do with the "matter."

Very little reflection upon the prior law—its policy and its history—would have sufficed at least to inform the learned Judge that the time of filing the application has a great deal to do with the matter.

2. In Gramme *vs.* Arnoux (2 Blatch., 45), the

same question arose before Mr. Justice Blatchford as Circuit Judge. He simply cited and followed Judge Nixon's decision without reasoning, or discussion, in his opinion.

In Edison Electric Light Co. *vs.* U. S. El. L. Co. (35 Fed. Rep., 134), Mr. Justice Wallace simply cites the two foregoing cases and saying that "Judge Blatchford adopted the view of Judge Nixon," follows them with but little in the way of discussion.

In the Bate Refrigerating Company *vs.* Hammond (35 Fed. Rep., 151), Mr. Justice Colt, in a decision consisting of a single paragraph, referred to the decision by Mr. Justice Bradley, hereinafter mentioned, against the patentee, and simply followed it.

It is quite manifest that of these several cases one alone is properly to be regarded as an authority. The others followed it simply as being a precedent.

3. The same case in which the decision was rendered by Mr. Justice Nixon, came at a subsequent stage, before Mr. Justice Bradley, and an attempt was made to reopen the question before him. He refused to allow it to be reopened, but said: "If the question "were an open one, I might have some hesi- "tation: but as it is at least a question of "considerable doubt, I feel constrained, "sitting at Circuit, to follow the law of the "case as held by Judge Nixon, especially as "his judgment has been followed in other "circuits."

Mr. Justice Bradley could not with propriety, sitting as an appellate judge, set aside a previous order in the same case made

by another judge. Further observations made by him upon this question have been quoted in a former part of this brief.

4. The question came before the Supreme Court of the United States on an appeal taken in the cause in which Mr. Justice Colt gave the decision above referred to (Bate *vs.* Hammond, 129 U. S., 151), and the Supreme Court allowed twelve counsel to intervene and argue this and one other question. The Court avoided a decision upon this question by sustaining the patent upon the other ground. It is believed that the judges were divided in their views upon the present question. And the main part of the argument contained in this brief, namely, that which relates to the prior policy of the law, to the settled rules for the interpretation of revising statutes, to the history of the legislation, and to the contractual nature of the obligation of the government, was not presented before the Supreme Court.

5. The question, therefore, upon the judicial decisions is, as Mr. Justice Bradley declared, a *doubtful* one, and is a case for judicial construction, wholly unembarrassed by authority.

The observation in the opinion of this Court (Andrews *vs.* Hovey, 124 U. S., 694–717), that the construction of the Patent Act "cannot be regarded as judicially settled," * * * "cannot be regarded as finally "set-"tled so as to establish the law for like cases, "until it has been determined by *this* Court," is pertinent.

6. It is not unimportant to observe that the provision in the patent law, respecting limitations, due to taking out foreign patents has been the subject of great judicial differences, and that in every case which has reached the Supreme Court, that tribunal has found the construction favorable to the patentee to be the true one.

The cases of O'Reilly *vs.* Morse (15 How., 62) and Bate *vs.* Hammond (129 U. S., 167) reversed five Circuit Court decisions—all that had been made down to 1888—which held patents void because the limitation was not expressed.

The case of Pohl *vs.* Anchor Brewing Company (134 U. S., 381) reversed all the current decisions that were made upon this provision to the effect that foreign prolongations did not prolong, and that foreign forfeitures would destroy, United States Patents.

7. In such a condition of the adjudications in the Courts, it is comparatively unimportant what the views of the Patent Office have been. Its *action*, however, has been, up to the time of the decision by Judge Nixon, in accordance with the interpretation insisted upon in this brief. In 1871 the office promulgated this rule:

"An applicant whose invention has been "patented abroad, should state the fact that "a foreign patent has actually been ob- "tained, giving its date, and if there are "more than one, the date of each."

In *ex parte* Mann, C. D. 1880, page 57, Commissioner Paine decided that Section 4887 speaks from the *date of the application*. It has been stated that after he ceased to be

commissioner, Mr. Paine, in a private letter, said that he doubted the correctness of his decision. But no Commissioner has ever reversed it, or made a contrary decision.

Up to the time of Judge Nixon's decision no rule or practice required that foreign patents issued after the application and before the actual grant of the patent here, should be taken notice of.

As the rule now stands, it amounts to a declaration by the Patent Office that the whole question is in doubt.

Lastly.—It should be certified to the Circuit Court of Appeal that the words "first patented" and "previously patented" in Sec. 4887 of the R. S. mean patented before application for the United States patent.

JAMES C. CARTER,
Of Counsel for Complainant.

Office Supreme Court, U. S.
FILED.
NOV 15 1894
JAMES H. McKENNEY,
CLERK.

Supreme Court of the United States.

OCTOBER TERM, 1894.

No. 687.

THE BATE REFRIGERATING COMPANY,
Appellant,

vs.

FERDINAND SULZBERGER ET AL.,
Appellees.

BRIEF ON BEHALF OF THE HARRISON INTERNATIONAL TELEPHONE COMPANY, FILED BY LEAVE OF COURT.

B. H. BRISTOW,
WM. H. KENYON,
Of Counsel.

C. G. Burgoyne, Walker and Centre Sts., N. Y.

Supreme Court of the United States.

THE BATE REFRIGERATING COMPANY,
Appellant,

vs.

FERDINAND SULTZBERGER ET AL.,
Appellees.

October Term, 1894.
No. 687.

The question presented to the Court by this record is of interest and importance to corporations and individuals who are not parties to the case, and its determination will directly affect their business and investments. Among others so situated is the Harrison International Telephone Company, a corporation of the State of Illinois, organized for the purpose of entering upon and conducting the telephone business through local exchanges throughout the United States, and which has already put into operation a number of such exchanges in the States of Illinois, Ohio, Kansas, Michigan, New York, North Carolina and Arkansas, and is now proceeding with the establishment of a large number of other exchanges in the same and other States. At the time of beginning such business, namely, in the spring of 1894, it was believed by the officers of said company, and understood by the public, that certain important telephone patents had expired under the provisions of Section 4887 of the Revised Statutes. Very recently suits have been instituted against said company by the owners of such patents, in which it is claimed that the same are still in force, and that the Harrison In-

ternational Telephone Company is an infringer thereof. Some of these patents were granted in 1892 upon applications filed in 1877. During this interval foreign patents were granted for the same inventions. In the event of a decision by this Court adverse to such general understanding, and to the ruling at circuit, the patents, which it was supposed had expired, will be in force for many years to come, contrary to the belief and understanding of the public, and of the officers of said company when they entered upon the business of organizing telephone exchanges. For this reason the undersigned, as counsel for said company, respectfully ask leave to submit the following brief suggestions in support of the contention of counsel for appellees.

Section 4887 of the Revised Statutes is as follows:

"No person shall be debarred from receiving a patent "for his invention or discovery, nor shall any patent "be declared invalid, by reason of its having been first "patented or caused to be patented in a foreign coun- "try, unless the same has been introduced into public "use in the United States for more than two years "prior to the application. But every patent granted "for an invention which has been previously patented "in a foreign country shall be so limited as to expire "at the same time with the foreign patent, or, if there "be more than one, at the same time with the one hav- "ing the shortest term, and in no case shall it be in "force more than seventeen years."

It will be seen that the first sentence of the section relates to the right of an inventor to receive a patent for his invention or discovery, notwithstanding it may have been first patented in a foreign country, unless it had been introduced into public use in the United States for two years prior to the application. It has nothing whatever to do with the term or duration of the patent.

The second sentence relates to the term of a domestic patent for an invention patented in a foreign country, and fixes its duration.

This last sentence of the section covers the entire subject to which it relates. No other part of the section, and no other section of the Revised Statutes, is in *pari materia*.

It cannot be denied that the sentence read by itself and interpreted by the ordinary and grammatical rules of construction plainly declares that every domestic patent shall expire at the same time with the foreign patent for the same invention, which was granted previously to the granting of the domestic patent. The grammatical rule makes the adverb "previously" relate to its last antecedent. Obviously, the last antecedent here is "patent granted for an invention." No rule of grammatical construction would justify carrying the adverb back to a preceding sentence which relates to another branch of the subject, to seek for an antecedent while there is one immediately preceding it in the same sentence. To do so would be to defeat the plain meaning of terms as understood not only by persons of ordinary intelligence, but by the greatest sticklers for strict rules of grammar. The claim that this section makes a change in the law as it stood before the adoption of the Revised Statutes does not authorize the courts to disregard the plain meaning of the section and hold that Congress erred in the revision.

U. S. vs. Bowen, 100 U. S., 513.

If the language were ambiguous or admitted of substantial doubt as to its meaning, the Court might well look to the old law as a "valuable source of information." But it was entirely within the power of Congress to impose any limitation it chose upon the life of a patent; it could as well do so in a general revision of the statutes as in the passage of an act relating to only one subject. The sole power and duty of the Courts is to apply and enforce the statute as it comes from the hands of Congress. And in ascertaining what Congress has done or meant to do, the first

resort is to the words of the statute. If they are plain and unambiguous, no other source of information is open to the Court. It is of no consequence what individual members of Congress may have intended or supposed. *Non constat* that other members, or, Congress as a body, had the same purpose. The opinion and purpose of the author of a bill, or of a committee having it in charge, however clearly expressed, cannot be permitted to prevail against the plain language of an act; for it may well be that others whose votes were necessary to its passage had very different opinions and purposes. Nor would the fact that the ordinary and grammatical meaning of a statute would probably lead to results not in the mind of Congress, authorize a Court to disregard the plain language and give it another meaning.

The rule in this regard was well stated by this Court at an early period in its history as follows, viz.:

"Where the words of a law, treaty, or contract, have "a plain and obvious meaning, all construction, in hos- "tility with such meaning, is excluded. This is a "maxim of law, and a dictate of common sense; for "were a different rule to be admitted, no man, how- "ever cautious and intelligent, could safely estimate "the extent of his engagements, or rest upon his own "understanding of law, until a judicial construction "of those instruments had been obtained."

Green vs. Biddle, 8 Wheat., 1, 89-90.

The reason upon which the rule is founded as thus stated is peculiarly applicable to a statute fixing and limiting the duration of patents.

It is a matter of common knowledge that a considerable part of the industries and business of the country depend for their establishment and success upon patent rights and their limitation. In entering upon a business affected by the patent laws, the public have a right to rely upon the plain and obvious meaning of the statute, either as to grants or their limitation. If after

making investments and establishing plants the statute should be construed to mean something not expressed in it or fairly deducible from its words, great mischief and injury would often result.

The argument derived from the supposed mischiefs or hardships to the owners of patents leaves out of view altogether the limitation upon the rights of the public in our own country, and the consequent hardships to them in case the construction contended for by appellant be adopted. When a foreign patent expires the invention is, of course, open to use by the public of such foreign country; but, if the contention of appellant's counsel should prevail, the public in our own country would be cut off from such use. The modern practice of long delay between the application and issue, often the fault of the applicant, was a sufficient reason for limiting domestic patents to the life of foreign patents for the same invention. If not so limited, the public of this country would be at great disadvantage in respect of inventions patented both here and abroad.

The situation of the Harrison International Telephone Company, as hereinbefore stated, furnishes a striking illustration of the mischiefs and hardships likely to result if this Court should follow the contention of the learned counsel for appellant. If the section be read and construed according to the plain import of its words such results would be avoided. In fact, such a construction of the statute furnishes a safeguard, and the only one afforded by the patent law, against undue delay in applications for patents. But it is safe to say, that investments to the extent of millions of dollars, made in perfectly good faith, and in reliance upon the plain and explicit language of the section, would be greatly injured, if not totally destroyed, by the construction claimed by counsel for appellant.

In the matter of the section now under consideration, it does not by its own terms suggest any ambigu-

ity or doubt as to its true meaning, and there is nothing in any other section of the Revised Statutes in conflict with it, or calculated to raise a doubt as to its meaning. The most intelligent man of business could perceive no possible reason why the statute does not mean just what it says. Nor would counsel, called upon for advice touching the expiration of a patent for an invention which had been previously patented in a foreign country, find any reason in the section itself or in any other section of the Revised Statutes for holding that it should be given any other meaning than that indicated by the known rules of language and grammar. If he should look to the former statute he might find that the revision changed the law in respect of the measure of the life of the patent, but he would know it was within the power of Congress to make the change just as it had made other changes by the revision. This would not lead him to suspect that Congress did not mean what was plainly expressed, or that the section should be construed to mean something else.

The contention of the learned counsel for appellant in regard to the effect of the revision, and the duty of the Courts in construing the section in question, carried to its logical sequence, would greatly impair, if not destroy, the usefulness and convenience of the revision. Instead of being, as Congress intended it should be, the embodiment of statute law on the subjects embraced by it, it would be little more than an index—a point from which lawyers and courts might start to find the law. It would confuse, rather than simplify the statute law.

Elementary rules for the construction of statutes and written instruments are against the contention of appellant.

"The leading rule of construction is that a written "document is to be construed in the primary, literal "meaning of the words according to the rules of "language and grammar."

Leake on Contracts, First Edition, 222.

Story on Contracts (Fifth Edition) Sec. 780, states the rule of construction thus, viz.: "Where the lan- "guage of an instrument is neither uncertain nor am- "biguous it is to be expounded according to its ap- "parent import; and is not to be warped from the "ordinary meaning of its terms in order to harmonize "it with uncertain suppositions in regard either to the "probable intention of the parties contracting, or to "the probable changes which they would have made in "their contract, had they foreseen certain contingencies. "Wherever the words are clear and definite, they must "be understood according to their grammatical con- "struction and in their ordinary meaning. For such, "it is natural to suppose, is the intention of the party "using them."

Mr. Parsons states the rule as follows:

"Indeed, the very idea and purpose of construction "imply a previous uncertainty as to the meaning of "the contract; for, where this is clear and unambig- "uous, there is no room for construction, and nothing "for construction to do."

2 Parsons on Contracts, 8th Ed., Pg. 617.

In United States vs. Hartwell, 6 Wall., 396, Mr. Justice SWAYNE said, speaking of a statute:

"If the language be clear it is conclusive. There "can be no construction where there is nothing to "construe."

Endlich on Interpretation of Statutes, Sec. 2, gives it thus:

"The first and most elementary rule of construction "is that it is to be assumed that the words and phrases "are used in their technical meaning, if they have ac- "quired one, and in their popular meaning if they have "not, and that the phrases and sentences are to be "construed according to the rules of grammar."

"When the intention is expressed, the task" (interpretation) "is one of verbal construction only."

Ibid., Sec. 1.

If a statute, read in the clear light of these elementary rules, would, in the opinion of the Court, lead to mischievous or absurd consequences or even to hardship, that circumstance would not warrant the Court in giving it some other meaning not suggested by the words of the statute. The remedy for such a mischief would be with Congress. If Congress had power over the subject, unrestrained by constitutional limitation, the matter is completely within its discretion, and to attempt to control that discretion by forced construction would be an unwarrantable invasion of the legislative domain.

"Where, by the use of clear and unequivocal lan-
"guage, capable of only one meaning, anything is
"enacted by the Legislature, it must be enforced, even
"though it be absurd or mischievious."

Endlich on Interpretation of Statutes,
Sec. 4.

"If courts were at liberty to travel out of the words
"of any particular act of Parliament, and to consider
"what would in any case be the consequences of
"giving those words their natural meaning, they
"would become legislators and not interpreters.
"It has, therefore, been distinctly stated, from
"early times down to the present day, that
"Judges are not to mould the language of stat-
"utes in order to meet an alleged convenience or
"an alleged equity; are not to be influenced
"by any notions of hardship, or of what in their view
"is right and reasonable, or is prejudicial to society;
"are not to alter clear words, though the Legislature
"may not have contemplated the consequences of
"using them; are not to tamper with words for the
"purpose of giving them a construction which is sup-
"posed to be more consonant with justice than their
"ordinary meaning. Where the language of an Act of
"Parliament is clear and explicit, effect must be given
"to it, whatever may be the consequences, for in that

" case the words of the statute speak the intention of " the Legislature."

Wilberforce's Statute Law, p. 116.

In the case of Woodward vs. Watts, in the Court of Queen's Bench, 2 Ellis & Blackburn, 452, the question was whether the defendant was qualified to act as a Justice of the Peace under certain statutes relating to the qualification for that office.

Lord CAMPBELL, C. J., said: "I cannot interpolate " the word 'including,' as was suggested by one " counsel; nor can I, as suggested by the other, in " effect, reject the words 'which are leased,' &c., as " applicable to 'remainder.' To do either would be to " make an enactment, not to construe one. I must " take the words as I find them, and, following the " golden rule, construe the words so as to put a just " construction on them. If this leads to hardship or " inconvenience the remedy must be sought from the " Legislature (p. 257).

CROMPTON, J., said: "We are here, in effect, asked " to apply the last part of what has been called the " golden rule to this statute, and say that, though the " grammatical sense of the words disqualifies the de- " fendant, yet that is such an absurdity that the gram- " matical sense must be modified to avoid it. I cannot " apply that to this case. I have great doubt as to " what the Legislature may have intended; and I do " not know that, if this case had been present to their " minds, they would have thought this a fit qualifica- " tion. But, supposing I knew what the Legislature " meant, and that it was not what the words in their " grammatical sense mean, still we must go farther, " and find some words that may express their real in- " intention; for I do not understand the rule of con- " struction to go so far as to authorize us, where the " Legislature has enacted something which leads to an " absurdity, to repeal that enactment and make another " for them, if there are no words to express that inten- " tion" (p. 458).

And Lord CAMPBELL, C. J., added: "With reference "to what my brother Crompton has said, I may re- "mark, that in the United States the Supreme Court "has the power of annulling an Act of the Legislature "if unconstitutional. In conversing with an eminent "American lawyer, I asked him some questions about "the working of that new and peculiar jurisdiction. "He said that it was understood in the United States "that our courts did, indirectly, by construing statutes "so as to avoid absurdity or injustice, control the Act "of the Legislature to the same extent. I am glad to "have the opportunity to disclaim any such jurisdic- "tion on our part" (p. 458). Doubtless this Court would just as promptly disclaim any such power.

The rule of construction of a statute is expressed by the Court of Appeals of New York as follows:

"Statutes which are plain and explicit are not to be "qualified by construction on the mere ground that "the Court deem the legislation unwise or indiscreet, "nor because, if effect be given thereto, according to "their plain expression, one class affected thereby may "be subjected to inconvenience to secure protection "and immunity to another."

Hyatt vs. Taylor, 42 N. Y., 260.

Cases may be cited in which the Courts have felt authorized to depart from or relax these elementary rules of interpretation for the reason that otherwise a particular statute or instrument would be inoperative, and that by doing so no possible mischief or injury could result to any one. But such is not the case presented by this record. The section in question would have a distinct effect and operation if the ordinary rule of grammatical construction be followed and a departure from it would seriously affect the business and interests of others than the owner of a particular patent.

Nor should consideration of the policy of the Government control in the construction of a statute. For the reasons stated by Mr. Justice FIELD, speaking for this

Court in Hadden vs. The Collector (5 Wall., 111), what is supposed to be the policy of the Government with reference to a particular subject of legislation is entitled to little, if any, weight even in a case of ambiguous or doubtful language. The policy of the Government ascertained from previous legislation is wholly inadmissible as the ground upon which to rest the judgment of a Court in the interpretation of plain and explicit statutory language. The only safe ground upon which a Court can stand in such cases is suggested by the maxim *ita lex scripta est*.

The danger of departure from this position is well expressed by SHARSWOOD, J.:

"The moment we depart from the plain words of "the statute according to their ordinary and grammati- "cal meaning, in a hunt for some intention founded on "the general policy of the law, we find ourselves in- "volved in a sea of troubles. Difficulties and contra- "dictions meet us at every turn."

Dame's Appeal, 62 Pa. St., 422.

In the administration of a statute which covers a multitude of patents, and affects such a diversity of interests, adherence to the simple and elementary rules of interpretation is of the greatest importance. However plausible and forcible may be an argument in favor of relaxation of thes rules in a particular case arising under the section in question, it is not possible to foresee the complications and mischiefs that may arise in the application of the relaxed rule to other cases.

Congress has seen fit to permit Section 4887 to stand as it was inserted in the revision, notwithstanding the rulings at Circuit construing it according to its plain import. This at least justifies the presumption that the legislative department of Government does not share the opinion that the language of the section does not express its real intention and purpose.

B. H. BRISTOW,
WM. H. KENYON,
Of Counsel.

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Supreme Court of the United States.

OCTOBER TERM, 1894.

No. 687.

BATE REFRIGERATING COMPANY,
COMPLAINANT AND APPELLANT,

against

FERDINAND SULZBERGER ET AL.,
DEFENDANTS AND APPELLEES.

BRIEF FOR MILO G. KELLOGG.

CHARLES H. ALDRICH,
Counsel for Milo G. Kellogg.

JUDD & DETWEILER, PRINTERS, WASHINGTON, D. C.

IN THE

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BATE REFRIGERATING COMPANY,
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BRIEF FOR MILO G. KELLOGG.

This brief is filed by permission of the Court in behalf of Milo G. Kellogg, of Chicago, whose interests, both as an inventor of telephone appliances and as a stockholder in companies operating telephone exchanges and manufacturing electric light and other apparatus, will, in his opinion, be disastrously affected by an interpretation favorable to complainant of section 4887, Revised Statutes.

The manner in which Mr. Kellogg's interests are affected will be shown with more particularity when the policy of

the act and the public injury that will be inflicted by an interpretation favorable to the complainants come to be considered.

The Policy of the Patent Laws.

It cannot be doubted that there is a general public policy with reference to this subject, and it is thought that a recognition of this fact will furnish substantial aid to the proper interpretation of the meaning of section 4887. This policy is found in the Constitution giving to Congress the power "to promote the progress of science and useful arts by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."

Congress in the exercise of the power here granted had as the ultimate object of its solicitude and care the interests of the people of the United States. This legislation was, as was also the grant to the Federal Government, for the interest of the people at large and not for the benefit of authors and inventors, except as a means to an end. It was rightly supposed that by offering rewards to authors and inventors the progress of science and the useful arts would be secured and thereby the general intelligence increased—the best safeguard of republican institutions. To this end a reward was paid the author and inventor, which is not directly graduated according to the benefit conferred upon the public, but is substantially so in actual practice. The exclusive right is granted in every case, neither more nor less. If the discovery is of great value great rewards are reaped from the grant; if of little or no value, the rewards are correspondingly small. There are exceptions, of course, but this is the theory of the grant.

The grant is, however, only for a limited time. Congress would have no power to create a perpetual monopoly or exclusive right. The intention here was to provide that the art or discovery should become free to the people upon the expiration of such limited period. If this fact is kept in mind, the assertion that upon the filing of an application for a patent the inventor at once acquires a vested right to a seventeen-year grant is shown to be entirely without foundation. The whole question of the length of time for which he shall have his exclusive right is committed to the discretion of Congress, and I cannot doubt that if Congress should see fit at its next session to pass an act limiting all patents thereafter granted to the term of six years it would be, or could be made, applicable to all pending applications. If this be conceded, much of the argument in favor of the construction sought by the complainant falls to the ground. At any rate, we find in the Constitution the declaration that Congress shall only grant exclusive rights for a limited time, and in the Statutes a compliance with this provision in all cases limiting the patent to seventeen years, and in some cases, as is claimed in behalf of appellees, limiting the grant to the life of the shortest grant of the same invention taken abroad.

Keeping in mind this fact, that both by the terms of the Constitution and by the acts of Congress from the beginning of legislation upon this subject the term of the patent grant has been limited and must be limited, it becomes evident that in a question of doubtful construction the Court should adopt such interpretation or construction as will carry out this intention to limit the grant.

The Practical Working of the Construction Sought by the Appellant.

In the brief filed in support of the motion to advance this case and permit oral argument herein counsel for the appellant urged the great public importance of the question involved arising from the desire of the public to use inventions upon which patents taken in foreign countries expired in advance of patents granted by the United States, and emphasizes the fact that the question is one affecting "many patents and large and varied interests over the United States." That fact is further emphasized by the names and relations of the counsel who appear in behalf of the complainant. These considerations of public importance and interest doubtless induced the Court to advance the cause and make proper on my part, an examination of what these interests are, and some comments upon the circumstances which have made this issue so important. This is further justified by the statement contained in the brief filed in support of the motion to advance the case, under date of April 17, 1894, that it was not designed to simply repeat the arguments advanced in Bate *vs.* Hammond, 129 U. S., 151, but that an extended examination would be made of the legislation upon the subject, of decisions expounding that legislation, and of the practical working of the plan established by that legislation and those decisions. (Page 5.)

For the purpose of this branch of my argument the complainant's position may be stated as follows:

The words of section 4887, Revised Statutes, "but every patent granted for an invention which has been previously

patented in a foreign country shall be so limited as to expire at the same time with the foreign patent, or if there be more than one, at the same time with the one having the shortest term, and in no case shall it be in force more than seventeen years," shall be so construed as to exempt from these plain terms such patents as were applied for before any foreign patent on the same invention was granted, though not actually issued until after the foreign patent. (Complainant's Brief, April 17, 1894, page 2.)

It is considered that a construction sustaining this proposition would, in the absence of action by Congress, render many of the leading monopolies dependent upon patents practically of indefinite duration. Such decision would also tend to greatly encourage practices in the Patent Office which would work a wrong to the people of a most serious character and cost the public, within a few years, many millions of dollars.

The willful and intentional delay of applicants for patents has, in recent years, been the subject of much comment. This comment has not been confined to the public at large, but has also taken the form of official action and recommendation.

For instance, the Commissioner of Patents in his annual report for the year ending December 31, 1887, says:

"I desire to call especial attention to the subject of delays "which occur in the Patent Office on the part of appli- "cants in the prosecution of their applications for patents."

" * * *

"Under this section applicants who desire to prolong "their applications and postpone action therein have ample "opportunity to do so. There are two classes of persons

"who apply for patents, one composed of those who are "exceedingly anxious to obtain their patents at the earliest "practical moment, the other of those who desire to prolong "the issue of their patents and to keep the applications "pending in the Patent Office to the very latest date pos- "sible. The second class embraces the more powerful, rich, "and influential parties, who are either the inventors or the "assignees of the inventors. This section of the statute "enables the second class of persons to keep their applica- "tions pending in the office for years before their patents "issue. In the meantime they are engaged in manufact- "uring and putting upon the market the article or improve- "ment, but warning the public that the patent is applied "for, the effect of which is to give them the absolute control "and monopoly of the invention and to deter all other in- "ventors from entering upon the same field of invention "and from manufacturing the article."

This evil was of long duration and finds illustration in some of the patents which injuriously affect Mr. Kellogg's interest and in behalf of which counsel have appeared at the bar in this case. These facts, together with the assertions of the brief filed to secure the advancement of this cause, seem to make it proper for me to make reference to particular patents.

On May 3, 1893, three patents were issued to the Western Union Telegraph Company on applications filed by Thomas A. Edison, as follows:

Patent No. 474,230; application filed April 27, 1877.

Patent No. 474,231; application filed July 20, 1877.

Patent No. 474,232; application filed July 20, 1877.

And on March 7, 1893, patent No. 492,789 was issued

to the same party on an application filed by the same party on September 5, 1877. These inventions became the property of the American Bell Telephone Company by the telephone consolidation contract of November 1, 1879, by which the great corporations who were parties to that contract agreed to stifle competition, the monopoly of telegraphy being reserved to the Western Union Telegraph Company and of telephony to the American Bell Telephone Company.

These Edison patents are fundamental, and it is undisputed that if they shall be held not to be limited by the expiration of foreign patents they, with the Berliner patent now in litigation, which was delayed or slept in the Patent Office from June, 1877, to November, 1891, will easily enable the American Bell Telephone Company to prolong its monopoly for seventeen years from the date of the letters patent.

These inventions were in constant public use from 1878, and assisted in founding a monopoly such as only the modern commercial world has witnessed and which has existed from that time to the present. Seldom, if ever, has an invention come so rapidly into public favor and returned to those owning it such substantial and ample rewards. It has been very ably and intelligently managed, and has conferred a great benefit upon mankind. The president of the American Bell Telephone Company recently stated as a witness under oath that the net annual income of the American Bell Telephone Company was, in 1892, $3,411,674.78, and in the same connection he testified that the inventor of one of these patents received $25,000 therefor, and for all of his inventions and some services he had

received about $100,000. The Edison inventions were patented abroad at earlier dates—in England, France, and Canada in 1877, in Belgium, Austria-Hungary, Italy, Germany, and Spain in 1878, and in Prussia in 1882. The art, in so far as these patents are concerned, is free in foreign countries, and, according to numerous decisions of the Supreme Court of the United States, and, as is submitted, according to the plain language of section 4887, is thereby made free in this country. In the Berliner case, where, as has been stated, the application was pending in the Patent Office from June, 1877, until November, 1891, there was never any contest, or, to put it in another way, in all its long sleep in the Patent Office it was never in interference with any other invention.

Substantially the same history is true with reference to the quadruplex telegraph patents which were applied for October 14, 1874, and issued December 15, 1885.

The incandescent-lamp patents also injuriously affect Mr. Kellogg's interests, and by reason of their expiration abroad have, under the construction heretofore given, expired here. The delay in the Patent Office was not so great in the case of these patents as in those to which I have heretofore referred.

It is a matter of common knowledge that most of the great inventions which mark eras in human progress are quickly followed by other improvements which carry the principle involved in the original invention to commercial success. The inventors of these improvements apply for their patents, which are useless except to the owners of the fundamental patent. Generally before the patent is granted, the application has become the prop-

erty of the owners of the original. They are then at liberty to use it and all interest in securing an early patent is at once gone. In fact, the interest is all on the side of delay, for thereby the period of monopoly is lengthened, or, as in many instances which might be cited, practically made perpetual by a number of patents always ready for issuance about the time some important patent expires. Hence have arisen those scandalous delays which, while they have enriched their owners, have plundered the people, and, in every respect, constituted a violation of the intention of the framers of our Constitution and of the provisions of the laws of Congress to carry that intention into effect by which the terms of the patent grant is to be only for a limited period.

Until recently, the rule established upon circuit, and, as I submit, plainly required by the language of the text, has to a large extent prevented these practices. Inventors desired to protect their inventions, and therefore took out foreign patents and became foreign patentees, and as such, *pro tanto*, governed by foreign law and deriving their rights therefrom. It has, at least for some years, been understood that the American patents were limited to expire with the foreign patent of shortest life, and the inventor had simply to consider whether reaping in all the fields for a shorter period would be more profitable than in one field for the full period. As he decided the question his patent term was determined.

Later these vast corporations based upon patented inventions conceived the idea, as we must presume from their known interest and the facts of history illustrated by the dates here given, that they could prolong the life of their monopolies both through delays in the Patent Office and through congressional or judicial action. Hence there have

been delays of fourteen years without interference; of as many or more years where all sides of the interference were owned by the same interest. Hence, also, there were five bills introduced into the Fifty-third Congress seeking to amend section 4887 along the lines sought for in your decision and retroactive in character. These bills were House bills 4515, 5014, 5361, 6098, and 6597. They also were ostensibly in the interest of the "poor inventor" who, presumably, was masquerading behind great corporations. They failed to obtain a recognition in Congress, which is an astonishing fact if the question whether a domestic patent has expired by reason of the expiration of a foreign patent is to be determined from the date of the application rather than the date of the issuance of the patent, and if, as counsel must contend, the present wording of section 4887 is a mere oversight. It is submitted that the refusal of Congress to give recognition to this contention is entitled to weight in this Court. However that may be, it is manifest that if the Court sustain the appeal the practices which have been pointed out will be encouraged and the people of the United States will, in all important inventions, be paying tribute to monopolies long years after the art is free in foreign countries. Such "practical workings" would, I submit, neither promote honest conduct nor the progress of science and the useful arts, but would work great wrong to the people of the country, to the enrichment of vast corporations already adequately rewarded.

Section 4887 and Its Interpretation.

The first legislation of Congress which seems to have a bearing, though perhaps remote, upon the question at issue is found in section 6 of the act of 1839. It is as follows:

"That no person shall be debarred from receiving a pat-
"ent for any invention or discovery, as provided in the act
"approved on the fourth day of July, one thousand eight
"hundred and thirty-six, to which this is additional, by rea-
"son of the same having been patented in a foreign country
"more than six months prior to his application: *Provided*,
"That the same shall not have been introduced into public
"and common use in the United States, prior to the applica-
"tion for such patent: *And provided, also*, That in all cases
"every such patent shall be limited to the term of fourteen
"years from the date or publication of such foreign letters
"patent."

Prior to this time the restrictions limiting the benefit of our patent laws to citizens of the United States or persons who had declared their intention to become such had been removed. Congress had apparently realized that the benefits of a foreign discovery were as great if communicated to our people as of a domestic one. The citizen of the United States was also at that time permitted to patent his inventions abroad and the enlightened policy, now so common, of granting to the citizens of other nations large and extensive privileges was generally recognized. In fact, if I am not mistaken, the act quoted was passed for the relief of Mr. Morse, the inventor of the magnetic telegraph, who had

taken out foreign patents more than six months before he properly should have filed his specifications and drawings, which, under the law, prior to that time should have been filed when the patent issued, and not at the date of the application. Under the act of 1836, there was a limitation of six months. This was abolished by the act of 1839, and the inventor permitted to receive a patent, although the invention had been patented in a foreign country more than six months "prior to his application" in this country. This general statement was limited by the proviso which debarred the inventor from receiving a patent if his invention had been introduced into public or common use in the United States. The farther limitation is significant, "that in all cases every such patent shall be limited to the term of fourteen years from the date of publication of such foreign letters patent." Thus it will be seen that as early as 1839 the term of the domestic patent for an invention also patented abroad depended neither on the date of the application nor on the date of the grant, but upon the date of the publication of the foreign letters patent. Where there had been several letters patent, not so common then as now, there were no provisions as to which publication should fix the date from which the fourteen years should commence to run. In view of the evident purpose I submit that had the question arisen it would have been held to run from the first publication. It is a mistake to suppose that the majority opinion in O'Reilley *vs.* Morse, 15 How., 62, 112, holds that this statute is only applicable to foreign inventions. The language of Taney, Ch. J., at the last page is especially significant as to this suggestion, and in view of later decisions of this

Court it is submitted that there can be no doubt that the date of the application has nothing to do with the question. It is important in many cases as bearing upon his right to a patent, but has nothing to do with its term of life.

The next act was in 1870. Section 25 was as follows:

"That no person shall be debarred from receiving a pat-
" ent for his invention or discovery, nor shall any patent be
" declared invalid by reason of its having been first patented
" or caused to be patented in a foreign country, *provided* the
" same shall not have been introduced into public use in
" the United States for more than two years prior to the
" application, and that the patent shall expire at the same
" time with the foreign patent or, if there be more than one,
" at the same time with the one having the shortest term,
" but in no case shall it be in force more than seventeen
" years."

This act omits all reference to the application for the patent in its first clause and provides generally that a patent may be granted in this country, notwithstanding the fact that the same invention has been patented or caused to be patented in a foreign country.

The proviso differs from the proviso to the statute of 1839 in that in the latter act, if the invention had come into public and common use for any time prior to the application for the patent, such use prevented its issue, while in this act the public use must have continued for two years to bring about this result. But under this act of 1870 there is nothing to indicate that the domestic patent for an invention patented abroad and not used in this country two years prior to the application here was to continue for seven-

teen years. Nor is this statute limited to cases where the application is filed here after the patent abroad. The act of 1839 was. The language is comprehensive and applies to all cases, without reference to the date of the application, and provides absolutely that the domestic patent "shall expire at the same time with the foreign patent, or if there be more than one at the same time, with the one having the shortest term."

It seems to me that it must be admitted that this section, which was only in part prepared by the revisers, did work changes in the law, and I suppose that the well-established principle that a revision is not presumed to be designed to depart from the meaning of the original text will be invoked, and upon this will be founded the argument that the clauses must be interpreted so as to mean the same as the original act.

It will doubtless also be insisted that the statement of members of the Committee on Patents in Congress negatives the idea of any intention to make any change. This can be only partially true, for it must be conceded that the clause expressly providing that the patent so granted should expire at the same time as the foreign patent having the shortest term was an addition, not by the revisers, but by the House Committee on Patents, which addition, therefore, is in no way subject to the rule so often invoked where the work of revisers is under consideration. This clause stands as the deliberate act of Congress, and as full effect is to be given thereto as though it had been enacted as an independent act. With it the revisers had nothing to do.

In the second place, it may be suggested that the act of June 27, 1866, did not create the ordinary revisory

committee, and that therefore the many decisions which may be collected from the different State reports as to the interpretation of the work of revisers can have but little or no application. This commission was not charged with the duty alone of bringing together statutes upon the same subject, "omitting redundant or obsolete enactments and making such alterations as may be necessary to reconcile the contradictions." They were authorized, also, to "supply the omissions *and amend the imperfections of the original text.*" This must necessarily mean the power to report amendments wherever the law was supposed to be defective. Any other interpretation makes the italicized words redundant and meaningless. This is further illustrated in section 3, where they are required to "suggest to Congress such contradictions, omissions, and imperfections as may appear in the original text, with the mode in which they have reconciled, supplied, *and amended* the same." I have not seen the original report of the commission nor a *fac-simile* thereof, but whether the clerical notations shall show that this section was, in the opinion of the commissioners, amended or not does not seem to me important in view of the fact that it was in fact amended; that the revisers had power so to do; that the title of their act declared it to be an amendment, and that Congress, after approving an addition coming from another source which absolutely controls the case at bar, if words are given their ordinary signification, enacted the clause as it now stands and has since caused the same to be embodied in the revision of 1878, pursuant to the act of March 2, 1877. This last revision is made legal evidence of the laws therein contained in all the courts of the United States, * * *

"but shall not preclude reference to nor control in case of any discrepancy the effect of any original act as passed by Congress since the first day of December, eighteen hundred and seventy-three." It is not suggested that this language prevents reference to prior statutes where there is ambiguity or uncertainty calling for construction, but where the words have a plain and ordinary meaning it is not thought that reference should be made to acts prior to December 1, 1873, to create a discrepancy or uncertainty, especially as under section 5596 all earlier acts, any portion of which is embraced in 4887, are expressly repealed.

It is therefore submitted that there is nothing in the history of the legislation upon this subject which requires the Court to assume that Congress intended anything more or other than it said. Certainly the fact that the chairman of the Committee on Patents loosely and inaccurately stated the effect of the work of the revisory committee, or failed to understand it, affords no reason whatever why words not found in the act should be imported therein, or words found given other than their ordinary signification.

I come now to the language of the act. Suppose that that portion of section 4887, with which the revisers had nothing to do, had been passed by Congress as an independent act. It would have read about as follows:

"Whenever a patent has been granted by the United States for an invention which has also been previously patented abroad, the domestic patent shall be so limited as to expire at the same time with the foreign patent, or if there be more than one, at the same time with the one having the shortest term, but in no case shall it be in force more than seventeen years."

There would be nothing uncertain about this. It would be said that Congress had evinced a clear intention to have our people free of royalties at as early a date as any other people to whom the patent had been communicated became free.

This would be in accordance with the public policy of foreign countries, in many of which there is express provision by which this result is secured.

This Court, in Siemans *vs.* Sellers, 123 U. S., p. 276, held a domestic patent issued when the act of 1836 was in force limited in its term to fourteen years from the date of the sealing of the English patent, notwithstanding the fact that the domestic patent bore a later date, and the further fact that the act of 1861 declared "that all patents hereafter issued shall remain in force for the term of seventeen years from the date of issue."

Again, in Marsh *vs.* Nichols, 128 U. S., p. 605, it was held that a patent accidentally issued without the signature of the Secretary of the Interior was void, and that it was the completed patent grant that created the property interest in the invention. Under this decision it is difficult to understand how any vested rights are acquired by a mere application, and if there are none such acquired, it follows that a law making the domestic patent expire with the expiration of the earliest foreign one takes away nothing belonging to the patentee and cannot be considered either a punishment or a penalty. This is not germane, perhaps, to this case, as the patent in suit was applied for, both here and abroad, after the law had been put into its present shape. These cases make plain that the Court has not considered the date

of the application so all important as the complainants assume.

A construction favorable to complainants would make the last clause of section 4887 practically nugatory. In that case all inventors, both domestic and foreign, would first apply for a patent in the United States. It is known that delays longer than the life of most foreign patents are comparatively common. Sometimes these delays are caused by interference and sometimes not; sometimes the interferences do not represent real contests, but all sides are owned by the same interest. Delay is sought because the monopoly is adequately protected by other patents. It will be time enough to terminate these delays when the other patents are about to expire. Thus the monopoly becomes, in effect, perpetual, and the limited term contemplated by the framers of our Constitution, with the intention that thereafter the art should become free to the people, is rendered nugatory and our citizens are still under burdens when the discovery is free in every other country.

I have not referred to the circuit court decisions because I assume they will be fully cited by other counsel.

In conclusion, I submit that the plain language of the statute, as well as every dictate of public policy and prudence, require this Court to certify to the circuit court that the patent in question expired at the date of the expiration of the British patent, without reference to the date of the application, and that this Court should not afford relief which Congress itself has recently refused or failed to give when solicited by parties similarly situated.

CHARLES H. ALDRICH,
Counsel for Milo G. Kellogg.

Office Supreme Court, U. S.
FILED.
NOV 30 1894
JAMES H. McKENNEY,
CLERK.

157-1 157-1

Supreme Court of the United States.

BATE REFRIGERATING COMPANY,
Complainant,

against

FERDINAND SULZBERGER, *et al.*,
Defendants.

No. 687.

Observations upon the Brief submitted by Mr. Aldrich.

The undersigned have just received (November 22d, 1894), a brief filed by Mr. Aldrich in pursuance of the leave granted to him.

They assumed, when the Court called their attension to the application of Mr. Aldrich, that it was made by him as counsel for parties who had some actual litigation pending which might be affected by it. It was not supposed by them that applications would be made, or, at all events, entertained by the Court, to permit any citizen who might wish that the term of a patent should be abridged to intervene in the argument of a particular cause. It appears, however, from the brief in question, that Mr. Milo G. Kellogg, in behalf of whom it is filed, has no other interest in the case except such as he has in common with the public generally who may be affected by the existence of a patent.

The brief in question contains little, if anything, that is new in respect to considerations properly bearing upon the question of the interpretation of

the section. What are apparently intended as its important features are suggestions having no tendency to furnish any light upon the interpretation of the statute in question, but yet having a tendency, and apparently designed, to divert the attention of the Court from the legitimate function of interpretation.

A few observations only are needed by way of comment upon this brief:

First.—The first position taken in it is based upon a reference to the provision of the Constitution which gives to Congress the power "to pro- "mote the progress of science and the useful arts "by securing for *limited* times to authors and "inventors the exclusive right to their respective "writings and discoveries."

Apparently, the author of the brief understands by the term "limited times" that it is the duty of Congress from time to time to *limit*, that is, to *shorten*, the term for which patents are to be granted, and that whenever Congress undertakes to shorten a term, or whenever the Court undertakes by interpretation to make it shorter than it otherwise would be, it is obeying the constitutional injunction; and this view is illustrated by the statement that the writer does not doubt that "if "Congress should see fit at its next session to pass "an act limiting all patents thereafter granted to "the term of six years, it would be, or could be, "made, applicable to all pending applications." His view is that the performance by an inventor of the consideration contained in the offer of the Government to give a patent, namely, the making of the invention and the disclosure of it to the Government by an application for a patent, does not secure to the inventor any right whatever; but that it is com-

petent for Congress at its next session to enact that in the case of pending, as well as future applications, the term for which a patent shall be granted shall consist of but one year; and if it may do this, of course it may also enact that no patent at all shall be granted.

Without stopping to discuss the correctness of this extraordinary proposition, it is enough to say that Congress has never yet been guilty of the injustice of acting upon it. It is true, indeed, that the policy of the system of the patent law is not to heap rewards upon individuals, but to promote the progress of the useful arts; but it is also true that the *means* pointed out by the Constitution, and heretofore always adopted by Congress (unless the interpretation of the legislation in question in accordance with the defendants' view is correct, in which case an exception undoubtedly has been made) of gaining this end, is that of promising to inventors an exclusive right for a limited time to the benefits of their inventions, and *keeping* the promise when made.

Second.—A large part of the brief is embraced under the heading "The Practical Working of the Construction sought by the Appellant," and embraces a careful enumeration of certain patents, of which the American Bell Telephone Company is said to be the proprietor, and it is also said that if the Court should concur in the view of the complainant respecting the interpretation of the legislation in question, it will follow that these patents will be indefinitely extended and the rewards which that company has already received, which are also stated to be enormous, will be prodigiously increased, and the continuance of heavy burdens upon the public be indefinitely protracted. Similar results, it is said, will also follow in the case of a

patent, or patents, for incandescent lamps, and the Court is gravely requested to *infer* from the *names of the counsel* who have participated in the argument for the complainant that this suit is an effort by the proprietors of the patents referred to, to prolong their monopolies.

Those who wish to indulge in this form of argument do not generally presume to address it openly and directly to a judicial tribunal, but commonly seek the instrumentality of newspapers, as has also been done in relation to this case. The undersigned cannot help thinking that there is a measure of impropriety in the making of any answer by them to suggestions of this description; but, as they are addressed openly to the Court, they should not, perhaps, be passed wholly without comment. It ought to be enough to say that the alleged facts cannot be noticed by this Court in any manner whatsoever. They are not contained in the record, nor have they in the slightest degree that notoriety which charges every one with knowledge of them, and therefore makes them a subject of judicial notice. Are the undersigned to inquire whether these statements of fact are in any respect true? Neither of them has ever had any charge of the interests of the Bell Telephone Company's patents, or has ever been employed in any suit in which their patents were involved. Mr. Storrow has long been known to have been of counsel for that company, and doubtless knows and could state whether, and if all, to what extent, the American Bell Telephone Company would be affected by the decision in this case, but he is on the other side of the continent.

The undersigned, however, have made inquiries concerning the manner and extent in and to which the patents upon which the exclusive rights of the American Bell Telephone Company in the telephone business rest may be affected by a decision in this case; and from the information they have ob-

tained they feel justified in saying that each and all the statements in the brief of Mr. Aldrich to the effect that the Edison patents enumerated by him are fundamental, and that they, unless held limited by the expiration of patents issued in foreign countries, will enable that company to prolong its monopoly indefinitely, are wholly erroneous. And the statement or intimation in said brief that the Berliner patent therein mentioned had slept or was delayed in the Patent Office is also erroneous, the fact being that that patent was long involved in interferences in that office. And the undersigned are advised that the American Bell Telephone Company regards itself as being affected, if at all, only in a very remote and indirect way, by the question in this suit, and that it is, comparatively speaking, unimportant to that company how the present case is decided.

Should the Court regard the matters thus suggested in Mr. Aldrich's brief as material, or fit to be taken into consideration in the determination of the present question, it would, of course, not accept either the statements in newspapers, or in the briefs of counsel, but order an inquiry and ascertain what the real fact was.

This studied effort to create a prejudice in the Court will be dismissed with this observation only: that whatever effect a correct interpretation of the patent laws of the United States may have upon existing monopolies, whether to prolong them or to abridge them, must be accepted as the plain consequence of the law. The suggestion that thi Court should make the fact that, according as its decision may be one way or the other, patents owned by the American Bell Telephone Company, or any other corporations would be lengthened or abridged, a ground for making it one way rather than another, is one not fit to be made, and does not deserve to be answered; and those who make it dis-

play, by the very fact of making it, their want of confidence in any legitimate arguments which are at their disposal.

Third.—It is intimated or asserted in this brief that, if the interpretation insisted upon by the complainant were the true one, inventors themselves might employ the provisions of the patent law to delay the issue of the American patent; and that the change alleged by the defendants as having been effected by the revision of the Act of 1870 was adopted for the purpose of correcting that supposed evil. This argument has already been sufficiently answered, but we may, in addition, point to the languge of Mr. Justice Grier, in O'Reilly *vs.* Morse (15 How., 62–128), in which the same suggestion was made. To this he said: "It is a sufficient answer to say that, if such evil consequences "should be found to exist, it is for Congress to "remedy them by legislation."

Congress did, by an amendment first introduced by the Patent Committee of the House into this very revision of 1870, provide a distinct remedy for such supposed mischiefs, and, if it be not a sufficient one, it can be amended so as to be made sufficient.

Fourth.—This brief presses the view which was insisted upon on the part of the defendants upon the oral argument, that the rule to the effect that changes of language in revising statutes do not import changes of meaning, unless there is evidence that Congress intended a change, does not apply to Section 25 of the Act of 1870, for

the reason that it is conceded that Congress did in that section intend *some* change, namely, to abolish the preceding distinction as to the effect of foreign patents according as they might have been taken out within six months, or more than six months, prior to the application in this country. The undersigned have never been able to perceive the force of this suggestion. The rule referred to is that the change of language does not import a change of meaning *unless there is evidence that the legislature intended it.* In the case of the change in respect to the six months' limitation, there is the plainest evidence that Congress intended it. That evidence is gathered, in the first place, from the force of the language itself, which *compels* the conclusion that a change was intended, and in the next place from the circumstance that prior to that time the utility of this small distinction had been questioned and a reasonable motive, or one which Congress might have regarded as reasonable, is thus furnished for making the change. If it be meant that this conceded change is not consistent with Chairman Jenckes' statement in his oral report to the effect that the revisers' report of Section 25 made no change in the existing law, the force of this argument is not perceived. If that statement were regarded as incorrect in this particular, he none the less made it, and Congress must none the less be presumed to have relied upon it, and accordingly to have regarded Section 25 as simply re-enacting pre-existing law. But the statement was not in any just sense incorrect. The change thus effected was not a change in principle, or in substance, but in a subordinate detail. The provision of 1836, which after lifting the bar restricted the privilege of obtaining American patents to those who applied within six months, was designed to stimulate diligence and discourage delay. The provision of the statute of 1839, lifting the bar so as to include those who applied more

than six months after taking their foreign patents, was accompanied with a qualification of the patent issued in such cases, which was designed also to encourage diligence. When this distinction between these two divisions of one class was abrogated, and the shortening of the patent applied to all who made application in this country, after taking out a foreign patent, the object was still the same, and would have the same effect, namely, to encourage diligence. Whether the distinction between the two classes should be maintained or abrogated was a matter of small consequence, and related solely to a feature of administration. Of course Chairman Jenckes could not have intended to state anything which was incorrect. Whether the change was so slight that it failed to impress itself upon his memory, or was regarded by him as of such slight importance as not to make it needful to call the direct attention of Congress to it, is immaterial. The mere fact, however, that *some* change was made in one of the provisions of the section in question, to which attention was not called, has no tendency to show that, where the language of other provisions was changed, Congress intended a change of meaning; still less does the circumstance of a conceded change in a detail of little importance have a tendency to show that in a provision affecting the fundamental elements of the patent system a mere change of language must be deemed to have been designed to effect a change in meaning

The other matters in the brief of Mr. Aldrich call for no further attention than has been given in the briefs already filed.

JAMES C. CARTER.

C. E. MITCHELL,

Of Counsel for Complainant.

Office Supreme Court U. S.
FILED.
NOV 1 1894
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CLERK.

1894

Supreme Court of the United States.

BATE REFRIGERATING COMPANY,
Complainant and Appellant,

against

FERDINAND SULZBERGER ET AL.,
Defendants and Appellees.

BRIEF FOR APPELLEES.

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Solicitors.

EDMUND WETMORE
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Of Counsel for Appellees.

C. G. Burgoyne, Walker and Centre Streets, N. Y.

Supreme Court of the United States.

THE BATE REFRIGERATING COMPANY

vs.

FERDINAND SULZBERGER ET AL.

CERTIFICATE FOR INSTRUCTIONS FROM THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT.

STATEMENT.

Complainant filed a bill in the Circuit Court of the United States for the Southern District of New York to enjoin defendants from infringing certain letters patent for a process of preserving meats, *applied for* December 1st, 1876, *and issued* November 20th, 1877, by and to John J. Bate, and by Bate on the 23d November, 1877, assigned to complainant.

Intermediate application for and issue of the patent the proceedings in the Patent Office included an appeal to the Examiners-in-Chief as well as a subsequent contested interference with a patent to one Halsted. The grant of the patent was in terms for seventeen years.

The defendants filed certain pleas showing that after the filing of the application by Bate and before the issue of the patent to Bate two foreign patents were granted for the same invention, viz., one by England to one

Lake on a communication from said Bate of date January 29th, 1877, sealed July 13th, 1877, and complete specifications filed July 26th, 1877, for the term of fourteen years from date, the said invention being patented, or caused to be patented, by said Bate; and one by Canada to said John J. Bate, under date January 9th, 1877, for five years.

Both said foreign patents expired before the expiration of the seventeen years specified in the grant of the United States Patent to Bate, and before the filing of the bill herein.

The bill was filed July 25th, 1892, and prayed an injunction and account.

The pleas were set down for hearing, and on the hearing the bill was dismissed.

On appeal by complainant to the Circuit Court of Appeals that Court certified to this Court that it desired instruction on the question of law, "whether the invention for which the United States Patent aforesaid was issued to said John J. Bate had been previously patented in a foreign country," within the meaning of those words in Section 4887 of the Revised Statutes, and whether said patent expired under the terms of said section before the expiration of the term of seventeen years faom its date (Record, pp. 1 and 2).

POINTS.

First.

"The Revised Statutes must be treated as the legislative declaration of the statute law on the subjects which they embrace on the first day of December, 1873. When the meaning is plain the courts cannot look to the statutes which have been revised to see if Congress erred in that revision, but may do so when necessary

to construe doubtful language used in expressing the meaning of Congress."

U. S. vs. Bowen, 100 U. S., 508–513.
Edison vs. U. S. Co., 35 Fed. R., 134–138.

This last case quoted and applied the rule of the Bowen case to Section 4887, and held the meaning of that section to be plain and to accord with defendant's contention.

The language quoted from the Bowen case is not *obiter* or even mere reasoning. It is the very gist of the decision.

The Court held that effect must be given to the word "such," though that construction plainly made the statute differ from the statute which had been revised.

In King vs. Poor Law, 16 A. and E., 1, COLERIDGE, J., says: "It is, in my opinion, so important for the "Court, in construing modern statutes, to act upon the "principle of giving full effect to their language, and "of declining to mould that language, in order to meet "either an alleged convenience or an alleged equity, "upon doubtful evidence of intention, that nothing will "induce me to withdraw a case from the operation of "a section which is within its words but clear and un-"ambiguous evidence that so to do is to fulfill the "general intent of the statute, and also that to adhere "to the literal interpretation is to decide inconsistently "with other and overruling provisions of the same "statute."

In Newell vs. The People, 7 N. Y., 9–97, the New York Court of Appeals says:

"Whether we are considering an agreement between "parties, a statute or a constitution, with a view to its "interpretation, the thing we are to seek is *the thought* "*which it expresses*. To ascertain this, the first resort "in all cases is to the natural signification of the words "employed, in the order and grammatical arrangement in "which the framers of the instrument have placed

" them. If thus regarded, the words embody a definite " meaning which involves no absurdity and no contra- " diction between different parts of the same writing, " then that meaning apparent upon the face of the in- " strument is the one which alone we are at liberty to " say was intended to be conveyed. In such a case " there is no room for construction."

In Hadden vs. The Collector, 5 Wall, 107–111, this Court, through Mr. Justice FIELD, says:

" What is termed the policy of the Government with " reference to any particular legislation, is generally a " very uncertain thing, upon which all sorts of opinions, " each variant from the other, may be formed by dif- " ferent persons. It is a ground much too unstable " upon which to rest the judgment of the Court in the " interpretation of statutes."

If this were not the rule there would be no use or purpose in a revising statute.

The function of a revising statute cannot be better described than in the United States law providing for this revision, passed June 27, 1866 (14 Stat. at Large, 74).

That law made it the duty of the Commissioners " to 'bring together all statutes and parts of statutes which, from similarity of subject, ought to be brought together, omitting redundant or obsolete enactments, and making such alterations as may be necessary to reconcile the contradictions, supply the omissions and amend the imperfections of the original text.' 'And they shall arrange the same under titles, chapters and sections, or other suitable divisions and subdivisions, with head notes briefly expressive of the matter contained in such division; also with side notes, so drawn as to point to the contents of the text, and with reference to the original text from which each section is compiled, and to the decisions of the Federal Courts explaining or expounding the same, and also to such decisions of the said Courts as they may deem expedient.'" "'They shall also suggest to Congress such contradictions, omissions and imperfections as may ap-

pear in the original text, with the mode in which they have reconciled, supplied and amended the same' (Sec. 3)."

Counsel for complainant, Mr. Carter, in his brief in the Court below (p. 39), gave a somewhat fuller definition of the function of a revising statute. He said: "*What is* the *business* of *revising* statutes? It is the work of eliminating the repetitions and redundancies and reconciling the incongruities which have crept into the law chiefly by reason of its having been made the subject of legislative action at *different times* and for *different* purposes, as well as of simplifying language and putting the law into a clearer and more *accessible form*." (Italics ours.)

But the very purpose of a revision, as so stated, would be defeated were it incumbent upon every person reading or examining a revised statute, in order that he may act thereunder, to, in the first instance, examine to see whether there was any change of language from prior statutes; and, further, then to assume that if there were such change it meant no change of meaning; and, further, then to take upon himself the duty of investigating the whole field of the prior law and of judicial decisions thereunder, and coming to some conclusion as to what was intended and what was the true meaning of the prior law, which confessedly, by the mere fact of the existence of the revised statute, was in such a condition as to need a statute which should definitely and peremptorily put an end to the conflict and uncertainty and question existing in the prior law.

Statutes are not passed for the sole purpose of enabling acute lawyers to find out, by reference to the past, some meaning which is not obvious on the face of the statute. If the statute, upon its face, presents a fair and reasonable meaning, such as an ordinary mind would promptly and surely give to it, *that* meaning should be given to it by the Court. Otherwise a revision asks, from the public, action upon the faith that

the law means what it says, and then deceives the public by making the law mean something other and quite different.

The rule thus stated, becomes much stronger when we remember that the Revised Statutes are not a mere revision of the law.

They are a revision *and an amendment* of the law.

The title of the Act of 1870 which first dealt with the patent law is "An Act to revise, consolidate *and amend* the statutes relating to patents," and that act did *amend* the law by making undoubted changes in various important matters.

Some of these changes or amendments will be referred to under subsequent points.

Second.

The plain meaning of Section 4887 is that the term of any United States Patent is limited by the term of a foreign patent granted before the grant of, though subsequent to, the application for the United States Patent.

Applied to this case, the term of complainant's patent of seventeen years from November 1st, 1877, *i. e.*, until November 20th, 1894, is limited by the term of foreign patents expiring January 29th, 1891, and January 9th, 1882, respectively, which were granted before the grant of the United States Patent but after the application therefor.

So plain indeed is this meaning that so far as the language is concerned it seems impossible to suggest a doubt in respect to it.

"But every patent granted for an invention which has been previously patented in a foreign country" must mean patented in a foreign country before it was patented in this country, and cannot mean anything else.

Our opponents quote from a stenographer's report a question by the late Mr. Justice BRADLEY on the hearing of the case in New Jersey. "Previous to what?"

It would seem as if the report must be incorrect.

What possible doubt can there be? There is absolutely nothing else in the statute for the word "previously" to refer to than previously to the patent granted by the United States.

In the quoted stenographic report of what was said by Mr Justice BRADLEY it would seem to be intimated that the word "previously" might refer to the word "application," being the last word of the preceding sentence, and that this construction might be aided by making the punctuation after the word "application" a semicolon instead of a period.

Such a construction is impossible.

The clause of which the word "application" is the last word begins with the word "unless," and reads "unless the same has been introduced into public use in the United States more than two years prior to the application." It refers to "invention" and not to patent.

Under the old law there were two things which barred a patent. One was a prior publication, and, another, prior public use.

By Section 7 of the Law of 1836 it was provided that on the filing of the application, description and specification the Commissioner should make an examination, and that "if on any such examination it shall not appear to the Commissioner that the same had been invented or discovered by any other person in this country prior to *the alleged invention* or discovery thereof by the applicant, or that it had been patented or described in any printed publication in this or any foreign country, or had been in public use or on sale with the applicant's consent or allowance *prior to the application*," etc., a patent should issue.

The words "prior to the application" in that statute clearly refer to the public use.

Mr. Carter, on pages 30 and 31 of his brief for complainant in the Court below, concedes that they do so refer. Speaking of this statute Mr. Carter on page 30 says: "It made, however, the language not before known or used refer not to the date of the application, but to the date of the discovery; and it used other words to indicate that sort of possession by the public of a knowledge of the invention which should defeat the application, and referred these to the date of the application thus: 'And not at the time of his application for a patent in public use or on sale with his consent or allowance as the inventor or discoverer.'"

His language on page 31 is to the same effect.

Now, clearly, the word "application" in Section 4887 equally refers only to the bar of public use.

So far as the law of the effect of a printed publication or patent in a foreign country on the grant of a patent here is concerned Section 4887 of the Revised Statutes might as well have read without the clause "unless the same has been introduced into public use in the United States for more than two years prior to the application."

That clause refers to a different subject matter, to wit, the effect of a certain public use.

Exclude it then as we must do when considering the meaning of the rest of the section and I submit that human ingenuity is not equal to the task of suggesting any other meaning to the words "previously patented in a foreign country" than previously to the United States Patent.

If we eliminate that clause as referring to a different subject matter and as affording no aid in the solution of the pending question Sec. 4887 would read as follows:

"No person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, by reason of its having been first patented or caused to be patented in a foreign country. But every patent granted for an invention which has

been previously patented in a foreign country shall be so limited as to expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term, and in no case shall it be in force more than seventeen years."

This construction accords with and is required by the rules of grammar.

The adverb (previously) refers to the last preceding antecedent in the context.

To illustrate:

"We now sat down to dinner, which was almost cold; but *previously*, my arm still continuing painful, Sir William wrote a prescription."

"Vicar of Wakefield, Chapter XXX., where 'previously,' referring to the immediate antecedent, means 'before we sat down to dinner.'"

"A bill of this nature may be brought without the leave of the Court *previously* given."

Mitford, Eq. Pl., 84 (m. p.); *i. e.*,
given before the bill is brought.

"Those thoughts suggest each other which had *previously* constituted parts of the same entire or total act of cognition."

Sir Wm. Hamilton, Metaphysics, p. 435;
that is to say, which had constituted parts of the same cognition before they *suggested* each other.

A Pennsylvania statute provided "that it shall be lawful for the plaintiff, on or at any time after the third Saturday succeeding the several return days hereinbefore designated, on motion, to enter a judgment by default, notwithstanding an appearance by attorney, unless the defendant shall *previously* have filed an affidavit of defense."

Construed to mean that the affidavit may be filed any time before the *motion for judgment*, the last antecedent before "previously."

Gillespie vs. Smith, 13 Penn., 65.

Says the Supreme Court of New Hampshire, dis-

cussing a relative word: "The reference is to the antecedent next preceding the relative." And the Court adds: "Certainly, that must be the construction where there is any ambiguity in reference to the antecedent referred to."

Fowler vs. Tuttle, 24 N. Hamp., 22.

We submit, then, that there is no ambiguity. Where there is one plain, obvious meaning, leading to no absurdity, exhibiting no inconsistency, and which is criticised only on the ground that the provision, thus construed, is asserted to lead to results which are contrary to an alleged legislative policy, which is merely inferred from purely extraneous facts, that plain meaning cannot be disregarded. It would be a wide departure from the safe rules of statutory interpretation to disregard the first and obvious sense of the words because of an *inference* about which there can be no concurrence of opinion, and which will be differently drawn according to the interest of the parties that make it.

Third.

If we seek for aid in its construction outside of the statute itself, the history of the prior law demonstrates the clearness and precison of the revised statutes and the impossibility of giving to Section 4887 any other construction than the one above stated.

The first patent statute is that of 1790, 1 Stat. at Large, 109.

It provides that upon the petition of any person to the Secretaries of State and War and to the Attorney-General setting forth that he has invented any useful art, &c., not before known or used and praying a patent, therefore said officers or any two of them may cause

letters patent describing the invention, &c., to be made out and delivered to the Attorney-General, who shall within fifteen days, if he shall find the letters to conform to the act, so certify and deliver them to the President, who shall cause the great seal to be affixed and the letters patent recorded and *delivered* to the patentee.

Section 2 provides that the grantee of each patent shall, *at the time of granting the same, deliver* to the Secretary of State *a specification in writing containing a description*, &c., which specification shall be filed in the office of the Secretary to the end that the public may have the full benefit thereof after the expiration of the patent.

In 1793 a new statute was passed. It provided that when any person *being a citizen* shall allege that he has invented any new and useful art, &c., not known or used before the application, and shall present a petition to the Secretary of State praying an exclusive property therein, it shall be lawful for the said Secretary to cause letters patent to be made out giving "*a short description* of the said invention," &c., which letters shall be given to the Attorney-General who shall within fifteen days if he finds the same to conform to the act so certify and return the same to the Secretary of State, who shall record and deliver the same to the patentee.

By Section 3 of that act the inventor before he could "*receive*" his patent was required to deliver a *written description* of his invention in such *clear and exact terms* as to distinguish the same from all other things before known, which description was to be filed with the Secretary of State.

It will be noted that in both of these acts the *specification* was something other and different from the *petition for the patent*, and that though it might accompany the petition there was nothing in the act that required it to be filed or delivered *before the delivery of the patent*. Indeed, the acts seem to contemplate that

the specification shall be delivered contemporaneously with the patent and as the consideration therefor.

In Pennock vs. Dialogue, 2d Peters, 21-2, it was held that the words "before the application" in the Act of 1793 made clear what in the Act of 1790 was perhaps doubtful as to the time to which the word "before" in the Act of 1790 referred.

The time which was matter of possible doubt in the Act of 1790 was not, however, as in the case at bar, between the application for and issue of the patent, but was between the date of the invention by the patentee and the date of the application.

The Act of 1793 was the more rigorous statute, as it required that the invention should not be known before the date of the application.

The period of time between the application and the issue was not regarded as important.

It substantially was required not to exceed fifteen days. It might all be done in one day. It was regarded as practically cotemporaneous and doubtless was so.

While the statute of 1793 restricted its offer to *citizens*, the statute of 1800 (2d Stats., 37, 38) made its offers also to aliens of two years' residence, provided that they should make oath "*before such patent should be granted*" that the invention had not been known or used in this or any foreign country, and, that if it afterwards appeared that the invention had been used "previous to such application for a patent," the patent should be utterly void.

Here, again, the words "previous to such application for a patent" are intended to apply a rule or test more rigorous than the rule or test "known previous to the invention of the claimant."

No distinction was made, or was being made, as between the time of application and that of issue.

The application and issue might be exactly, and always were, practically contemporaneous, and no attention was paid to the possible few days' difference.

The Act of July, 1832, 4 Stat., 377, extended to aliens who had declared their intention to become citizens the right given by the law of 1800 to aliens of two years residence ; but provided that a failure to manufacture and introduce the invention should invalidate the patent.

The foregoing was all the patent legislation which can bear on questions herein to be considered prior to 1836.

It evidently was not framed with regard to foreign patents or with any intent to provide for them.

Foreign patents affected home patents under the statutes prior to 1836 precisely as foreign publications or knowledge affected home patents.

The law offered a patent only where, but for the disclosure of the patentee, the public would be without knowledge of the invention.

If that knowledge was open to the public by foreign publication or patent, no patent could be here obtained.

Under those laws the "consideration," the "*quid pro quo*," was wanting.

If such a thing as a "policy" can be talked of with respect to patent laws, which are really *contracts*, then we may say that it was the "policy" of those laws not to issue a patent for an invention which had already been patented abroad.

That unquestionably was their *effect*, and if we talk of policy, it must have been their policy.

Patent laws, however, are essentially contracts. The Government on the one side offers a certain monopoly to those who will comply with certain conditions.

Upon such compliance the contract is complete, and the patent laws must be construed as contracts.

> Pennock vs. Dialogue, 2d Peters, 23, "no *quid pro quo*."

"For a valuable consideration the public give him for a limited period the profits arising from the sale" (7 Peters, 320).

In Nielson vs. Harford, 1 Web. Pat. Cas., 331, ALDERSON B., citing Lord ELDON, says :

"Lord ELDON lays down the principle so long ago as 1800. He says patents are considered as *bargains* between the inventor and the public, to be judged of on the principles of good faith by making a fair disclosure of the invention, and *to be construed* as other bargains. That is the principle which must be taken to be sound principle."

And in Gibson against Campbell, 1 *Web.*, 627, TINDALL, C. J., says (p. 629) :

The specification * * * is the *price* that the man who takes out his patents pays to the public. * * * Therefore, every man who is an honest man is bound to pay that *price* justly and fairly.

"But it should always be remembered that in the grant of a patent privilege as now understood *a contract* takes place between the public and the patentee, * * * *to be construed* in all its essential features of a bargain, like other *contracts* to which there are two parties."

Curtis on Patents, Section 23.

"Patent law as such * * * relates only to the *contract* character of the patent privileges, and forms one branch of the law of contracts."

Robinson on Patents, page 61.

In a reply to our brief below, Mr. Carter, of counsel for complainant, agreed with us that a patent is a contract, and thus expressed himself: "The very gist of the patent law is that it constitutes a standing offer, which ripens into a contract" (p. 17).

Considered, therefore, as contracts for monopolies, the statutes above quoted offered no contract to any one who had taken out a foreign patent.

Considered as stating a policy the statutes excluded the idea of a policy to foster, encourage or allow the taking out of foreign patents before home patents.

The question whether if foreign patents had been at all considered the period when they should have effect on home patents would have been the time of application or of issue is of course not solvable.

As there was no examination and no delay in the issue of a patent, there was no practical difference between the two dates and the question would have been unimportant.

The time most probably would have been the same as the *filing of the specifications* and the *issue* or *delivery* of the patent which the statutes seem to have contemplated would be cotemporaneous.

This concludes what may be regarded as the first period of the patent statutes.

(b) The second period of the patent statutes commences with the statute of 1836.

5 Stat. at Large, 117.

This statute provided a new system. It required an examination of a claimed invention by experts and their decision as to novelty and merit before a patent could issue, and in it was first made a provision as to the effect of the existence of foreign patents.

By Section 6 of that act the inventor could apply in writing for a patent.

Such application did not necessarily contain a *specification*, for it was in said section further provided: "But before he shall *receive* a patent he shall deliver a written description of his invention."

This law therefore *retains* the distinction existing in the prior laws between the application or petition and the specifications, and in order to retain the distinction uses the same word, "*receive*," used in the statute of 1793.

By Section 7 the Law of 1836 provided that on the filing of such application, description and specification the Commissioner should make an examination, and that, "if *on any such examination* it shall not appear to the Commissioner that the same had been invented

or discovered by any other person *in this country* prior to the alleged invention or discovery thereof by the applicant, or that it had been *patented* or described in any printed publication in this or any foreign country, or had been in public use or on sale with the applicant's consent or allowance *prior to the application*," if the Commissioner shall deem it to be sufficiently useful and important, it shall be his duty to issue a patent therefor. "But whenever *on such examination* it shall appear to the Commissioner that the applicant was not the original or first inventor or discoverer thereof, or that any part of that which is claimed as new had before been invented or discovered or *patented* or described in any printed publication in this or any foreign country as aforesaid" he shall notify the applicant and give him an opportunity to withdraw or amend or appeal, &c.

This law provides three bars to a patent.

1st. If the invention had been invented or discovered by any other person in *this country prior to the alleged invention* or discovery by the applicant.

2d. If the alleged invention had been patented or described in any printed publication in this or any foreign country.

3d. If the invention had been in public use or on sale with the applicant's consent or allowance prior to the application.

The time in the first bar referred to is the date of the invention by the applicant.

The time in the second bar referred to is the date or time of the issue of the patent or the close of the examination which immediately precedes the issue of the patent.

The time of the *third* bar referred to is the date of the application.

And that this date of the application in this statute limits only the third bar and not the others our opponents in the court below, as we have seen, conceded and asserted (see *ante*, Point 2d).

If, under this 7th Section of the Law of 1836, it appeared on the examination that at that time, viz., the time of the examination, the invention had been patented in a foreign country, the applicant could obtain no patent.

And the time of the examination is the time of the issue of the patent, for it could only be said when the examination was finished that it did not appear on the examination that the invention had been patented, and when it did not so appear the applicant was entitled to his patent.

Thus under Section 7 of the Act of 1836 the existence of a foreign patent at the time when, but for such foreign patent, the applicant would be entitled to a home patent, prevented the issue of the home patent.

This result, however, was qualified by Section 8 that "nothing in this act contained shall be construed to deprive an original and true inventor of the right to a patent for his invention by reason of his having previously taken out letters patent therefor in a foreign country, and the same having been published at *any time within six months next preceding the filing of his specifications and drawings.*"

It is not six months *prior to his application, but* to his *specifications and drawings.*

As we have seen, specifications and drawings might accompany the application and might not. The only provision of the statute was that they must precede the *receiving* the patent by the inventor and inferentially that they must precede the examination.

So soon as they are filed, the examination must be made, and when made, the patent must be awarded or refused.

Practically and substantially, therefore, under this act, the right to a patent depends upon the existence of

a foreign patent not more than six months before the *issue* of the home patent; for the filing of the specifications might be long after the application and but just precede the issue of the patent.

If the foreign patent was subsequent to the application and more than six months prior to the filing of the specifications it was a bar.

The distinction between the application and the specification in the Act of 1836 is recognized in Sec. 6 of Chapter 45, Laws of 1837, 5 Stat. at Large, p. 193, providing for the issue of the patent to assignees, "the *application* therefor being duly made and the specifications duly sworn by the inventor." It is further illustrated by Sec. 32 of the Law of 1870, "that all applications for patents shall be *completed* and prepared for examination within two years after the filing of the petition," and was pointed out by Judge NIXON in Bate vs. Gillette, 13 Fed. Rep., 55, "made the date of the filing of the *specifications* and drawings, in *the one case*, and the date of *the application for* the home patent, *in the other*."

In 1839 a further provision as to foreign patents was made.

It provided "that no person shall be debarred from *receiving* a patent for any invention or discovery * * * by reason of the same having been patented in a foreign country more than six months prior to his application. Provided that the same shall not have been introduced into public and common use in the United States prior to the application for such patent, and provided, also, that in all cases every such patent shall be limited to the term of fourteen years from the date or publication of such foreign letters patent." The "bar" referred to is, of course, that of Secs. 6 and 7 of the Act of 1836, qualified only by Sec. 8 of that act.

These two statutes of 1836 and 1839 certainly did recognize the propriety of giving a patent to an

inventor who had previously taken out a foreign patent.

Why the United States should give a patent to an inventor, probably a foreigner, who, through a foreign patent, had already disclosed his invention, is not at first apparent.

The inventor, under such circumstances, can give nothing for the monopoly. It seems a unilateral contract.

It seems a grant by the United States without any consideration, and it is difficult to conceive why, on sound principles, the thing should be done at all.

There could possibly be but one purpose in thus offering the monopoly of our patent laws to an inventor who had taken out a foreign patent.

It must have been in order to induce the inventor to introduce and use his invention here.

The time of foreign and domestic patents, at least in England (14) and France (15), was then substantially the same as our own.

The offer to inventors made by these Laws of 1836 and 1839 was that if the inventor came here substantially at the same time that he went to foreign nations we would give him a patent running substantially the same time.

We would not do this if he delayed coming here, because if we did our patent would continue to exist after the foreign patent had run out, and our own citizens would thus be placed at a disadvantage.

In order to do this, the filing of the specifications being a date on which the patent might issue was fixed upon by the Law of 1836 as the date from which to calculate the six months before which the taking out of a foreign patent would bar a domestic patent.

The offer of Sec. 6 of the Law of 1839 was made for the same reason and with the same purpose as that of the Law of 1836, viz., to induce the inventor to make public and to *use* his *invention* here at the earliest

moment, and to make sure that when the invention was free abroad it should be free here.

If the invention was already in use here we would not buy it—would give the inventor no monopoly.

If not in use here we would buy, but we would give a term to commence from the date of publication of the foreign patent.

We thus avoided putting our own citizens at a disadvantage while offering inducements to early patenting and using here.

In neither of these statutes was it secured that our patent should expire exactly at the same time with the foreign patent.

By the law of 1836, if the foreign patent was granted not to exceed six months before the filing of the specifications and drawings it would not affect our patent at all.

By the law of 1839, if the foreign patent were granted more than six months before the application for our patent the date of the foreign patent fixed the date from which our patent commenced to run its term of fourteen years.

The point or gist of each law was as to what we would give for an invention which our citizens could obtain for nothing because of the foreign patent, but which the inventor would probably not only patent, *but introduce into use here*.

This condition of the law remained until 1870. Meantime the law for revising and amending the statutes of the United States had been passed and the Act of 1870 was the result.

When the revisers assumed the duty of revising and amending, so far as the patent laws and foreign patents were concerned, this problem presented itself to them.

Under the then law a foreign patent might affect a contemplated United States Patent in three different ways:

1st. If the foreign patent were granted less than six months before the application and more than six

months before the filing of specifications and drawings, neither Sec. 8 of the Law of 1836 nor Sec. 6 of the Law of 1839 would apply, and the case would be governed by the general rule of Sec. 7 of the Law of 1836, and the foreign patent would be a bar.

2d. If the foreign patent were granted *more* than six months before the application, the fourteen-year term of the domestic patent would commence to run at the same time with the publication of the foreign patent.

3d. If the foreign patent were granted less than six months before the filing of the application, and within six months before the filing of the specifications and drawings for the domestic patent the foreign patent would be without effect, and the domestic patent would issue for the term of fourteen years from its date.

We here cite the several provisions of law:

ACT OF 1836, SEC. 7.

"If on any such examination it shall not appear to the Commissioner that the same had been invented, * * * or that it had been patented or described in any printed publication in this or any foreign country, * * * or had been in public use or on sale with the applicant's consent or allowance prior to the application it shall be his duty to issue a patent therefor."

ACT OF 1836, SEC. 8.

"But nothing in this act contained shall be construed to deprive an original and true inventor of the right to a patent for his invention, by reason of his having previously taken out letters patent therefor in a foreign country, and the same having been published at any time within six months next preceding the filing of his specifications and drawings."

ACT OF 1839, SEC. 6.

"That no person shall be debarred from receiving a patent for any invention or discovery * * * by reason of the same having been patented in a foreign country more than six months prior to his application, provided that the same shall not have been introduced into public and common use in the United States prior to the application for such patent, and provided also that in all cases every such patent shall be limited to the term of fourteen years from the date or publication of such foreign letters patent."

The printed House Bill, supposed to show the law as it was and the proposed changes by enclosing in brackets the part proposed to be omitted, and printing in italics the proposed additions, was as follows:

"No person shall be *debarred from receiving* a patent for his invention or discovery by reason of his having first patented it in a foreign country; provided the same shall not have been introduced into public (and common) use in the United States prior to the application, and that the patent shall (be limited to seventeen years from the date of publication of the foreign patent) *expire at the same time with the foreign patent, or if there be more than one at the same time with the one having the shortest term, but in no case shall be in force more than seventeen years.*"

The problem was so to revise and amend the law in respect to what term of monopoly or patent would be offered to an inventor who had taken out a foreign patent as to provide a single rule or provision applicable to all cases.

The old law by means of the different statutes contained several rules.

The question was, which one of the old rules or what new substitute for them all to adopt and how to express the rule so adopted.

Complainant herein claims that the rule or provision intended by the revisers was that the foreign patent

should be a bar only when issued before the *application for* the home patent.

Now, on examination of the Law of 1839, Section 6, we find that it expresses that precise rule if we leave out the words "more than six months." The statute reads:

ACT OF 1839, SEC. 6.

"That no person shall be debarred from receiving a patent for any invention or discovery * * * by reason of the same having been patented in a foreign country *more than six months* prior to his application, provided that the same shall not have been introduced into public and common use in the United States prior to the application for such patent, and provided also that in all cases every such patent shall be limited to the term of fourteen years from the date or publication of such foreign letters patent."

Leave out the words in italics, "more than six months," and *retain* the words "prior to his application," and the meaning claimed by plaintiff is clearly expressed.

Now, is it a thinkable proposition that if the revisers and Congress had intended to make the foreign patent a bar only when it existed prior to the application they could have supposed that they attained that object by leaving out the words "prior to the application," as well as the words "more than six months."

Is it not perfectly obvious that, by leaving out only the words "more than six months," one rule is established; while, by leaving out the words "more than six months prior to the application," another rule is established?

The words "prior to the application" are used twice in Sec. 6, Act of 1839—once with reference to a foreign patent and once with reference to use. They are not only words of the greatest importance—but evidently deemed by the draughtsman and by Congress to be of the greatest importance.

Can it be imputed to any one that they thought that they would express the meaning of these words in the statute, not by the use of *other* words—but by simply leaving them out?

Would not *revisers* retain such brief and simple words of the old statutes to express the same meaning in the new and revised statute *if* they so intended?

It must be remembered that when the revisers undertook this work of revision the law presented an extreme instance of the "incongruities" which Mr. Carter says that it is the "*business*" of a revision to reconcile.

It must have been considered by the revisers and by Congress that there was and could be no reason why the three several rules which we have shown then existed as to the effect of the existence of a foreign patent should continue to exist.

The rules were very different. No reason could be imagined for their continued concurrent existence. One of them or some new one should be devised which should apply to all cases.

The "incongruities" existing in the prior acts were incongruities as to the *time* when the existence of foreign patents should bar or affect home patents.

The words "prior to the application" were important, and had become, as it were, words of the art of drawing patent statutes. They had been used for one purpose or another since and including the Act of 1793, excluding, however, any effect of foreign patents until the Act of 1839.

They had been used in the statute of 1800 and 1836 with reference to the effect of public use.

The importance of using them in a new and "incongruity reconciling" statute, if their meaning were intended, could not have been overlooked.

Leaving them out or keeping them in clearly presents two different meanings, and the revisers and Congress deliberately leave them out.

It is not a case of "simplifying language and put-

ting the law into a clearer form" (Mr. Carter below, p. 39).

No language could be simpler or clearer than the words "prior to the application."

The change is by leaving out these words—by leaving out the limitation.

And after Congress has, *ex industria*, left out the limitation, the complainant asks the Courts to "read it in."

(c) It will be noted that Section 25 of the Act of 1870 is essentially quite as much an amending as a revising law.

It is as follows:

"No person shall be debarred from receiving a "patent for his invention or discovery, nor shall any "patent be declared invalid by reason of its having "been first patented, or caused to be patented in a "foreign country; provided, the same shall not have "been introduced into public use in the United States "for more that two years prior to the application, and "that the patent shall expire at the same time with "the foreign patent, or, if there be more than one, at "the same time with the one having the shortest term; "but in no case shall it be in force more than seventeen "years."

This section introduced several noteworthy changes.

It still allowed an inventor who had obtained a patent for his invention in a foreign country the privilege of thereafter obtaining a patent for the same invention here, but it altered the conditions upon which the American patent, in such case, was granted.

First. It altered the condition as to prior public use, and relieved the inventor from the restriction imposed by the Act of 1839, that the invention should not be in public use at *any time* before his application and placed the patent on the same footing as all others in that respect, so that it could only be defeated by public

use for *more than two years* prior to his application.

SECOND. It altered the limitation of the term of the American patent for an invention previously patented in a foreign country. Instead of placing that limit at *fourteen*, subsequently changed to *seventeen*, years from the date of any foreign patent granted prior to the application (De Florez vs. Raynolds, 17 Blatchford, 437), it was provided that the American patent should be limited so as to *expire at the same time with any foreign patent* granted at any time before the *grant* of the American patent.

In some instances the new limit would give the inventor a shorter term for his American patent; in some instances it would give him a longer term.

The effect of the former fixed limit of fourteen or seventeen years from the date of the foreign patent was necessarily to abridge the term of the American patent, to a greater or less extent, in every instance; the effect of the limit fixed by the Act of 1870 might, or might not, abridge the term of the American patent. If the prior foreign patent was in a country like Spain, where the term allowed is twenty years or more, the provision that both patents should expire at the same time would, in most cases, operate to prolong the American patent; and, hence, the proviso is inserted, that in no case shall the American patent remain in force over seventeen years.

The effect, or the reasons for the change, however, are not here under discussion. What is insisted upon is that, without, for the present purpose, considering *why* the Legislature wished by the law of 1870 to change the prior laws in the points above mentioned, the fact is that it *did* change them.

The changes in language between the provisions of the said former statutes and the Act of 1870, consisting of omissions, additions and modifications, are self-evident and radical. It needs but the briefest comparison between Section 6 of the Act of 1839 and Section 25 of

the Act of 1870, such as is exhibited in the following parallel, where the significant changes are noted in italics, to make this evident:

Section 6, Act of 1839.	Section 25, Act of 1870.
That no person shall be debarred from receiving a patent for any invention or discovery * * * by reason of the same having been patented in a foreign country *more than six months prior to his application*; provided that the same shall not have been introduced into public and common use in the United States *prior to the application for such patent*; and provided, also, that in all cases every such patent shall be limited to the term of *fourteen years* from the date or publication of such foreign letters patent.	No person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, by reason of its having been *first patented*, or caused to be patented, in a foreign country; provided the same shall not have been introduced into public use in the United States for more than *two years* prior to the application, and that the patent *shall expire at the same time with the foreign patent*, or, if there be more than one, at the same time with the one having the shortest term; but in *no case* shall it be in force more than *seventeen years*.

The Act of 1870 was not a mere codification or revision of existing laws. It was, in accordance with its title, "An Act to revise, consolidate *and amend* the statutes "relating to 'patents and copyrights.'"

It amended the law by changing it in a number of particulars, conspicuous instances of which are indicated by the foregoing parallel. Among those changes it altered the term of the limitation imposed by the existence of a foreign patent from a *uniform, fixed term*

of years, calculated from the date of the foreign patent, to a *varying* term of years, depending upon the length of the terms of one or more foreign patents, and, in calculating such term, took into account all foreign patents issued before the *grant* of the American patent, instead of those only which had been issued *more than six months before the application*, as had been the case when a uniform term was to be calculated under the former law.

By what right is it to be assumed that the first part of this amendment was intentional, and the last part unintentional?

The Acts of 1836 and 1839 used the explicit terms "preceding the filing of the specifications and drawings," and "more than six months prior to his application," while the Act of 1870 omits these most important words, and adopts in lieu of them the new and significent phraseology "first patented or caused to be patented in a foreign country," and "previously patented in a foreign country." Does this *omission* mean nothing? Do the *new terms* employed to designate the period anterior to which the patenting of the invention in a foreign country limits or may limit the term of the American Patent mean nothing?

In considering this change of phraseology, the following fact may be noted:

The phrase "*before the application*," or its equivalent, "*at the time of the application*," was used in Section 1 of the Act of *1793*, in Sections 6, 7 and 15 of the Act of 1836, and in the first proviso of Section 6 of the Act of 1839, always with reference to the knowledge or use which would bar an applicant's right to a patent.

In Section 6 of the Act of 1839, it was used with reference to foreign patents taken out prior to the application.

Thus, with reference to prior knowledge or use of an invention, the phrase, in some form, had been used five times in the legislation prior to 1870, and twice with reference to prior foreign patents.

In the Act of 1870 the employment of the phrase was still continued with reference to prior knowledge or use of an invention; but it was *discontinued* with reference to prior foreign patents.

Why was it retained in one case and omitted in the other?

Can any reason be assigned for the distinction, except that in one case the law was to continue as before, and in the other case it was to be changed; and, if the law was to be changed in one case, the language must of necessity be changed, and was in fact changed in regard to foreign patents? Can it be for a moment maintained, in the face of all these facts, that this change was a mere capricious variation of phraseology signifying nothing?

The established rule of interpretation in such cases is that an obvious change indicates an *intention* to change. Where an amendatory act is passed, like the Act of 1870, its omissions and substitutions that create a change, if the words be taken in their ordinary signification, must be held to import such a change.

The Supreme Court has applied this rule to other sections of this very Act of 1870, and in instances analogous to the one at bar.

In *Andrews vs. Hovey* (123 U. S., 267; 124 U. S., 694), the complainant contended that, under the Act of 1839 (Sec. 7) a patent could not be defeated by two years' public use or sale of the invention, before the application was filed, unless such use or sale was "with the applicant's consent or allowance."

Sec. 6 of the Act of 1836 had provided for the issue of a patent to an inventor for an invention not known or used by others before his invention or discovery thereof, "and not at the time of his application for a patent in public use or on sale *with his consent or allowance* as the inventor or discoverer."

Section 7 of the Act of 1839 provided:

"That every person or corporation who has, or shall

" have, purchased or constructed any newly invented
" machine, manufacture or composition of matter, prior
" to the application of the inventor or discoverer for a
" patent, shall be held to possess the right to use, and
" vend to others to be used, the *specific* machine, manu-
" facture or composition of matter so made or pur-
" chased, without liability therefor to the inventor or
" any other person interested in said invention ; and
" no patent shall be held to be invalid by reason of
" such purchase, sale or use prior to the application
" for a patent as aforesaid, except on proof of abandon-
" ment of such invention to the public ; *or that such*
" *purchase, sale or prior use has been for more than two*
" *years prior to such application for a patent.*"

The complainant contended that the condition of the applicant's " consent or allowance," although not reproduced in terms in the Act of 1839, really was there by legislative intent. The Supreme Court, although they found that Section 7 of the latter act " was intended as an amelioration in favor of the inventor " (as regards the public use or sale necessary to work a bar) " of the strict provisions of the Act of 1836," decided, nevertheless, that the words, " consent or allowance," found in the earlier act, but omitted from the new act, could not be put into the latter by judicial interpretation.

The case of *St. Paul Plough Works vs. Starling* (127 U. S. 376), is also instructive in respect to the effect to be given to the changes of phraseology in the Act of 1870, and the Revised Statutes. In that case, Section 56 of the Act of 1870, and Section 699 of the Revised Statutes were under consideration. By the Acts of 1836 and 1861, it was provided that appeals might be had to the Supreme Court, without regard to the amount involved, in all " actions, suits, controversies and cases " arising under any law of the United States, granting " or confirming to inventors the exclusive right to

" their inventions or discoveries." Section 56 of the Act of 1870, re-enacted in Section 699 of the Revised Statutes, in defining such appeals, changed the phraseology, and used the words " in any action, suit, controversy or case, at law or in equity *touching patent rights*."

Mr. Justice GRAY says, in delivering the opinion of the Court, that the substitution of the new phrase " touching patent rights " " must be supposed " to have been made "*purposely*," and that whether or not the case " should be considered as '*arising under*' the pat- " ent laws of the United States "—a question not before the Court—" it is sufficient for the decision of " this motion, that " it " is 'a case *touching patent* " *rights*,' and, therefore, within the appellate jurisdic- " tion of this Court under Section 699 of the Revised " Statutes " (p. 378).

Applying the rule of interpretation illustrated and enforced in the authorities just cited, we submit that the law of 1870 introduced a distinct change, and adopted a new standard for calculating the limitation to be applied in case of a patent for an invention previously patented in a foreign country.

The Revised Statutes did not alter the law in this respect. Section 4887 substantially re-enacts Section 25 of the Act of 1870. The only difference is that by breaking up the section into two paragraphs, and adopting the clear and emphatic language: " But every patent *granted* for an invention which has been *previously* patented in a foreign country shall be so limited," *etc.*, the revisers evinced their understanding of the law and their purpose to place the meaning beyond doubt, and to remove any possible misconception as to the intention which the words were designed to express.

We, therefore, respectfully insist that, whether the change from the date of the application to the date of the grant, as the controlling date with reference to

which prior foreign patents shall or may limit the term of the American patent, be wise or the contrary, whether it be in the interest of the public or of the inventor, whether it helps some interests or hurts others—the change is *there*. It cannot be ignored. It cannot be avoided without interpolating what the Legislature has *not* said and disregarding what it *has* said. The language leaves no room for reasonable doubt, and judicial interpretation can only carry into effect the change which its plain meaning imports, and leave the consequences to be dealt with as the Legislature may see fit.

(a) Nor is there any so-called "policy of the law" which supports or will admit of any other constructions.

If the *policy* of the act be considered, *any* policy which it may be reasonably supposed it was intended to carry out, will be *better* carried out by limiting American patents by the terms of foreign patents issued prior to the *grant* of the American patents, rather than by the terms of foreign patents issued prior to the *application* for the American patents; in other words, by the construction of Section 4887 contended for by defendants, instead of by that contended for by the complainant.

It must be remembered that from the inauguration of our patent system a foreign patent was a bar to a home patent unless and by virtue of some exception to that rule affirmatively stated in the Acts of 1836 and 1839. What then were the reasons or "policy" for those exceptions?

1. Under Section 4887, every patent for an invention previously patented in a foreign country expires at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term.

The result is that the invention, in such cases, becomes free here as soon as it is free abroad; but this is said to be a foolish and inadequate reason for the

statute, because, in the case of inventions patented here which are not patented abroad at all, as well as in case of those which are patented abroad subsequently to the American patent, but for a short term only, the invention becomes free abroad before it is free here, and no provision is made for these cases; hence it is concluded, there can be no general policy that inventions should be free here as soon as free abroad, or there would not be such omissions in the law, and that such a supposed policy can afford no reasonable ground for accounting for its application to one set of cases alone.

But this conclusion will not bear examination.

There is no reason for assuming that because an invention is patented and used here, it will become known and used in foreign countries, or *vice versâ*.

A prudent person will not invest money in the introduction, manufacture or sale of an invention in this country which is patented abroad but not yet patented here, since, before two years have elapsed, the invention may be patented here and the investment lost; and the same thing applies in various foreign countries to inventions patented here but not patented abroad. No prudent person would invest in the development of an American invention in a foreign country until it was protected by a patent. Indeed, there is small prospect of profit in introducing an unpatented invention which is already patented elsewhere, and, therefore, cannot be kept secret.

While, therefore, theoretically, an invention patented here but not patented abroad is free abroad while it is under monopoly here, yet it is a freedom which in ordinary cases would be availed of in such rare instances that the circumstance is one of no practical importance.

The case of inventions patented both here and abroad, however, is very different. That course is only taken in regard to inventions which, it is *expected*, will

go into use in all the countries where it is patented. It is a course taken in regard to inventions which are believed to possess importance and a special utility such as will lead to their adoption in more countries than one, and while these expectations are often disappointed, yet, in those cases in which they are fulfilled, the inventions are usually of great value and often relate to articles of necessary public convenience —such as the essential inventions relating to the telephone, which have been patented the world over.

Now, it is perfectly reasonable that Congress, legislating in reference to this class of patents, should have intended that if an invention was of importance enough to be patented both here and abroad, it was an invention that should be made free to the American public so soon as it was free to the public abroad.

It may be that this provision does not reach every *possible* case in which an invention is patented here while it is free abroad, but it reaches every case of the kind which it is *practicable* for the law to reach, and reaches the cases of the kind which it is most *important* to reach.

We say it reaches all the cases here which it is *practicable* to reach. The only ones which it does not reach are: *first*, inventions patented here which are *never* patented abroad, and *second*, inventions patented abroad *after* they are patented here.

As to the *first* case, it is plain that it is beyond the reach of legislation. It would be impossible to provide that an American patent should cease or be limited because of the fact that the invention had gone into use in a foreign country where it was free of the monopoly. The mere suggestion of such legislation reveals its impracticability. It would make the term of the American patent depend upon a subsequent event, difficult of proof and utterly uncertain in character.

Nor is the difficulty removed in the *second* case. To attempt to prescribe a limit to an American patent by any foreign patent which might be taken out *subsequently* to its grant would virtually deprive all American patents of nearly all their value, for no one could tell at the time of its grant how long any such patent would endure. It might be patented abroad in many different countries. It would be difficult in many instances, for the owner of the patent to ascertain at any given time whether it was in force or not; whether it had not already been terminated by the expiration of some foreign patent, or whether it was not limited by some such patent; and, if it was ascertained that such was the fact, the limit might, at any moment, be changed by some new foreign grant. The inconvenience of such a provision would be intolerable. It would introduce an element of uncertainty as to the length of the term of every patent granted under our statutes that could not be removed, and would so impair the value of the monopoly as largely to defeat the very object which the patent laws were intended to promote.

Therefore, it was impracticable to limit an American patent by any foreign use if the invention was never patented abroad, or by any foreign patent issued after the grant here.

Congress did all it could. It provided that every patent granted here for an invention previously patented abroad should be subject to limitation by any foreign patent issued up to the time of such *grant*, because the limitation thus imposed did not prevent the American patent from having a *fixed* term, and the event by which it was fixed was capable of ascertainment without great difficulty, and usually without any difficulty at all.

2. Thus far, we have mentioned the policy of securing the free use of the invention here, as soon as it was free abroad, as based upon the theory that the foreign public

should not be favored at the expense of, or, at least, should not be more favored than, the American public, but there is another reason for this policy quite independent of any idea of discrimination in favor of the foreign public. It is this:

Why was the term of a patent monopoly limited at all? Why were not an inventor and his heirs empowered to collect a perpetual royalty for the use of his invention, or to maintain his exclusive right in it forever? Why do not patents run for fifty years in this country, instead of only seventeen?

Plainly because Congress deemed seventeen years a sufficiently long exclusive monopoly to enable the inventor to obtain a reasonable compensation for bestowing his invention upon the public. A seventeen-year monopoly was regarded as a fair price for any invention. If the invention is valuable the exclusive right for that length of time is a correspondingly valuable privilege. In case of a small improvement, the value of the monopoly will, of course, be a smaller sum; in case of an invention of the first importance, like that of the telephone, the monopoly may yield many millions of dollars.

The granting of a patent is, in effect, a purchase of the disclosure of the invention from the inventor for the benefit of the public, and, as it is given upon moderate terms, it serves as a stimulus to invention and, as the statute expresses it, to "promote the useful arts."

A monopoly of seventeen years in this country is, therefore, taken as a fair consideration for the public to give the inventor for his invention, *when he takes out a patent in this country alone.*

Now, if when asking a monopoly for his invention in this country, the inventor has taken advantage of the patent laws of foreign countries to secure for himself a monopoly for the same invention abroad, it is natural, just, equitable and proper, that, because of this

circumstance, a less price should be given by the American public.

When this state of affairs exists, if a patentee is enjoying a monopoly in this country, worth, say, twenty thousand dollars a year, and is also enjoying monopolies in England and France which together are worth to him, say, another twenty thousand dollars a year, it is perfectly fair and true policy that his monopoly should not run so long in this country as if this country was the only one to which it extended.

The provision of law which limits all American patents so that they expire at the same time with any previously granted foreign patent is an entirely fair method of obtaining such an allowance for the benefit of the American public, where the patentee is, as a matter of fact, enjoying a much broader monopoly than he would enjoy if his invention were patented in this country alone. It in no way abridges his right to patent his invention abroad if he is a citizen of this country, or, if a citizen of a foreign country, from procuring a patent here; and it imposes on both classes of inventors alike a restriction that their monopoly shall, as a rule, terminate sooner than if they had been content with an American patent alone; but such restriction is just and equitable, because by virtue of their plurality of monopolies they sooner receive an adequate compensation for disclosing their invention to the public for whose benefit the patent laws were primarily enacted, and who are, therefore, entitled to a corresponding earlier free use of the invention.

3. Another reason, and the most important of all, for limiting the term of an American patent for an invention previously patented abroad is that it encourages inventors to take out their patents here first, even if they contemplate patenting in other countries.

The primary object of our patent laws being the public interest, and to obtain for the people of *this* country the early knowledge and opportunity to take

advantage of useful inventions, it is desirable that such inventions should be patented as early as possible after they are perfected. The sooner they are patented, the sooner will the country obtain the benefit of them, and the country in which they are first patented will have an advantage over a country where they are subsequently patented, *because an invention is not generally known or used*, or in a condition to attract capital and enter upon its commercial development, *until it has been patented*, and, other things being equal, *it will be first developed* and the country will first obtain its benefits *where it is first protected by a patent*.

That it was one of the objects of the statute to obtain this advantage has been noted in several instances in the decisions of the Patent Office.

Soon after the passage of the Act of 1870, Mr. Fisher, who was Commissioner of Patents at the time the law was passed, and who was in a position to know well its actual intent and purpose, uses this language in reference to the 25th Section in *Ex parte* Boyer (Com. Dec., 1870, p. 131):

"*It is reasonable to suppose that the inventor will* "*follow up his earliest patent with the greatest vigor;* " and that, other things being equal, he will protect his " invention, first, in that country where he expects to " make the most use of it. If, therefore, the American " inventor chooses to exhibit this preference for a " foreign country, and to give them the first informa- " tion respecting his invention, and the earliest oppor- " tunity of using it, the law makes no distinction " between him and the foreign inventor who obtained " his first patent at home."

Ex parte Boyer, Commissioners' Decisions, 1870, p. 131.

This statement from such a source is contemporaneous testimony as to the intent of the act, and is entitled to especial consideration.

The same idea as to the general policy of our law was expressed by Commissioner Leggett. He says:

"The law proceeds altogether upon the ground that "the inventor confers a benefit on the public here, and "it specially encourages and protects him for that "reason. A foreign inventor, whether a citizen of the "United States or not is immaterial, can only benefit "the public here by publishing his invention here."

Tucker vs. Davis, 2 Off. Gaz., 224.

And Commissioner Marble, almost following the language of Commissioner Fisher, says:

"There is no reason why American inventors who "choose to obtain patents abroad before doing so in "their own country should be placed upon a different "platform than foreigners. If they exhibit this prefer- "ence for foreign countries, and give them the first "information respecting their inventions, and the first "opportunity of using them, the law makes no distinc- "tion in their favor as against an inventor who makes "his first efforts at home."

Bell vs. Brooks, 19 Off. Gaz., 290.

It, therefore, appears that there are *three* objects which Congress may have intended to attain by the enactment under consideration, and no other than these three have ever been suggested. They are, *first*, to cause an invention patented both here and abroad to be free to the public here as soon as it is free abroad; *second*, to promote the earlier introduction of the patented invention in this country, by giving the full term monopoly to an invention first patented here; and, *third*, to secure some allowance for the benefit of the American public by imposing a reduction of the full term granted to an invention patented in this country alone, in a class of cases in which the inventor is also, at the same time, enjoying a monopoly in one or more foreign countries.

Now, each of these objects is most effectively attained by causing the limitation of the term of the American patent to depend upon the existence of a foreign patent for the same invention, prior to the *grant* of the patent here, and not prior to the *application* for the patent here.

As to the *first* object, if the date of *application* be made the controlling date, it will be in the power of any inventor, by first filing his application here and then taking out a foreign patent before the issue of the American patent, to obtain a full-term patent here, which may, and, in most cases, certainly will, extend beyond the term of the foreign patent. Should the law be so declared, it would, naturally, become an almost universal practice to file the application here first, and then postpone the issuing of the of the patent until after the invention was patented abroad—at least, as far as American inventors are concerned—and, after such an interpretation became known abroad, the obvious advantage of such a course would, doubtless, lead to its adoption by foreign inventors, especially those having attorneys or agents here. To a very great extent, therefore, this object of the statute would be defeated by the construction for which the complainant contends.

The *second* object, *viz.*, promoting the earlier knowledge and introduction of the invention in this country by offering a full-term patent only for inventions first patented here, would, under the same construction, be frustrated in a large number of cases.

It would permit an inventor to file his application here, and then delay prosecuting it to issue, while he was, in the meantime, developing his invention abroad, and then, after the lapse of a long period, to resume the American application, and, finally, obtain a patent and introduce the invention here after its use has become well established abroad.

This result will not be regarded as improbable by those acquainted with the history of inventions that have been successively patented in different countries.

As to the *third* object, it is manifest that it will be defeated altogether if the date of *application* be made the controlling date, since the inventor, having the plan to take his foreign patents first, might file his application here before filing abroad, but by the well-known methods recognized by our law and practice, delay the issue of the American patent until after the issue of all the patents abroad.

The evils incident to these delays in prosecuting applications in the United States Patent Office are very forcibly set forth by the Commissioner of Patents in his annual report for the year ending December 31, 1887. He says:

"I desire to call especial attention to the subject of "delays which occur in the Patent Office on the part "of applicants in the prosecution of their applications "for patents." * * *

"Under this section applicants who desire to pro- "long their applications and postpone action therein "have ample opportunity to do so. There are two "classes of persons who apply for patents, one composed "of those who are exceedingly anxious to obtain their "patents at the earliest practical moment, the other of "those who desire to prolong the issue of their "patents and to keep the applications pending in the "Patent Office to the very latest date possible. "The second class embraces the more powerful, rich "and influential parties, who are either the inventors "or the assignees of the inventors. This section of the "statute enables the second class of persons to keep "their applications pending in the Office for years be- "fore their patents issue. In the meantime they are "engaged in manufacturing and putting upon the mar- "ket the article or improvement, but warning the pub-

" lic that the patent is applied for ; the effect of which " is to give them the absolute control and monopoly of " the invention, and to deter all other inventors from " entering upon the same field of invention and from " manufacturing the article." * * *

" I have had occasion to direct an investigation to " be made into this matter, and I submit as a part of " this report the result reached by a committee on the " subject, showing the number of applications in the " Office which have been so pending for a number of " years (see Appendix B)."

The table constituting Appendix B shows that there were at the time of the report 7,745 applications pending in the Patent Office that had been thus kept alive for more than two years.

So far, therefore, from the enactment in question being an unreasonable and oppressive restriction, a forfeiture, a provision to be accepted with reluctance and construed with the strictest hostility, so as, if possible, to defeat its expressed purpose, it is a just, reasonable and equitable provision intended for the advantage and benefit of the public.

Patent legislation is not class legislation. It is, as has been stated in this brief, *not primarily* for the benefit of the inventor, but for the benefit of the public.

The Constitution provides (Art. I., Sec. 8) that Congress shall have power " To *promote the progress of* " *science and useful arts, by securing*, for *limited times*, " to authors and inventors, the exclusive right to their " respective writings and discoveries."

" Promote " for whose benefit? Not for the benefit of inventors, but for the benefit of the whole people of the United States.

Chief-Justice MARSHALL said :

" The great object and intention of the act is to secure

" to the public the advantages to be derived from the " discoveries of individuals."

Grant vs. Raymond, 6 Pet., 218.

The Supreme Court, at a later date, reaffirmed the same principle. In delivering its opinion in the case of *Kendall vs. Winsor* (21 How., 322), Judge DANIELS said:

" It is undeniably true that the limited and tempo- " rary monopoly granted to inventors was never de- " signed for their exclusive profit or advantage; the " benefit to the public or community at large was " another and doubtless the primary object in granting " or securing that monopoly."

It is true that the law, for the purpose of securing the desired benefit for the public, also secures a just reward, as it is often called, to the inventor, although this is an inaccurate expression. The monopoly conferred by a patent is not *a reward*, but a *compensation*: not a bounty, but a *fair price*. It does not depend upon the amount of skill, or genius, or labor, involved in making the invention, and no distinction is made between inventions of the smallest, and those of the highest, degree of utility. It is bestowed alike on the inventor who has spent years of effort, and the one who merely stumbles on a lucky discovery involving no more personal merit than the finding of a coin by the roadside.

All of these circumstances are immaterial, because the patent is given, not to reward merit, but to secure a public benefit upon just terms, which shall recognize and protect the inventor's property in his invention by giving him a monopoly therein in return for its disclosure, but shall also protect the public against exorbitant demands by limiting that monopoly to a fixed and uniform term, which is deemed adequate to furnish a proper compensation.

In *Neilson vs. Harford*, 1 Web. Pat. Cas., 331, ALDERSON, B., citing Lord ELDON, says:

"Lord ELDON lays down the principle so long ago "as 1800. He says patents are to be considered as "bargains between the inventor and the public, to be "judged of on the principles of good faith by making "a fair disclosure of the invention, and to be construed "as other bargains. That is the principle which must "be taken to be the sound principle."

And in Gibson vs. Campbell, 1 Web., 627, TINDALL, C. J., says (p. 629):

"The specification * * * is the price that the "man who takes out his patents pays to the public. "* * * Therefore, every man who is an honest man "is bound to pay that price justly and fairly," &c.

Mr. Curtis, in his treatise on patents, says:

"But it should always be remembered that in the "grant of a patent privilege, as now understood, a con-"tract takes place between the public and the patentee, "to be supported upon the ground of mutual consider-"tions, and to be construed, in all its essential features "of a bargain, like other contracts to which there are "two parties, each having rights and interests involved "in its stipulations."

Curtis on Patents, Sec. 23.

And in the later work of Professor Robinson on Patents it is said (p. 61):

"Patent law, as such, consisting of these statutes "and decisions, therefore relates only to the contract "character of the patent privilege and forms one "branch of the Law of Contracts."

It is just and proper that the contract theory, the only true theory of the patent law, shall be maintained. It is derogatory to the self respect, alike of the donor and the recipient, to reward philanthropy.

It is not the policy of this Government to pay bounties to its citizens for moral virtues or intellectual achievement.

And, if they were so paid, inventors, as a class, would seldom receive them. They are benefactors, but rarely philanthropists. They work like the rest of mankind, not for the public good, but for their private profit. The public may reap a benefit from their labors, but one would have to look far to find an inventor who proposed to let the public have that benefit for nothing; and, as a rule, they hold exaggerated views as to the value of what they have accomplished and the price they should receive. This is said, not in derogation of inventors, but in opposition to the view which clothes them with peculiar merits over the rest of their fellow citizens, which they by no means possess, and which it was not the object of the law to reward. Constancy under discouraging circumstances, and other virtues which inventors may have exhibited, are not peculiar to them, or to be rewarded in them more than in others.

Therefore, in construing the restriction upon an inventor's monopoly which the law has imposed in the only cases that it can properly reach, those in which he is enjoying that monopoly in two or more countries at once, it is to be remembered that the restriction is imposed in favor of the public, and that the public is as much a party to the bargain implied by a patent as the patentee.

The law has said that there shall be an abridgement of the term of the American patent where a prior foreign patent exists, and that abridgement was made by Congress because it was regarded as not trenching upon the patentee's just compensation where he holds a multiplicity of patents, and as better securing the interests of the public.

The section, then, is not to receive a strained interpretation in favor of the patentee. It is to

be construed according to the plain import of the language used, not only because its language is not ambiguous, but because such an interpretation is in accordance with its manifest intent to introduce a provision in favor of the public. That is the only intention the section can possibly have, and the argument of complainant, which is, in effect, that it should be strictly construed and treated as a forfeiture, an arbitrary invasion of the patentee's rights, is fundamentally erroneous.

If that argument is sound, it applies as directly to the limitation imposed in cases in which the invention is patented abroad before the filing of the application for the American patent, as to those in which the foreign patent is subsequent to the application but before the grant.

The objections based upon the supposed policy of our patent law, if they have any foundation, exist as much in one case as in the other, differing only in degree. If the appellant's theory is correct, it may be less of a hardship to have an American patent limited by a foreign patent issued before, than by one issued after, the application here, but it is none the less a hardship, and an arbitrary forfeiture of the patentee's rights, in either case.

If, on the contrary, the limitation is a just provision in favor of the public, which is the true interpretation, it is neither a hardship nor a forfeiture in any case, and should not be so considered or treated.

Complainant argues that a distinction ought to exist in favor of the patentee, in case the foreign patent is granted after the American application, upon two grounds: *first*, because, as is alleged, *the filing of the application* confers upon the applicant an absolute right to a full term seventeen-year patent which he did not before possess; and, *second*, that in case his term is limited by foreign patents issued before the grant

here, he may be prejudiced by delays in the Patent Office, for which he is not responsible.

Neither ground affords a basis for the distinction sought to be founded upon it.

1. *An inventor's right to a patent does not originate with, and is not fixed by, the filing of his application.*

His right is founded solely on the fact that he has made a new and useful invention. He is entitled to his patent because he is an inventor, and for no other reason. The law promises inventors a patent upon their fulfilling certain conditions. The filing of the specification is *only one* of those conditions, but the right to receive any patent at all, *as a matter of right*, is based solely upon the applicant's being, in fact, the first inventor of that which he claims. If rival inventors apply for a patent for the same invention, the right to the patent depends, *not upon priority in filing the application*, but upon *priority of invention*. Before an inventor can obtain a patent he must not only file such an application as the law requires, but must file such application before the invention has been in public use or on sale for more than two years. He must pay the specified fee upon filing, he must make proper amendments in his application, if they are found to be necessary by the examination, and he must pay the final fee before the patent can be issued. The making of the invention gives him the patent, as a matter of right, upon fulfilling these several conditions; but that right in no way originates in the fulfilling of any one of these conditions.

Especially is there nothing in the filing of the application which confers upon the applicant an indefeasible right to a patent for the full term of seventeen years. If he files his application in proper form, and follows it up by paying the proper fees, he becomes entitled to such a patent as an inventor of the class to which he belongs is entitled by law to receive, and if he

has previously patented the same invention abroad he is only entitled to receive such a patent as the statute allows under such circumstances; and the filing of his application cannot affect this question in one way or the other. The filing of an application is presumptive evidence that the invention was made at a date, at least prior to that event, and it, also, by statute, cuts off the effect of continued public use, or sale, of the invention after such application is filed; but these results of filing the application do not imply that the inchoate right to a patent based upon the making of the invention is, in any way, altered by the filing of the application. That is the fulfillment of *one* of the important conditions required in order to perfect that inchoate right, but until *all* the conditions are fulfilled, its character as a right is not altered. It remains inchoate until the payment of the final fee. A man, who has a contract for the conveyance of a piece of property, payable in installments, has no better right to the deed after he has paid part of the installments than he has before he has paid any. The condition of the inventor is similar. *When he has made his invention, the statute practically makes a contract with him to deliver a patent for that invention upon the performance of certain conditions, the last of which is the payment of a final fee.* His right to the patent is no more complete if he has not performed all the conditions necessary to obtaining it than it is when he has not yet performed any.

Complainant's argument, therefore, that when a patent is granted here for an invention previously patented abroad, the patentee should be relieved from the limitation imposed by the statute in such cases upon the ground that he has obtained some right to such exemption by filing his application here before the grant of the foreign patent, seems without foundation in authority, in principle or in reason.

2. The alleged hardship supposed to arise from delays in the Patent Office for which the patentee may

not be responsible is purely an argument *ab inconvenienti*, and one without weight.

(a) It is pointed out that an applicant for a patent may be delayed by an interference suit, and if he finally prevails in such suit, he may, where the invention has been patented abroad, have lost a considerable portion of the term of his American patent. This is true, but he has, in the meantime, been enjoying the monopoly of his foreign patent, and such inconvenience as he may suffer is inseparable from our patent system, which determines the claims of rival inventors before issuing the patent, and is very little more than every inventor suffers who happens to make the same invention as another and is compelled to have the question of priority determined before he can obtain his patent. The slight extra inconvenience which an applicant, who already has a foreign patent, may suffer in case he falls into an interference is wholly insignificant in comparison with the advantage to the public which is intended to be gained by the limitation which the statute imposes, and is more than offset by the injury to the public interest which might occur if the term of the American patent was not affected by any foreign patent granted after the American application. In that case, as already pointed out, it would be possible for any inventor, American or foreign, to file his application here and to allow it to remain until all desired foreign patents were obtained, and then to resume the prosecution of the American application and take out a full term patent here, so that it would be possible to nullify the statute as it now stands; and should it be authoritatively determined that it would only be necessary to file the application here in order to avoid the effect of a foreign patent, it may be confidently predicted that in the vast majority of cases the application, as a matter of fact, will be first filed here and the issuing of

the patent greatly delayed and the statute thus completely evaded.

It may be remarked, in passing, that the number of contested interferences, in proportion to the whole number of patents issued is very small.

The Official Gazette reports eighty-eight decisions in interference cases for the year ending June, 1893, and one hundred and sixty decisions for the year immediately preceding, or two hundred and forty-eight in all. During the same periods there were issued 22,467 and 22,779 patents, respectively, or 45,246 in all. As most contested interference cases are reported in the Gazette, it will be seen that the percentage of applications which are delayed by interference proceedings is very small, and only a trifle more than one-half of one per cent.

(b) Delays in the Patent Office not caused by interference proceedings must be charged to the inventor or his attorney. If an application is correctly drawn in the first instance, covering no more than the invention actually made, it is granted with all reasonable promptness. The most fruitful source of delay arises from errors and defects in the specification caused by the unskillfulness or ignorance of the inventor or his solicitor, or from an attempt to expand the invention beyond its proper limits. Such delays should not be charged to the Patent Office, and still less than delays arising from possible interference suits are they a reason for departing from the plain, literal meaning of the statute under consideration.

FOURTH.

The judgment appealed from is supported by a line of Circuit Court decisions covering a period of more than ten years past, and is not at variance with any decision either at circuit or on appeal.

The first case in which the point now involved was directly adjudicated, was *Bate Co. vs. Gillett*, 13 Fed. Rep., 553, decided by Judge NIXON in 1882. The patent in suit in that case was the same as that sued upon in the present case, and it was urged by the complainant that the prior Canadian patent did not limit the term of the United States patent under Section 4887, Revised Statutes, because the Canadian patent was granted after the filing of the application for the United States patent. On this point the Court said (p. 555):

"But the counsel for the complainant contended on "the argument that the present case did not fall within "the limitation of the statute, because the application "for the United States patent was filed antecedent to "the application for, or the grant of, the Canadian "patent. We are at a loss to understand what the "time of filing the application for the patent has to do "with the matter. It is true that the eighth section "of the Act of 1836, and the sixth section of the Act "of 1839, made the date of filing the specifications "and drawings in the one case, and the date of the application for the home patent in the other, the point of "time from which to reckon the six months intervening "between the issue of the foreign and domestic patent. "It is also true that by Section 4886, and the first "clause of Section 4887 of the Revised Statutes an inventor is required to file an application for his patent "within two years after his invention or discovery has "been in public use or on sale, from all of which the "late Commissioner of Patents (Paine) was led to the

"opinion that the word 'previously,' used in the last "clause of Section 4887, had reference to time prior "to the filing of the application rather than to time prior "to the granting of the patent (see 17 O. G., 330). "*But this seems to be wresting the language of the "section from its plain and obvious meaning*, and we "are not able to follow the reasoning by which such "an interpretation is reached."

In *Gramme Co. vs. Arnoux*, 17 Fed. Rep., 838, the same point was again raised on substantially the same state of facts under Section 25 of the Act of 1870, and argued at length. The Court (Justice BLATCHFORD), referring to the contention of the defendant that the patent in suit had expired by reason of the expiration of a prior Austrian patent, said (p. 840):

"To this the plaintiff replies that the application for "No. 120,057 was filed before the application for the "Austrian patent was filed. But the date of the ap- "plication for No. 120,057 cannot affect the question. "Under the Act of 1870 a patent takes effect from the "time when it is granted, and cannot be antedated. "The meaning of Section 25 of the Act of 1870 is "that the United States patent shall expire at the "same time with the foreign patent having the short- "est time to run, which was granted before the United "States patent was granted, and not that it shall ex- "pire at the same [time] with the foreign patent having "the shortest time to run, which was granted before "the time when the application for the United States "patent was made (*Bate Refrigerating Co. vs. Gillett*, "13 Fed. Rep., 553)."

It is evident from the language used that Judge BLATCHFORD, although he refers to the prior decision of Judge NIXON as supporting his conclusion, had given the matter independent consideration and had reached the same conclusion as Judge NIXON in regard to the proper interpretation of the statute.

In *Bate Co. vs. Gillett*, 31 Fed. Rep., 809, where the same point was again raised, Mr. Justice BRADLEY, sitting at Circuit, followed the prior decisions of Judge NIXON and Justice BLATCHFORD, and held that the prior foreign patent limited the term of the United States patent when the application for the latter preceded the grant of the foreign patent. Although he based his decision upon the prior adjudications, and said that he might have had some hesitation if the question was an open one, he did not say or intimate that he would have reached any different conclusion in the absence of any precedent on the point.

In *Edison Company vs. The United States Company*, 35 Fed. Rep., 134, the question was again argued at length, and the Court (Judge WALLACE), after referring to certain other questions, said (p. 138):

"The question may therefore be simplified by elimi-
" nating these immaterial ingredients; and the real
" inquiry is whether the section limits the term of a
" domestic patent to the term of a foreign patent when
" the application for the foreign patent is not made
" until subsequent to the application in this country,
" but the foreign patent issues before the domestic
" patent. If it were proper to treat this question as
" an original one, it would be necessary first to inquire
" whether there is any ambiguity in the language of
" the statute. If there is not, the duty of the Court is
" to give effect to its obvious meaning, notwithstanding
" it may be thought to make an unreasonable and
" harsh innovation upon the pre-existing privileges of
" our own inventors. It is not only the safer course to
" adhere to the words of a statute, construed in their
" ordinary import, instead of entering into any inquiry
" as to the supposed intention of Congress, but it is
" the imperative duty of the Court to do so. Where
" the meaning of the Revised Statutes is plain the
" Court cannot look to the sources of the revision to
" ascertain whether errors have or have not been com-

" mitted by the revisers (*U. S. vs. Bowen*, 100 U. S.,
" 508). There is no practical difference in the phrase-
" ology of Section 4887 and that of Section 25 of the Act
" of July 8, 1870, from which the section is reproduced.
" The precise point now raised by the complainant,
" but made with reference to the effect of Section 25 of
" the Act of 1870, was considered by this Court in
" *Electrical Co. vs. Electric Co.* (21 Blatchf., 450). It
" was insisted by the defendant in that case that the
" complainant's patent expired at the date of the ex
" piration of an Austrian patent, and the complainant
" took the position that the defense was not tenable, be-
" cause the application for his United States patent
" was filed before the application for the Austrian pat-
" ent was made. It was held by BLATCHFORD, J., that
" the date of the application for the United States
" patent could not affect the question, and that the
" meaning of the statute was that the United States
" patent should expire at the time of expiration of
" the foreign patent, irrespective of the time when the
" foreign patent was applied for. Judge BLATCHFORD
" adopted in that case the views of Judge NIXON upon
" the same question in *Bate Refrigerating Co. vs. Gil-*
" *lett* (13 Fed. Rep., 553). In the *Bate* case the question
" arose under Section 4887, and it was contended that
" complainant's United States patent did not expire at
" the date of the expiration of a Canadian patent
" because the application for his patent was filed an-
" tecedent to the application for the grant
" of the Canadian patent. The Court was of the
" opinion that it would be wresting the language of
" the section from its plain and obvious meaning to
" sustain that position. These decisions have
" been followed by BRADLEY, J., upon a subsequent
" hearing in the *Bate Case*, 31 Fed. Rep., 809, and by
" COLT, J., in *Bate Co. vs. Hammond*, *post*, 151.

" In view of these adjudications, the question should
" not be considered as an original one. The plea is,
" therefore, allowed."

In *Bate Co. vs. Hammond*, 35 Fed. Rep., 151, the Court (Judge COLT) followed the decision of Justice BRADLEY in the prior case of *Bate Co. vs. Gillett*.

In *Accumulator Co. vs. Julien Electrical Co.*, 57 Fed. Rep., 605, the same point was again raised, and the Court (Judge COXE) followed the prior adjudications above cited, and held the term of the United States Patent to be limited by a foreign patent prior to the grant, but subsequent to the application for the United States patent.

This point has not been passed upon, so far as we have been able to ascertain, either by the Supreme Court or by any of the Circuit Courts of Appeals. The only reported case in the Supreme Court in which the point appears to have been raised is *Bate Co. vs. Hammond*, 129 U. S., 151, but in this case the decision turned upon other points, and the Court did not disturb the Circuit Court adjudications on this point.

FIFTH.

We will now consider some of the arguments urged by complainant. They consist in substance of these propositions:

FIRST. That Section 4887 is not only open to interpretation by reference to the history of the prior legislation on the subject and the supposed policy of Congress underlying it, but it cannot properly be interpreted without such reference.

SECOND. That Section 25 of the Act of 1870 (with which Section 4887 has been held to be identical in its provisions) was a *mere revision* of the prior legislation

on the subject to which it relates, and was intended by Congress, so far at least as concerns the question now in controversy, to be a mere restatement in somewhat different phraseology of the existing legislation on this subject, *without making any change* in such legislation.

THIRD. That upon the construction contended for by defendants, the opening clause of Section 4887, providing that "no person shall be debarred," &c., is wholly unintelligible and without any conceivable effect; whereas, upon the construction contended for by appellant, this clause is intelligible, and its presence is fully explained.

FOURTH. That in the legislation prior to 1870 a definite policy and "working plan" with reference to the subject matter now under discussion had been adopted by Congress; that Section 25 of the Act of 1870, under appellees' construction, is wholly inconsistent with, and repugnant to, such policy and plan, while under appellant's construction it is entirely consistent and harmonious with it; and that it cannot be assumed that Congress intended to make so radical an innovation in this policy and plan as appellees' construction would involve.

FIFTH. That Section 25 of the Act of 1870, if construed as defendants contend it should be, is inconsistent with the other provisions of that Act, but if construed according to complainant's contention, it is entirely consistent with such other provisions; that the construction contended for by defendants would not only involve intolerable hardships to patentees, but would lead to manifest absurdities and be practically unworkable; and that Congress could never have intended any legislation which would lead to such results.

SIXTH. That complainant's construction has the support of contemporaneous executive opinion, and defendants' construction has no such support.

SEVENTH. That the inventor's right to a patent is complete when his application is filed, and that the word "patented" has been frequently used by the courts in their opinions, and by distinguished counsel in their arguments, when they clearly meant to refer to the application.

We will consider the above propositions in the order in which they have been stated.

I.

As to the proper rule of interpretation to be applied.

We have already discussed this subject, and have shown the general rule in regard to the interpretation of statutes to be, that when the words of a statute are plain and lead to no absurdity, they cannot be wrested from their plain and ordinary meaning by resort to considerations of convenience or supposed policy or legislative intent, gathered from other sources than the wording of the statute itself, and have cited cases in this and other Courts establishing such rule.

None of the cases cited by complainant are inconsistent with this general rule, or go further than to hold that, under peculiar circumstances, where the language used is not plain, or if construed according to the ordinary meaning of the words employed would result in an absurdity, or be repugnant to other existing legislation, resort may be had to other sources than the statute itself to ascertain the legislative intent. We have commented somewhat in detail upon these cases in an appendix which will be found at the end of this brief.

It is urged by counsel for complainant, both as a reason for claiming that the statute is open to interpretation, as well as for the interpretation of it when so

opened, that there is in existence a rule of law which was stated in the brief of counsel for complainant below as follows:

> "And hence the reasonable rule that in the case o
> "revisions it is to be *presumed* that a mere change
> "of language was not intended to effect a change
> "in the law. This presumption may, indeed, be
> "displaced by evidence tending to show that the
> "Legislature designed to do something more than
> "merely to revise—that it intended also to *amend*."

We submit that there is no such rule, and that the only rule is that, in the construction of a revising statute, a mere change of language does not *necessarily* infer a change of meaning.

Contention has been made in the argument of questions of construction of such statutes, that from the *mere* change of language it was *necessary* to infer a change of meaning. Undoubtedly the rule is that such an inference is *not* a necessary one; in other words, the rule is that from *mere* change of language, change of meaning is not to be inferred.

We submit that the first duty of the Court in this case is to look at the statute itself in its own language and say: "What does that statute fairly mean to any "one perusing it with the intent of acting under it? "Could he possibly come to any other conclusion than "that the date referred to in the statute, as 'first "'patented,' means just what it says; that is, whether, "at the time of the issue of the American patent, any "foreign patent had been issued?"

Nowhere in the Act would he find, in this connection, anything about the time of the application for the American patent. The only time referred to in this connection is the time of being patented. The contrast of time is as to which patent was first issued.

It is to be observed that the single word "patented," both in the expression "first patented" and in the expression "previously patented," is used as referring both to the domestic monopoly and to the foreign monopoly, and must be taken as meaning the same thing with reference to both. It has been held repeatedly that the word "patented" as used in this section refers to the date of the grant, so far as the foreign patent is concerned, and not to the date of the application, even when that is the date given to the patent and from which the term is calculated, as in the case of an English or French patent.

Says WHEELER, J., in *American Diamond, &c., Co., vs. Sheldon* (17 Blatch., 303):

> "As said by GROSE, J., in *Hornblower vs. Boulton* (8 D. & E., 105), the English patent was nothing without the specification, and the patentee could gain no advantage by it. The question is, was it *patented* there before the specification was filed. In *Howe vs. Morton* (1 Fish. Pat. Cas., 586), it was held, in an elaborate opinion, that an invention was not patented abroad until there was a full and perfected patent. And, in *Smith vs. Goodyear Dental Vulcanite Co.* (3 Otto, 486), the question seems to be settled, or treated as settled before, in the same way. Mr. Justice STRONG said, page 498: 'Of the English patent of Charles Good-'year it is enough to say that, though the pro-'visional specification was filed March 14, 1855, 'the completed specification was not until the 11th 'of September following. It was, therefore, on 'the last-mentioned date that the invention was 'patented.'"

How, then, can any different meaning be assigned to the same term as applied to the domestic monoply? The word must obviously refer to the same stage of the proceedings in both cases.

Nor can it properly or justly be said, as claimed by complainant, that the subject matter of Section 25 of the Law of 1870, or of Section 4887 of the Revised Statutes, is in any degree the patent system of the United States. The subject matter of those sections, and their only subject matter, is, how the validity and duration of an American patent shall be affected by the existence of a foreign patent.

On that point there did exist certain statutes which had been passed at different times, and for different purposes, and the result of which was a quite anomalous condition of the law, making provisions in certain cases, for the existence of which no sound reason could be suggested.

These statutes were dealt with by the 25th Section of the Law of 1870, and subsequently by the Revised Statutes. Beyond any question, the legislation pursuant to which the Act of 1870 and the Revised Statutes were enacted, contemplated changes in the law—in other words, it contemplated amendments to the law. Surely it was the function of the revisers, and of the committees, and of Congress, to make such amendments in the case of such statutes as the statute of 1836 and the statute of 1839, as should reduce the whole law upon the subject of the effect of a foreign patent upon the validity or duration of an American patent to some simple and precise rule affecting all alike.

Can it be said, when such simple and concise statute is passed, providing a simple and precise rule affecting all cases alike, that even an expert in statutory construction, knowing that it was the intention of Congress to amend more or less, is bound to look back and find all the various additions and inconsistencies, repetitions and incongruities which had crept into the law, and then come to a conclusion as to whether the revised statute does not mean something quite different from, and, we submit, quite inconsistent with, what it says, and that it really means what was

said in prior statutes, and what has been industriously left out of the revising statute?

Again we say, if such be the law, what is the use of revising statutes?

The complainant cites with great confidence, and, apparently, very largely relies upon the report of the proceedings in the House when Mr. Jenckes presented the report of the Patent Committee. Now, we submit that it is impossible to imagine anything more dangerous as an aid to the construction of a statute than reference to such proceedings. The statement of Mr. Jenckes was not one of precision, for even our adversaries concede that the Statute of 1870 did make *some* alteration in the preceding law, and that, too, without any reference to it by the use of italics. In this report of the oral remarks of Mr. Jenckes, no allusion is made to this conceded alteration. Confessedly, however, any one who had the least familiarity with what the patent law on the subject was at that time, would note that a change had been made. Can it be supposed that Mr. Jenckes had no conversation or consultation with any member of Congress upon that subject except in the formal oral remarks the record shows him to have made? Is the whole House of Representatives to be charged with remaining in willful ignorance of the defects which were then proposed to be cured by such legislation, when it was of such vast importance and when a word of inquiry would have shown them all that was done in the premises? Or can it be supposed that Mr. Jenckes or the other members of the committee failed to communicate to all members of Congress, as well the change which our adversaries concede was made, as the change which it seems to us it is apparent upon the face of the revising statute was also made?

The inference which our adversaries seek to draw from these oral remarks of Mr. Jenckes is altogether too stupendous for the base upon which it is founded.

Neither Members of Congress nor members of any other deliberative body rely exclusively, or, we may probably say, rely mainly, upon the formal discussions which take place. They are in constant, daily association, consultation and deliberation, and it must be supposed, in the absence of some formal and deliberate action showing the contrary, that they were aware of all the existing facts. .

Further, it is probably no unfair claim to make that the legislators must be presumed to be cognizant of such changes as are herein under consideration.

How and where and by whom is the distinction to be drawn between what is by our adversaries denominated an "unimportant detail," and one of importance?

Grant, for the moment, that no burden was imposed upon Mr. Jenckes in his oral address to allude to the change which our adversaries concede was made; who can say, or who shall say, that either to Mr. Jenckes or to any other Member of Congress at that time, the question now presented then presented itself as other than an "unimportant detail"?

And if it was then regarded by Mr. Jenckes or by any other Member of Congress as a detail equally unimportant with the change which it is conceded was made, is legislation to be changed and a different construction put upon a statute because Mr. Jenckes and his associate Members of Congress at that time took a different view of this importance of detail than that which is now advocated by our adversaries? Is a statute to be construed according to the question whether Mr. Jenckes made an error or not in the degree of importance he attached to this detail?

The Court will see what an infinitude of difficulties and dangers we at once encounter when we allow such considerations to influence the construction of this statute.

Here certainly is one fair, obvious distinction between the old law and the new ; the old law of 1836 referred in terms to the "filing of his specifications and drawings" ; the old law of 1839 referred in terms to the application of the inventor ; the new law clearly and plainly leaves out the very words which were effective, and the *only* words which were effective, in the old law in fixing the date to which the existence of a foreign patent should be referred, and deliberately adopts and uses other language which refers to a different date in the ordinary proceedings for the obtaining of a patent, and that date is the issue of the patent itself.

Could there be anything plainer to show that an amendment or change in the law was contemplated? Could it be possible that a skilled lawyer—a skilled patent lawyer such as was Mr. Jenckes—that a body of gentlemen specially skilled in patent matters, such as were the House and Senate Committees on Patents to whom the report was referred, would not have their attention immediately drawn to so broad a change, and would not immediately say, assuming that it was their intention to retain the old law, "This language is not "appropriate, is not adequate, to express our intent that "a rule adopted by the law of 1839 shall become the "exclusive rule, in substance, for all cases"?

II.

As to appellant's contention that the Act of 1870 was a mere revision.

It is to be observed, in the first place, that, as we have already shown (pp. 13–20), the Act of 1870 was not a *mere* revision, since the title of the act itself is "An Act to revise, consolidate *and amend* the Stat- "utes relating to patents," &c. ; and it did *amend* the law relating to patents by introducing undoubted changes in various important matters.

But complainant contends with great earnestness that, whatever changes may have been made with regard to *other* provisions of the patent law, as to *this particular provision* now under consideration it was clearly understood and intended by Congress not to introduce any change whatever in existing legislation. Support is sought for this contention by a reference to the proceedings in Congress relating to the passage of the act. For this purpose quotations are made in complainant's brief from the "Congressional Globe," showing that the original draft of the act was prepared by Commissioners for the Revision of the Laws appointed pursuant to an act passed June 27th, 1866; that these Commissioners were instructed to revise existing laws, and whenever they should make changes amounting to alterations of the law, to distinctly indicate that such was their character; that this draft was examined by a House Committee, and found to embody all the provisions of the existing law, and referred to the Committee on Patents; that this latter committee reported it back to the House, and Mr. Jenckes, the chairman of the Patent Committee, stated orally to the House that it had been examined by the Patent Committee and was found to embody all the provisions of existing law, and that the latter committee had made certain amendments in it, and had printed the bill embodying this draft of the law in such a way as to show in Roman type such parts as merely embodied existing provisions of law, and in italics such parts as embodied the Patent Committee's proposed amendments. It is further shown that the part of Section 25 of the Act of 1870 upon which the present discussion turns was printed in Roman type in the report of the Committee on Patents.

It is contended that nothing could show more clearly than this that the legislation now under discussion was fully understood, and intended *by Congress* to constitute *a mere revision* of preceding legislation on the same subject without any change in the meaning or effect of

such legislation, and that, even if the language employed seems in some measure repugnant to this conclusion, it is the duty of the Court to give effect to the obvious intention of Congress, which was to preserve the provisions of the prior Acts of 1836 and 1839, making the date of the application for the American patent rather than the date of the patent itself, the controlling date with reference to the limitation of the term of the American patent by foreign patents.

It is a sufficient answer to this to show that the premises will be found, upon examination, to be fatally defective.

1. It is not true, as complainant assumes, that the Act of 1870, even upon complainant's construction of it, merely repeated the provisions of the prior Acts of 1836 and 1839 without making any change in them.

According to complainant's contention, which in this is undoubtedly correct, the Act of 1836 was not repealed by the Act of 1839, but both were in force in 1870. Under the Act of 1836, even if a foreign patent was taken out by the inventor prior to the date of filing his specifications in this country, his American patent was not only not invalidated, but *it was not limited* in its term, or affected in any way, provided the foreign patent was not taken out more than six months before the specifications and drawings were filed in the Patent Office; but if the foreign patent was taken out more than six months prior to the filing of the specifications and drawings here, the American patent was invalid. Under this Act, the date with reference to which the foreign patent affected, or did not affect, the American patent was not *the date of the application*, but a date *six months prior to the filing of the specifications and drawings.*

Under the Act of 1839, the effect of a foreign patent as a bar to a home patent was further limited by the

provision that it should be no bar when patented more than six months prior to the application here, but the term should run from the date of the publication of the foreign patent.

It thus appears that, under the provisions of these two acts taken together, if the inventor took out a foreign patent prior to the filing of his specifications and drawings here, but not more than six months prior, he suffered no curtailment of the term of his American patent, and the only class of patentees who did suffer any curtailment of the term of the American patent were those who took out foreign patents *more than six months prior* to the filing of the specifications and less than six months prior to the application in this country.

Upon examination of the extract from the House Bill 1714 it will be seen that the parts printed in Roman type, which are alleged to embody only the provisions of existing laws, without any change whatever, did in fact make a very important change in the provisions of these two prior acts, even assuming that the date of application is the date referred to, as appellant contends. This part of the section provides in substance that *all* patents granted for an invention "first patented " in a foreign country shall be limited to seventeen years " from the date of publication of the foreign patent," thus eliminating wholly the period of six months prior to the filing of the specifications and drawings in this country, during which, under the Act of 1836, foreign patents might be taken out without any limitation of the American term.

2. Complainant concedes, as it must do, that this change was in fact made in existing legislation by the part of the revision in Roman type which the Commissioners of Revision, the House Committee and Mr. Jenckes had all found " to embody all the provisions " of the existing law in brief, clear and precise language,"

and which had been so printed by the Patent Committee in the bill "as to show the law as it now is, in "the "form in which it came from the hands of the Commis- "sioners of Revision"; but it contends that this change *was trivial and immaterial.*

We will deal with this suggestion further on; it is sufficient for our present purposes to show that the "revision" made *some* change, however slight, *in the law itself*, and was not confined merely to reforming the phraseology of the law. This point being established, it is clear that these statements of the various committees and of Mr. Jenckes could not have been intended to be understood in their strictly literal sense, or to convey the meaning that the part of Section 25 now under consideration *merely* restated all of the provisions of the existing legislation on the subject *without any change whatever* in the provisions of the law. The change above referred to is too obvious to any one upon a mere cursory comparison of the prior statutes with what was proposed to be enacted, to be attributed to mere inadvertence. The change of language adopted in the revision was on the face of it *intended* to make a change in the meaning of the law.

It cannot be said that the language contained in Section 25 of the Act of 1870 was used inadvertently, or that the provisions of the prior legislation were apparently changed without due consideration. On the contrary, the Act of 1870 was very carefully considered by the Patent Committees of both the Senate and the House of Representatives. These committees were composed of eminent lawyers, many of them being eminent patent lawyers. The House Committee was composed of Thomas A. Jenckes (chairman), Aaron F. Stevens, John A. Smith, Lewis Tillman, Jesse H. Moore, Jas. A. Johnson, Stephen Sanford, Daniel M. Van Auken, Harvey A. Calkin and Leonard Myers ("Congressional Globe," 1st Session, Forty-first Cong., p. 76; "Congressional Globe," 2d Session,

Forty-first Cong., p. 184). The Senate Committee consisted of Senators Willey (chairman), Ferry, Carpenter, Norton and Hamilton.

The bill in the House was twice recommitted to the Committee on Patents, and was twice reported back by Mr. Jenckes, with amendments. It was very carefully considered by the Senate Committee on Patents, which proposed thirty-nine amendments, some of which were agreed to by the House ("Congressional Globe," 2d Session, Forty-first Cong., p. 5136).

Section 25 of this act was very carefully considered, not merely as regards substance, but as regards phraseology.

When the bill was under discussion in the Senate, Senator Carpenter moved that the first part of Section 25 be amended by inserting the words "by reason of "its having been," etc., in place of the words "by rea- "son of his having;" etc., and said "I think the com- "mittee will see that this amendment is necessary to "carry out the spirit of the bill;" and, later on, said that his amendment was to provide for the custom in certain countries of issuing patents in the name of the attorney of the inventor, or of somebody else.

Senator Thurman objected to the amendment on the ground that it would make it inconsistent with Section 62 of the Act, but was apparently convinced by Senator Carpenter that no such inconsistency would arise.

Both Senator Thurman and Senator Carpenter have frequently appeared as counsel in patent cases.

Possibly the revisers and the various committees and Mr. Jenckes did intend to state that the *general provisions* of the preceding legislation were preserved in the revision, and that such changes as were made related merely to more effectually carrying out the general policy of existing legislation. The phraseology used in the various reports and in Mr. Jenckes' state-

ment is entirely consistent with the view that they certainly intended to say no more than this.

3. The assumed understanding and intention of *Congress* in regard to the meaning of the phraseology now under discussion depends wholly upon the reports of the Committees and the statement of Mr. Jenckes already referred to, as no other evidence of any kind is offered to establish any such assumed understanding or intention. It must therefore be assumed that *Congress* did not understand or intend that the phraseology adopted was to make *no change whatever* in the provisions of existing legislation, but, on the contrary, that *some* change of the law was to be effected; and the phraseology adopted undisputedly *did make this change*, of depriving the inventor of the privilege he had enjoyed under the prior legislation, of taking out foreign patents, at any time within six months prior to filing his specifications and drawings, without affecting or limiting his American patent.

4. The moment it is admitted that *any* departure whatever from the provisions of existing legislation was in fact included in the part of the paragraph under consideration which was printed by the Patent Committee in Roman type, complainant's argument on this point loses its entire force. The argument is that Congress could not possibly have intended, by the change of language now under discussion, to refer to the date of the grant instead of the date of the application, because it understood and intended that *no change whatever* was to be made in the provisions of existing legislation, and the exclusion of all changes would of course exclude this particular change.

With the disappearance of the premise the conclusion necessarily falls. The premise is a universal negative, and any exception destroys it. If it was understood and intended by Congress that *any* change

in the law was to be made by the adoption of the phraseology employed, and we have shown that there was at least one such change, the door is at once opened for the inquiry whether the phraseology adopted also imported other changes of a similar character in existing legislation. We shall show that it did.

5. It is no answer to this to say, as complainant does, that this change was viewed by the Revising Commissioners "as an unimportant detail." There is no evidence that the Revising Commissioners, or either of the Committees, or Mr. Jenckes, took this view of it, or ever called the attention of Congress to it at any stage of the proceedings, and there is no note of the change in the text of the House Bill, by enclosing the omitted words of the previous acts in brackets or otherwise; yet it is conceded that the omission from the Act of 1870 of certain words which appeared in the prior Acts of 1836 and 1839 *did work a change in the law* in this particular.

Possibly, the Revising Commissioners considered the change as one of "detail not affecting the general policy of the law, and such as was within their authority to make; but in no event was it "unimportant." On the contrary, by curtailing the time during which foreign patents might be taken out without limitation of the term of the American patent, it not only deprived the inventor of a privilege he had enjoyed under the prior law, and one which according to appellant's view must have been a very important and valuable one, but it tended materially to promote the patenting of the invention first in this country, which, as we have already shown, was the principal object of the legislation on this subject.

The decision of Commissioner Holt, quoted in *ex parte* Cochrane (Commr's. Dec., 1869, p. 60), which is cited by complainant, does not by any means support its

contention that the period of six months was "too "small a fraction of time to require its introduction" for the purpose of distinguishing those cases in which the American term should be curtailed from those in which it should not.

The part of the decision referred to relates to the effect of Section 6 of the Act of 1839 upon the prior Act of 1836, and is as follows (p. 63, italics ours):

> "It may be very well supposed that Congress "might consider six months as too small a fraction "of time to require its introduction *as a part of* "*the lifetime of a patent*, and would therefore "leave it to be embraced or not, at the option of "the applicant, while, to guard against abuse, if "the period were longer, the inclusion of the whole "might be consistently and properly exacted."

In the first place, this is not, in any proper sense, a part of the decision at all, but a mere attempt to give the *reason* Congress may have had for the legislation embodied in the Act of 1839, and, in the second place, it does not hold, as appellant contends, that six months was regarded by Congress as too small a fraction of time to be considered in determining *whether there should be any limitation* or not, but merely that it was too small a fraction of time to require its deduction from the American term, the difference in time between the date of the foreign patent and that of the American patent being, in effect, under the Act of 1839, deducted from the American term by making the term here run from the date of the foreign patent.

For the purpose of determining whether the American patent should be *limited at all*, the period of six months *was*, under the prior legislation, considered a sufficiently large fraction of time to be taken into account, because it was taken into account, and was, indeed, made the decisive and controlling factor for this purpose. If the foreign patent was taken out

more than six months prior to the application, there was a limitation of the American term, and if it was less than six months prior to the filing of the specifications and drawings there was no limitation.

Moreover, even for the first purpose above referred to, the revisers came to a different conclusion in framing the Act of 1870 from that followed by Congress in framing the Act of 1839, because in their original draft (Roman type in Patent Committee's Report) they *did* take it into account and, even on appellant's construction, deducted all the time between the date of publication of the foreign patent and date of the patent here from the American term, whether such time was more than six months or less, by making the American term run from the date of publication of the foreign patent.

Commissioner Holt's decision, therefore, serves only to bring out more clearly the fact that the omission of the six-months limitation was not an immaterial or trivial change, but a distinct and material departure from the provisions of the Act of 1839.

Nor is there any warrant for saying that the six-months limitation provided for by the Act of 1839 merely operated "to make a slight and unimportant "distinction in respect to the *extent* of the curtail-"ment." It determined *whether there should be any curtailment at all, not the extent merely* of the curtailment, and under this Act, it might, and often did, make a very great difference in the term of the American patent whether the foreign patent was taken out more than six months, or less than that time, prior to the filing of the specifications and drawings here.

The change effected by dropping the six-months limitation was not, therefore, in any aspect an immaterial or trivial one, and it cannot be assumed that the very able and experienced patent lawyers who dealt with this matter in Congress can have so regarded it.

The important fact, however, is that there was *a change in the law* made by the part of the section printed by the Committee on Patents in Roman type, and which was not in any way noted as a change.

If one change was so made, why not another, if the change of language from that used in the prior Acts clearly indicates it? It is not material for the purposes of the present argument whether the change was one of "detail" or was "unimportant" or not. If the assumed intent of Congress to exclude *all* changes in the existing law is disproved in a single instance, it disappears as a controlling element, and leaves us free to consider whether changes of language in other particulars also imported changes in the law.

6. But the change from the date of the application to the date of the grant, which, as we contend, was also clearly made by the Revising Commissioners, was also as much one of "detail not affecting the general "policy of the law, and such as the Revising Com- "missioners may well have considered within "their authority to make", and it was no more important than the change which concededly was made.

Furthermore, it was a change *the same in kind* as the one which is conceded to have been made. It merely curtailed the time during which foreign patents might be taken out without limiting the term of the American patent, by eliminating from the time allowed for this purpose the interval between the application and the grant, and in this way still further promoted the patenting of the invention first in this country. Complainant contends that the change from the date of the application to the date of the grant would, in addition to the elimination of this interval of time, work a radical innovation in the policy of the law.

That proposition has been discussed elsewhere and is untenable.

It is sufficient for our present purposes to show that the change which we contend was made did, at any rate, whatever else it may have accomplished, eliminate an interval of time previously allowed for taking out foreign patents without limiting the American term, just as the conceded change did; and that it did promote patenting inventions in this country first, just as the conceded change did.

Moreover, the interval of time eliminated by the change from the date of the application to the date of the grant, is not, under ordinary circumstances, so great an interval as the period of six months which was eliminated by the conceded change in the law. Except in the rare cases where applications are delayed by interference proceedings, patents may be prosecuted to issue in much less time than six months, *if the applicant proceeds with diligence*. Any delay beyond this time is, in practically all cases, the fault of the applicant himself in not preparing his application in proper form, in not submitting proper amendments promptly when required, or in failing to perform some other duty incumbent upon him with relation to the granting of the patent. It is difficult, if not impossible, to obtain any official records on this subject, but it is a matter of common knowledge among those who have dealings with the Patent Office that, even in those divisions which are most crowded with work, the examination is always completed within two or, at the outside, three months after the application is filed, and in most divisions within a far less time than this. It is true that there are a great number of patents besides those delayed by interference proceedings which are not granted, as a matter of fact, until a much longer time after the filing of the application, but in these cases it will practically always be found that the fault is with the applicant and not with the Patent Office. In view of these facts, the Revising

Commissioners may well have considered the elimination of the interval between the application and the grant as a comparatively "unimportant detail" in the carrying out of the general policy of the law in all cases where the applicant proceeded with diligence, and, of course, if the applicant suffered in other cases, it was his own fault. It may also have been, and probably was, their intention to promote diligence in the prosecution of applications by making the limitation of the term by reference to foreign patents depend upon the date of the grant rather than the date of the application.

As we shall show fully further on, no benefit whatever is conferred upon the public in this country by the filing of an application, while a benefit is conferred by the granting of a patent, and thus giving publicity to the invention, and putting it into condition to be worked. The primary purpose of the legislation discriminating against patents for inventions which had previously been patented abroad was, as we have already shown, to secure for this country the first patenting and disclosure of the invention.

The two changes, therefore, are similar in kind, and tend to secure the same object, and they do not differ greatly in degree.

7. The *manner* in which the two changes in the law were effected has an important bearing upon the question whether one was intended to be made and the other not, as appellant contends, or whether both were intended to be made, as we contend.

In both cases the change in the law was effected by a *mere omission of certain words* used in the previous statutes, and the substitution of another word in place of them.

The phraseology of the Act of 1870 is evidently borrowed from the Act of 1839. In the Act of 1839, the

phraseology is, "patented in a foreign country *more* "*than six months prior to his application.*" The corresponding phraseology in the Act of 1870 is, "*first* "*patented* or caused to be patented in a foreign coun- "try." The words "more than six months prior to "his application" are omitted from the Act of 1870, and the word "first" is substituted for them.

Our contention is that the omission of these words eliminated, not only the period of six months, but also the date of the application. The complainant's contention is that the omission of these words merely eliminated the period of six months, and that, although the reference to the date of application was physically removed from the new section as written by the Revisers, yet in spirit it remained by implication.

It is extremely difficult to see how one of these things can be separated from the other. There are only two positions which logically can be taken. One is that the word "first," as used in the Act of 1870, was intended to express in more concise language what was more fully expressed by the words "six months prior to his "application" in the Act of 1839, and that, therefore, *no change whatever* was made in the law. This would, indeed, be logical, but it would involve too violent a wrenching of the language used in the Act of 1870, and the reading in of too much that is not there, to commend itself even to complainant's counsel. The other position, and as we contend the only tenable one, is that the omission of this phrase from the Act of 1870 eliminated both the period of six months and the date of application as elements in determining the meaning of the word "first," and left this word to stand in its obvious and usual grammatical significance.

It is sufficient, however, for our present purposes to show that the method by which, as we contend, the date of the grant was substituted for the date of the application, is *precisely the same method* by which the conceded change in the statute was made, and there-

fore the same reasoning would apply with equal force in both cases.

8. So far as *any* intent of the Revising Commissioners, or of Congress, can be gathered from that change of the law which concededly was made, it affords strong support for our view that the change from the date of the application to the date of the grant was also intended.

The Revising Commissioners and Congress must have had *some* object in view in making the change which was made. The only conceivable object is the one we have already stated, of more effectually promoting patenting in this country first, by curtailing the time during which foreign patents might be taken without limitation of the American term. This object would also be very greatly promoted by the change from the date of the application to the date of the grant, which merely effected a further change in the same direction; and it may, therefore, properly be assumed that this change, which the change of language plainly imports, was also intended.

The evils arising from intentional delays, on the part of inventors or their assignees, in prosecuting applications in the Patent Office have, as we have elsewhere shown, been adverted to by the Commissioner of Patents in his reports to Congress, and, although this abuse of the patent law was probably not as great prior to 1870 as it afterward became, it did, as complainant has conceded, engage the attention of the Revisers and of Congress in the consideration of other provisions of this Act, and it must, therefore, have been known to them at that time.

It is no answer to this to show, as complainant attempts to do, that some remedy for this evil was provided by other parts of the Act of 1870. If Congress had it in mind at all—and it is conceded that such was the case—

its effect must have been considered under all the provisions of the Act, and it may fairly be presumed to have been one of the reasons for making the change from the date of the application to the date of the grant, which the new language clearly imports, when such a change would provide an effectual remedy in the class of cases to which Section 25 relates.

9. Manifestly we are not confined to an examination of *this particular section* of the Act in considering the correctness or scope or intent of the statements of the various committees and of Mr. Jenckes, upon which complainant so confidently bases its argument, since these statements relate to the Act as a whole.

Section 56 of the Act of 1870 provides for a writ of error or appeal to the Supreme Court, without regard to the sum or value in dispute, "in any action, suit or controversy or case, at law or in equity, *touching patent rights*," &c. The prior Act of 1861 (12 Stat. at Large, 130) had provided for such appeal or writ of error "in any action, suit, controversy or case, at law or in equity, *arising under any law* of the United States granting or confirming * * * to inventors the exclusive right to their inventions or discoveries," &c.; and there were similar provisions in the legislation prior to that time.

In *St. Paul Plough Works vs. Starling*, 127 U. S., 376, the Supreme Court held that it had jurisdiction, under the Act of 1870, of a writ of error in a case identical with several prior cases in which it had held that it had no jurisdiction under the prior legislation. Referring to the language previously used in defining the jurisdiction both of the Circuit Courts and of the Supreme Court, Mr. Justice GRAY, in delivering the opinion of the Court, said (p. 378, italics ours):

> "But in the Act of 1870, as in the Revised Statutes, Congress, while using similar language in

defining the jurisdiction of the Circuit Court, *substituted (it must be supposed, purposely) the new phrase 'touching patent rights'* in defining the jurisdiction of this Court."

The Court then held, in substance, that the new language used was broader than the old language, and clearly gave the Court jurisdiction in the case at bar without the necessity of inquiring whether the Court would have had jurisdiction under the prior legislation.

For cases in which the facts were substantially the same, but the Court had refused to take jurisdiction under the prior legislation, see cases cited in *Dale Tile Mfg. Co. vs. Hyatt*, 125 U. S., 46; *Albright vs. Teas*, 106 U. S., 613, and *Hartell vs. Tilghman*, 99 U. S., 547.

The substitution of the new phrase "touching patent rights, therefore, worked a change in the law in a very important matter, extending greatly the jurisdiction of the Supreme Court, but upon examining the House Bill as reported by the Patent Committee, it will be found that this new phrase appears in Roman type, and there is no note or suggestion on the face of the bill or in any of the proceedings in Congress, so far as we can ascertain, that any change in the law was intended.

It is to be observed that the change in law made by this section was a far more important change than the one which we contend was made by Section 25, since it extended the jurisdiction of the Supreme Court to a large class of cases arising in controversies between owners of patents and their licensees, in regard to which it had had no jurisdiction under the prior legislation. The change of language by which this important change was effected was certainly no clearer in its import than that by which the change from the date of the application to the date of the grant was effected in Section 25, and there was far more room for argument in that case

than in this, that no change in the law was intended. Nevertheless, this Court held that the change of language did change the law.

Many similar instances might undoubtedly be pointed out upon a careful study of the bill, but, as we have already said, a single instance is sufficient for the purposes of our present argument.

III.

As to the meaning and effect of the first clause of the section under consideration.

Complainant contends that, under our construction, Section 25 of the Act of 1870 and Section 4887 of the Revised Statutes are "incoherent and confused jumbles "of what is necessary with what is superfluous, working "a change in the law where it was avowed that no "change was intended—a change repugnant to reason "and to prior policy," whereas complainant's construction gives "meaning and effect to all parts of the en-"actment, makes them consistent, harmonious and "not inelegant" (Briefs below).

The reasoning upon which this contention is apparently based, is that the opening clause of each of these sections removed a bar, or what was supposed to be a bar, and therefore constituted remedial legislation; that the bar that was removed must have been co-extensive with some bar that had existed, and the only such bar was a foreign patent for the same invention, granted prior to the filing of the application in this country. It is upon this theory of the removal of a bar that appellant contends that the only possible explanation of the presence of this opening clause can be founded, and that if this theory be discarded, the whole section becomes "a confused jumble."

1. If this argument proves anything, it proves too much; it proves that, even upon complainant's construction of the words "first patented," as referring to the date of the application, the difficulties in dealing with this clause, so graphically set forth in complainant's brief, below still exist.

(a) In view of the other provisions of the Act of 1870, *there was no bar* which the opening clause of this section could by any possibility have removed, and the provisions of the Act on this point are so clear and unmistakable that no one could, by any possibility, have supposed that such bar existed.

Section 24 of the Act of 1870 (which immediately precedes the one under consideration), is as follows:

> "SECTION 24. *And be it further enacted*, that any "person who has invented or discovered any "new and useful art, machine, manufacture "or composition of matter, or any new and "useful improvement thereof not known or used "by others in this country, and not patented "or described in any printed publication in this or "any foreign country before his invention or dis-"covery thereof, and not in public use or on sale "for more than two years prior to his application, "unless the same is proved to have been aban-"doned, may, on payment of the fees required by "law and other due proceedings had, obtain a "patent therefor."

This section provides in substance that "*any person*" who has made an invention may "obtain a patent therefor," provided certain things, which are enumerated, do not exist. Among the things so enumerated as constituting a bar to obtaining the patent, there is no mention of a prior foreign patent *to the same inventor*. The only prior foreign patent specified as a bar is one existing "before his (the inventor's) invention or dis-

covery," and it is manifest that the inventor could not take out a foreign patent before his invention was made.

It is clear, then, that if Section 25 of the Act of 1870 had been omitted entirely, the inventor would still have been entitled to a patent without any limitation of term, notwithstanding his having taken a foreign patent for the same invention at any time, whether prior to the issue of the American patent, or prior to the application for such patent, or more than six months prior to the filing of specifications.

If, then, the opening clause of Section 25 be considered as remedial legislation, or as removing a bar, or as conferring any rights or privileges whatever upon inventors which they would not have possessed fully in the absence of Section 25, this section still remains, even on the assumption that "first patented" means patented before the application, "a confused jumble "of what is necessary with what is superfluous."

(b) Furthermore, on any possible interpretation of Section 25, and assuming the existence of Section 24, the *only* effect it actually had was to impose a limitation of term upon *some* patents. For the purposes of the present argument, it is not material whether the class of patents upon which such limitation was imposed was a larger class or a smaller class; whether it extended only to the case of patents for inventions which had been patented abroad before the application was filed, or included also those for inventions which had been patented abroad after the application here but before the American patent was issued. In either case the section, as a whole, removed no bar, conferred no additional rights or privileges, but *merely curtailed the term* of certain patents. That was its only possible effect, whether appellant's construction or our construction of the words "first patented" be adopted.

It is no answer to this to say that if, as we contend, it was the sole object of the section under consideration to impose a limitation as to certain patents, and substitute the date of the grant for the date of the application, this object could have been accomplished by the use of much more concise language. Precisely the same thing is true under appellant's construction. Appellant contends that the object intended to be accomplished was to impose a limitation upon certain patents, and leave the date of application standing, but omit the period of six months prior to the application.

Each of these constructions involves *some* change from the old phraseology, and each is susceptible of being carried into effect by the use of much more concise phraseology than was in fact adopted by the draughtsman of the Act of 1870. Taking the form suggested by complainant's brief below to fit *our* construction, a very slight change of wording would make it fit *his* construction equally well. By merely substituting "application for" in the place of "issue of" it would read as follows:

> "In case any foreign patent shall have been "issued prior to the application for the patent in "this country, the latter shall be limited to seven- "teen years from the date or publication of the "foreign patent."

Can there be any possible doubt that this provision would mean precisely what complainant contends Section 25 did mean as it came from the hands of the Revisers, or that the phraseology used by the Revisers in fact had any effect whatever which this provision would not have had?

(c) In any aspect, also, even upon complainant's construction, this section is open to the charge of "working "a change in the law where it was avowed that no change "was intended." It confessedly dropped the six months

limitation; and this was not only a change in the law, but it was, as we have already shown, a change as inconsistent with the avowals of the various committees and of Mr. Jenckes (which are doubtless those referred to by complainant) as was the change from the date of the application to the date of the grant.

The change effected by dropping the six months limitation is constantly referred to in complainant's briefs as one *intended* to be effected by the Revisers, and the change from the date of the application to the date of the grant as one that could not have been intended. Upon what is this assumption based? There is no evidence of any *declaration* of any such intent with reference to the six-months limitation by the Revising Commissioners, or any one else, and it is a mere inference from the change of language.

The same inference is equally well founded, and equally strong, with reference to an intent to substitute the date of the grant for the date of the application.

On any theory, therefore, that this clause, taken by itself, constitutes, or was intended to constitute, *remedial* legislation, or *a positive enactment* for any purpose, all of the difficulties to which complainant refers are still present; and, if complainant's argument proves anything, it proves that even on its own theory of the meaning of "first patented," the opening clause of this section is wholly meaningless and nugatory, and that the section, as a whole and in its original form, changed the law.

2. All these difficulties disappear, however, if we consider this first clause as a mere introductory recital, specifying, by way of inducement, the class of cases to which the limitation of the second clause is to be applied in the form of a proviso; or if we refer it to

the general bar provided by Section 7 of the Act of 1836.

The phraseology of this first clause was evidently borrowed from the Act of 1839. In that act the clause had two distinct functions. It removed a bar (that imposed by the Act of 1836 and prior acts), and it described the class of cases to which the limitation specified in the second clause, which was in the form of a proviso, was to be applied.

The most cursory examination of the Act of 1839 will show that *both* of these functions were essential functions of the first clause as it appeared in that Act. Doubtless the revisers desired to preserve, as far as was consistent with the changes they intended to make in other respects, the phraseology of the prior Acts; and they adopted the phraseology of the opening clause of the corresponding section of the Act of 1839 for the purpose of subserving the *second* of these two functions, the first function having been fully provided for by the preceding section (Section 24 quoted above) of the new act.

It is to be observed, however, that the revisers did not adopt bodily the phraseology of the first clause of this section as it stood in the Act of 1839, as they would have done if they had intended to preserve the same scope and extent of this second function as it had had in the prior Act. They changed the language in order to make it conform to the scope they desired to give the second clause in the form of a proviso, omitting, not only all reference to the period of six months, but also *all reference whatever to the date of filing the application*, and thus leaving the comparison to be made between the dates of *patenting* in this country and abroad for the purpose of ascertaining whether the limitation provided for was applicable in any given case or not.

The section, as a whole, must be taken as reading:

"No person shall be debarred from receiving a patent "for his invention, &c., as is provided by the preced- "ing section, by reason of its first having been pat- "ented in a foreign country, but this must be taken "subject to the proviso that the patent shall in that "case be limited, &c."

This is an entirely logical and consistent explanation of the presence of this first clause in the section and of the relation of the two clauses to each other. On *any* theory of the meaning of the words "first patented," the first clause *is a mere recital* of what had already been enacted in Section 24 of the same act as to one class of patents, and must be treated as such in substance, if not in form.

The same reasoning applies to the slightly changed phraseology adopted in Section 4887 of the Revised Statutes, and this construction is made even more evident by the use of the word "But" to introduce the second clause. The first clause states what, beyond dispute, had been fully accomplished by the preceding section (Sec. 4886) as to one class of patents, and then proceeds to specify by the second clause, commencing with "But," an exception to the general provisions of Section 4886, by imposing a limitation of term on such patents as fall within the class specified in the first clause.

3. This explanation of the presence of the first clause of the section under consideration is, as we have already shown, fully supported by the history of the legislation on this subject, and no other explanation can be found in the history of such legislation.

It is merely a case of the survival of the *form* of phraseology used in prior acts, after a part of the functions of such phraseology has become obsolete by reason of other legislation. This is not by any means an unusual occurrence, especially in revisions of the law, where the revisers naturally follow, so far as prac-

ticable, the ancient phraseology, and make only such changes in the language as are necessary to conform it to the changes which they desire or intend to make in the law.

In this case the revisers followed the former phraseology, preserving it for one of the functions it had formerly subserved, but they did not adopt the former phraseology entirely; they made important changes in it. It is conceded that these changes of phraseology did make *some* change in the law. Our contention is that they made the full change which the change of language imports; but complainant contends that only a part of this change was intended, and, therefore, only a part of it was, in fact, made.

It is submitted that our contention is the only one that finds any support in logic or in the established rules of interpretation.

IV.

As to the general policy of the legislation prior to 1870, in regard to patenting abroad.

Complainant contends that it was the ancient and established "working plan" (whatever that may mean) and policy of the Patent Statutes prior to 1870, to make the date of the application in this country the "crucial date" in determining what foreign patents are to be considered as limiting the American term, and thereby to encourage patenting both in this country and abroad; and that, under our construction, Section 25 of the Act of 1870 would involve so radical a departure from this established plan or policy that Congress cannot have intended that such a construction should be put upon it.

Our reply to this is that, in the first place, no such general plan or policy as is here suggested has ever

been declared by Congress or the Courts, and that it cannot fairly be deduced from any of the prior legislation on the subject; and, secondly, that Section 25 of the Act of 1870, as construed by us, is not in any way a departure from the general policy which did underlie this legislation, but, on the contrary, is entirely harmonious with it and well calculated to effectuate it.

FIRST. There is no warrant for complainant's assumption that the date of application in this country was advisedly, and *as an essential part* of the general policy of the legislation on this subject, made the crucial date in determining what foreign patents should limit the term of the American patent, or that it was the intention of Congress in such legislation to *encourage* patenting abroad, as well as patenting in this country. On the contrary, under the acts prior to 1836 the existence of a foreign patent when the home patent was issued was a bar and made the home patent invalid.

By Section 7 of the law of 1836 the same effect followed, and Section 8 of that act was needed and was passed in order in the case specified to allow a home patent notwithstanding the existence of a foreign patent.

Under all acts the allowing of a home patent notwithstanding a foreign patent was the exception to the rule, and the claimant had to bring himself within the exception.

1. The date of application was not made the crucial date at all for this purpose in *any* of the prior legislation.

The Act of 1839 is the first and only act prior to 1870, which prescribed a limitation on the term of the American patent as a condition of its not being made invalid by reason of the same invention having been patented abroad, and in this Act the crucial date is not the date of application, but a day six months prior to that date. It is, of course, true

that the crucial date in this case was determined by reference to the date of application, and that in this sense the date of application may be considered as indirectly fixing the crucial date, but this consideration is, nevertheless, of importance in view of the fact that, whatever else the Act of 1870 may have done, *it certainly did not follow the Act of 1839* in this respect, but concededly made a change in the crucial date. Even on complainant's construction, the crucial date was moved forward six months.

In all of the Acts prior to 1836 the only effect a prior foreign patent had upon the American patent was to invalidate it if the foreign patent was granted before the patent in this country, and under the Act of 1836 a foreign patent granted more than six months prior to the filing of the specifications had the same effect; and neither in the last-named Act, nor in those that had preceded it, was there any provision for any limitation of the term of the American patent as a condition of its issue notwithstanding the foreign patent.

2. Nor is there any warrant for appellant's assumption that it was the purpose of the prior legislation on the subject to *encourage* patenting abroad as well as patenting in this country.

No such purpose of the legislation has ever been declared by Congress, nor, so far as we can ascertain, by the Courts; nor has Congress any power to *encourage* patenting abroad. It was undoubtedly the purpose of this legislation to make patenting abroad no objection to patenting in this country, but it is to be observed that such permission has never, under any of the legislation on the subject, been without effect on the right to a home patent; on the contrary, under all of the different Acts of Congress relating to patents, patenting abroad has been made either to deprive the inventor altogether of his right to a patent in this country or to affect the term of his patent.

3. Even assuming that the date of application was the crucial date in the prior legislation for determining the question as to what foreign patents should limit the term of the American patent, this was merely incidental to the main purpose of the legislation on the subject, and in no way formed so essential a part of such legislation that the selection of some other date for the purpose would work a radical departure from any general policy of the law.

The reasons given by complainant in support of its contention, that the selection of the date of application as the crucial date was an essential part of the established policy of the law, will not bear examination.

(a) A studious attempt is made to convey the impression that the date of the application has always been a controlling and important one indetermining an inventor's right to a patent in this country, and that, therefore, this date was not only the natural and proper one, but the only one, to select for the purpose now under discussion.

This is a wholly erroneous view of the law. Prior to 1836 the date of the application and of issue were practically the same; since the Act of 1836 was passed, the date of the *invention* or discovery hasbeen the important and controlling date with reference to the inventor's right to a patent, and the date of application has been of little importance. Under the legislation prior to 1836, any patent, publication or public use prior to the date of application barred the right to the patent. Since the Act of 1836 was passed, the patent or publication, if in existence at the time of the examination, barred the right to a patent except as allowed by Section 8.

Under the Act of 1836, and all the legislation since that time, the inchoate right of the inventor to the patent accrues at the date of his invention or discovery, and this right is perfected, and becomes abso-

lute upon the performance of certain other acts by the inventor, of which the filing of the application is only one, as before stated. As, therefore, the inventor's right to a patent neither originated with the filing of the application, nor was perfected by it, under the legislation since 1836, there was no special reason for selecting the date of the application rather than the date of the invention or that of the grant, for the purpose of determining by reference to it whether the foreign patent should limit the term or not.

(b) Nor is it true, as complainant assumes, that the filing of the application constitutes the *disclosure to the public* which is the consideration for the granting of the patent, or that it confers any benefit whatever upon the public.

Complainant argues that it never could be the policy of the law to make the inventor suffer for delays "after "he has made a full disclosure of his invention"; and that "the disclosure by the inventor, and the "sole act of the inventor, was the application"; and that the filing of the application constitutes the disclosure of the invention in consideration for which the patent is granted.

Now, under our law and the established practice of the Patent Office, *the filing of the application and of the specification is not a disclosure at all.* They are kept in the secret archives of the Patent Office, and no one is allowed to examine them except the officials of the Patent Office. Until the patent is actually issued, the specification and drawings are merely confidential, privileged communications, as has been frequently held by the Courts, and the public can obtain no knowledge from them in regard to the invention. This is manifestly not such a disclosure as the patent law contemplates, and it is therefore not *the* disclosure in consideration for which the patent is granted.

Nor is it true that the filing of the application by the inventor is, as is asserted by the appellant, the *only* act of the inventor necessary for making such disclosure. In order to make any disclosure at all, he must prosecute his application to issue and pay the final fee. If he fails, either to make proper amendments, or to pay the final fee, or to comply with any of the other provisions of the law, the patent will never issue, and there will never be any disclosure. For the purposes of the disclosure, the subsequent acts on the part of the inventor are as essential as is the filing of the application.

Nor is it true that the filing of the application is the sole act the date of which the inventor can control. He can control the date of issue of the patent. It is true that there is some interval of time between the filing of the application and the issue of the patent consumed in making the necessary examination over which the applicant has no control, but as to all other matters he has complete control of the date of issue. He can expedite the issue of the patent, or he can retard it at his pleasure, within wide limits, and the date at which the patent is finally issued is always fixed by the applicant by his payment of the final fee.

Prior to the enactment already referred to in the Act of 1839, all the provisions of the law with reference to a prior foreign patent for the same invention had relation solely to its effect as a publication of the invention before the application here. The effect of the legislation was to relieve the inventor, to a greater or less extent, from its effect as a *publication* of his invention, and place it upon a different footing in this respect from the case of a foreign patent for the same invention granted to another inventor than the one applying here.

Thus, the original Patent Act of April 10th, 1790, required that the invention for which a patent might be issued, should not have been "before known or used." This was repealed by the Act of February 21st, 1793,

which gave to a citizen of the United States a right to the patent for an invention "not known or used before "the application," and this privilege was, by the Act of April 17th, 1800, extended to aliens of a certain class, and thus the law remained until the Statute of 1836.

Under these laws, prior to 1836, an inventor was not allowed to obtain a patent for an invention known or used before his application, even if he were the first inventor. The right of the public to anything known or published prior to an application for a patent therefor in this country was regarded as superior to that of the inventor, and no reservation was made in respect to the publication of the invention, even where that publication consisted in a prior foreign patent for the same invention granted to the applicant himself. Therefore, if the inventor published his invention, either here or abroad, prior to his application, he could not obtain a patent.

By the law of 1836, a change was made in respect to the prior publication of the invention. It was provided that taking out a patent abroad for the same invention, and the publication of such foreign patent at any time within six months next preceding the the filing of the specifications and drawings should not be deemed such a publication as would bar the right to a patent.

The intention of this provision appears to have been to allow a reasonable time after the publication of a foreign patent for the inventor to take out a patent in this country. Six months was fixed as the limit, so that the public here, on learning of the invention through the publication of a foreign patent, would know that the inventor might, nevertheless, apply for a patent here for the same invention, and obtain one, if it was taken out promptly; and it was assumed that it would be taken out promptly if the specifications and drawings were filed here within the very short period of six months after the foreign grant was published.

Then came the Act of 1839, which, by its sixth section, provided, *first*, that the patenting abroad more than six months prior to the application here should not debar an inventor from receiving a patent, provided the invention had not been introduced into public and common use in the United States prior to the application.

This provision, while it relieved the inventor entirely from the effect of his foreign patent *as a publication* of the invention, for the first time brought into prominence the question of a double monopoly. It was obvious that if the inventor's right to obtain a patent here was not affected by a prior foreign patent, provided there had not been any public or common use of the invention in the United States, he might enjoy a monopoly abroad for the full extent of the term of the foreign patent, and then come here and obtain a second monopoly in this country.

To prevent this result, and to properly preserve the rights of the public in case of a double monopoly, it was, therefore, further provided that the enlarged class of patents here, covering inventions patented abroad more than six months prior to the application, should be limited to the term of fourteen years from the date of the publication of the foreign patent. Fourteen years was then the term of all American patents, with the possibility of extensions.

This provision did not limit the term of the American patent, either by reference to foreign patents taken out less than six months before the application, or by reference to foreign patents taken out between the application and the grant. It may well have been regarded, especially with the short term of fourteen years which then prevailed, that the possible extension of the term of the American patent beyond that of the foreign patent need not be provided for, where the foreign patent was taken out during the period between six months prior to the application and the date of the American grant; but afterwards, when

the term of all American patents had been extended to seventeen years, and the Act of 1870 came to be passed, it was seen that it was necessary to enlarge the class of foreign patents which limited the term of the American patent, and, therefore, it was extended, as the Act says and as the defendants contend, so as to include all foreign patents issued prior to the grant here, and the complainant itself admits that it was extended so as to include all those issued within six months preceding the application, but argues that it ought not to extend any further, and that, therefore, the interpretation of the statute according to the plain import of the language used must be abandoned.

We insist, for reasons set forth elsewhere, that there is no foundation in reason, policy or judgment for this assumption. The provision in no respect prevents an inventor who has patented his invention abroad from obtaining a patent here; it only provides a different term for the American patent in such cases, and in determining that limit, there was no reason why the lawmakers should not take into account foreign patents granted after the application and before the grant, as well as those issued within six months before the filing of the specifications and drawings.

The point here under consideration, however, is that there is a wide difference between the effect of a foreign patent as a *publication* of the invention and its effect as a reason for *limiting* the American grant; and provisions having relation to its effect as a publication do not afford a basis for provisions having regard solely to its limiting effect.

THIRD. The only general policy and intent of Congress which can be deduced from the legislation on this subject prior to 1870, is the promotion of *patenting*

first in this country where an invention is to be patented both in this country and abroad.

As we have shown above, an invention is usually introduced or worked first in the country in which it is first patented, and it would, of course, be beneficial to the public in this country to have inventions introduced and worked here at as early a date as possible.

Under the legislation down to 1836 this main object was promoted by making the existence of a foreign patent a bar to the patent here.

Under the Act of 1836 some departure was made from the provisions of this prior legislation by permitting a patent to be taken out abroad within six months prior to the filing of the specifications, &c., here without invalidating the American patent, and under the Act of 1839 a penalty was imposed for failure to proceed promptly in this country, by shortening the term of the American patent.

The object sought to be accomplished in all cases, however, was *not the mere filing of the application* at an early date, but the *issue of the patent* at an early date, since, as we have already shown, no benefit whatever is conferred on the American public by the mere filing of the application.

There is no conceivable reason why the *mere filing of an application* in this country at an early date with respect to the granting of a foreign patent should form any ground for discrimination with respect to the length of the term of the American patent, except so far as the early filing of the application is assumed to carry with it the early granting of the patent. The *early granting of the patent* in this country, as compared with the granting of patents for the same invention abroad, is, and always has been, the object sought to be required by legislation on this subject; and with reference to *this* object, the early filing of the application is merely an incident.

FOURTH. The main purpose and object of the legisla-

tion prior to 1870, therefore, affords no reason for selecting the date of the application as the "crucial date" with reference to limitation of the term of the American patent by foreign patents for the same invention; on the contrary, the date of the grant would subserve this purpose better in all respects, as we have fully shown.

By selecting the date of the grant rather than the date of the application, delays in the prosecution of the application in the Patent Office, so far as the inventor could control them, would be discouraged; and the early granting of the patent, as compared with the granting of patents for the same invention in other countries, would be required.

FIFTH. Nor would the selection for this purpose of the date of the grant, rather than the date of application, subject the inventor to any undue hardship or inconvenience in obtaining patents abroad as well as in this country.

We have considered this matter fully elsewhere, and have shown that it is not only entirely possible, but has been demonstrated by many years' actual experience to be entirely practicable, under the present law, construed as the Circuit Courts have uniformly construed it and as we contend it must be construed, to obtain valid patents both abroad and in this country, without any limitation of the term of the patent in this country, except in the very rare cases which form such exceptions to the general rule as the law can never adequately provide for.

SIXTH. The change, so far as the law of 1839 is *concerned*, from the date of the application to the date of the grant effected by Section 25 of the Act of 1870 was, therefore, no innovation upon, or departure from, the policy of the law established by prior legislation on the subject; on the contrary, it was entirely in line with

the policy of the law, and well calculated to promote the main object required by the prior legislation. It was merely an improvement and extension in detail of the general scheme of the prior legislation sought to enforce.

There is, and can be, no presumption, therefore, from the nature of the change effected, that Congress did not intend Section 25 of the Act of 1870 to mean precisely what its language imports.

V.

As to the appellant's contention that Section 25 of Act of 1870 is, under our construction, inconsistent with other provisions of the Act, and would be practically unworkable, and lead to intolerable hardships.

These propositions may conveniently be considered together, as the argument from inconsistency is based upon alleged inconveniences in applying the provision in question.

1. It is alleged that, if an American patent may be limited by any foreign patent issued prior to the grant here, an inventor may assign his invention and right to a patent here, and thereafter obtain a foreign patent, the effect of which would be to limit the term of the American patent the right to which he had assigned.

In the first place, assuming this to be true, how does it affect the question?

The assignee cannot get a better title to a patent than his assignor had to convey; but he can provide by covenant, or otherwise, that his assignor shall not patent the same invention abroad prior to the American grant, and have his proper remedy if his assignor defrauds him in that respect. The possibility of such a fraud is too remote to be weighed against the policy of limiting American patents granted for inventions previously patented abroad. It is entirely

competent for the assignee to protect his interest by agreement between the parties.

In the second place, the same difficulty is present under appellant's construction. An assignment may be made before the application as well as afterward. The law does not limit the right of assignment to the time subsequent to filing the application, and, as a matter of fact, inventions, and the patents to be obtained for them, are assigned more frequently before the application is filed than afterward. If the assignment is made before the application is filed, what is there to prevent the inventor from impairing the rights of the assignee by taking out foreign patents before he files his application?

The principle is the same in both cases, and the difference is, at the most, a mere matter of degree.

2. The provision requiring that applications for patents shall be examined, discloses, it is argued, a purpose on the part of Congress inconsistent with the plain interpretation of the act.

It is a little difficult to follow the argument based upon this allegation. If understood, the position is, that, because the statute orders the examination to take place on the filing of the application, *therefore*, the applicant acquires an inalienable right that the term of the patent subsequently granted to him shall not be affected by any event occuring after the application. This is only another instance of one of the fallacies upon which the appellant's argument is based. It is assumed, *first*, that an inventor's right to a patent rests, not upon the fact of his having *made an invention*, but upon the fact of his having *filed an application*; and, *secondly*, that it is an impairment of his right to a patent for the law to provide that different classes of patents shall have different terms, or that the duration of the term may be governed by any event the

Legislature may choose to name occurring before the grant.

Appellees submit that both of the appellant's contentions in this behalf are without foundation; and, if this be so, the suggestion that the direction for examining applications at the time of filing has anything to do with the question in hand, falls to the ground.

3. It is also urged that the provisions of law requiring the oath to the application is inconsistent with the statute, if plainly interpreted.

The same answer applies to this as to the former, namely, the argument depends upon the unwarrantable assumption that, if a person has not patented abroad when he files his application here, the filing gives him an inalienable right to a *seventeen-year* patent, notwithstanding the fact that he may subsequently, and before the grant, patent the invention abroad, and so become entitled to a fifteen-year patent only, at the time of its issue.

In respect to the provision requiring a statement on the part of the applicant at the time of filing the application as to any prior patents for the same invention which may have been taken out abroad, much stress is laid upon the assumed impracticability of ascertaining whether or not an invention has been patented abroad before the grant, and the supposed facility of determining whether it has been patented abroad before the application.

It is respectfully submitted that this difficulty is exaggerated beyond all measure by the eminent counsel for the appellant. If desirable for public information, it is impossible to conceive that there is the slightest difficulty in requiring a statement from the patentee as the last step before issue in regard to any foreign patents granted up to that time. As a matter of practical concern, those dealing in pat-

ents never need experience any serious difficulty in ascertaining the existence of foreign patents, which are public documents, issued prior to the grant.

The practical difference in this behalf between fixing the date of application and the date of grant, as the limiting date, is too trivial for serious consideration. Complainant's counsel have failed to show a single litigated case where any purchaser of a patent has been deceived by the existence of a prior foreign patent for the same invention. It is a simple matter to search the title of any patent, both as to domestic conveyances and as to prior foreign patents.

The law does not require that the limitation of the term shall be expressed on the face of the instrument, but all patents are granted for seventeen years, and the limitation is a matter of law, to be derived from extrinsic facts.

Bate ex. Hammond, 129 U. S., 151, 169.

To argue that the supposed greater difficulty of ascertaining what foreign patents have been issued before the granting of the patent, as compared with the difficulty of ascertaining what foreign patents have been granted before the application, creates an inconsistency between the different provisions of the act, if the section under consideration be plainly construed, seems a total misapplication of terms.

Moreover the question here is as to foreign patents taken by the *same inventor*. He, of course, knows what he has done up to any assigned period of time.

4. The fact that an application for a patent may be delayed in the Patent Office by an interference suit, or that the applicant may be compelled to resort to a bill or in equity to obtain his patent, is urged with great commencement as a reason against the interpretation of the according to the plain meaning of its lan-

It is fu and by the same misuse of terms these provi-

administer the act are alleged to be " inconsistent " with

that interpretation, when what is meant is that the law so interpreted imposes a supposed hardship.

In the first place, it is to be observed that it is not a reason for deviating from the plain interpretation of the statute, that such an interpretation may, in some cases, impose a hardship, to *some* extent, on *some* persons. The statute, in this case, is passed for the greatest good of the greatest number, and the change which would relieve the few from a possible hardship, would inflict an injury, or at least create a disadvantage, in respect to the public, which it was the very object of the statute to avoid.

In the next place, the supposed hardship, both in respect to its frequency and extent, is very much less than would be imagined from the argument of our learned opponents.

A majority of interference cases are determined by the filing of the preliminary statement without litigation. Where they are litigated and excessive delay ensues, it would be a moderate estimate to say that, in ninety cases out of one hundred, such excessive delay is due to the applicant or his attorney. Judicial experience is a sufficient warrant for the statement that the delay in pleading, taking testimony and arguing causes is not the act of the Court but the act of the party.

So, too, the remedy by bill in equity is rarely resorted to; not once in ten thousand, probably not once in twenty thousand times; the presumption is that the officers of the Patent Office will do their duty, and promptly grant an applicant such patent as he may be entitled to.

As stated elsewhere, if an applicant enters the Office with a specification that fairly and truthfully descri[bes] his invention, claims what is new, so far as the i[nven]tor's knowledge actually extends, and claims n[o] time. he will obtain his patent in from sixty to nin[ety] pat-

at the farthest, and it will be a rare exception that he will be obliged to resort to a bill in equity, and a most infrequent contingency that he falls into any interference.

The Bell Telephone patent, which has so frequently been before the Courts, was applied for February 14, 1876, and issued March 7, 1876; the Edison Lamp patent, was applied for November 4, 1879, and issued January 27, 1880; and these are believed to be fair samples of the promptness with which patents are issued where the application is prosecuted diligently and in good faith, even in what is notoriously the busiest division of the Patent Office.

In those few cases where hardships do occur, it must be presumed that the Legislature deemed that the fundamental benefits to be secured by the act, and the greater evils which might ensue if the date of application were made the controlling date in respect to limiting the term of the patent, far outweigh the consideration of the possibility of hardship in some cases.

It may be further observed, in regard to the supposed hardship of eating up the American term by the delay in the Patent Office, that the patentee all this time is *enjoying his foreign monopoly*. The hardship inflicted by the delay is merely the deprivation of so much of his *double* monopoly. If he deems the American patent of so much more value than the foreign patent, then let him wait until his American patent is ready to issue before he patents abroad. If the invention is not a valuable one, the loss is small; if it is a valuable one, a patentee who is enjoying a large revenue from his foreign patent has small cause to complain of hardship if he chooses to patent first in a foreign country and reap the benefit of his invention there.

It is further to be observed that the statute has been administered (with the exception of a very brief inter-

val during Commissioner Paine's incumbency in 1880) from 1870 to the present time, a period of nearly twenty-five years, in accordance with the interpretation for which the defendants contend, and the "intolerable hardships," the "unworkable" terms imposed by the statute have never made themselves felt to an extent sufficient to attract attention or lead to an appeal to Congress, or produce any marked remonstrances on the part of inventors. The principal opposition to the interpretation which the Courts have placed upon the law, and to its long and smooth working, has emanated from a single source, and that a source which can scarcely be trusted as a representative of a supposed oppressed inventor, and certainly not of the interests of the public at large.

Except in cases of such rare occurrence that the law cannot be presumed to take cognizance of them, there is, as a matter of fact, not only no hardship to inventors involved in the present provision of the law as we construe it, but the experience of many years in working under it, has conclusively demonstrated that there is no difficulty whatever involved in patenting an invention, both in this country and abroad, without impairing the validity of any of the foreign patents, and without any limitation of term of the American patent.

The usual practice is, and has been for many years, to file the application in this country and prosecute it to allowance; then to send the applications for the various foreign patents abroad with instructions to have them filed on a certain day, and then to pay the final fee here and have a patent issued on that day. When this is done, the American term of course is not limited, and the validity of the foreign patents is not affected in any country. This has been the uniform practice in this country at least since Judge NIXON'S decision in the case of *Bate vs. Gillett*, and was also the common practice among intelligent solicitors of patents long before this case had emphatically called

the attention of the public to this provision of the law. It is safe to say that at no period in our history have so many patents been taken out as during the past ten years, and that at no period have inventions been so generally patented in foreign countries, and yet the instances in which any limitation of the term of American patents has been imposed, or in which the validity of any foreign patent has been affected by the law as it now stands, are so few that one can hardly be found.

Under this practice the main object of legislation in securing the patenting of inventions first in this country has been greatly promoted by putting a penalty upon undue delays in the prosecution of applications in the Patent Office. Although there have been some notable instances of great delay in the prosecution of the application, in the main, applications for patents for inventions of sufficient importance to warrant taking out patents for them both here and abroad, have been prosecuted diligently, and with the result that the inventions have been patented in this country before they were patented in any foreign country, to the great and manifest advantage of the American public.

The few notable exceptions to this rule show what great abuses would exist under the interpretation contended for by the appellant.

It is true that, prior to the decision of Judge NIXON in the case of *Bate vs. Gillett*, there were a few instances in which American patents were limited by foreign patents, through the inadvertence of inventors or their ignorance of the law, or the bad advice of their counsel. It is for the benefit of these few patents that this Court is now asked to adopt a wholly different interpretation of the law from that which has been followed by all the Circuit Courts for the past ten years and upward; and the principal argument brought to bear is the hardship imposed upon the owners of these few pat-

ents. If the case is to turn upon any consideration of hardship, we respectfully submit that the great hardships that will be imposed upon established industries which have been created in reliance upon the reiterated decisions of the Circuit Courts interpreting the statute as we contend it should be interpreted, ought to have greater weight than the alleged hardships of the owners of these few patents; but, as we have already said, the consideration of hardship has, in our view, nothing whatever to do with the case.

The whole argument on the ground of hardship rests upon the assumption, not only that an inventor has a right, if he can do so, to get patents for his invention in all the countries of the world (which may be admitted if the foreign law gives it), but also that when any inventor, American or foreign, takes out a patent here, it is an intólerable wrong and absolute forfeiture of his right, if we don't choose to offer him as much for his invention as if he had not patented it abroad.

This position is untenable.

It is perfectly reasonable that a discrimination *in favor of the public* should be made in respect to different classes of patents. While the law is liberal and imposes no unjust restrictions upon the exercise by American inventors of the privilege of patenting their inventions in different countries, yet in doing so it is equally just and wise to keep in view the fact that the paramount object of all patent laws is not the benefit of the individual or the interest of foreign countries, but the benefit of the people of the United States.

Since the Act of 1836, the law has made no distinction on the ground of citizenship in regard to the right to obtain an American patent. Inventors who apply for patents here, and then take out foreign patents before the American patent is granted, are not all American citizens. They may be, and frequently are, foreigners, and it can scarcely be argued with any show of

force that a foreigner, who has applied for a patent here, has acquired an inalienable right to a seventeen-year patent which cannot be affected by any patent for the same invention issued previous to the grant here if he chooses to take out such a patent in his native country.

It must be admitted that a provision limiting the term of American patents was dictated from some reasonable considerations. It is a provision solely in favor of the public, and whatever those considerations may have been, however persons may differ as to their wisdom, there can be no difference as to the point that the restriction owes its existence to considerations of what under such circumstances is the fair and proper price to pay.

That the language used in a statute passed for such a reason can be disregarded, or wrested from its direct meaning as repugnant to the supposed intention of the Legislature, because it inflicts hardships of the kind and character which its enforcement might sometimes inflict in this case, is a proposition which, it is respectfully submitted, cannot be maintained. It would be a direct violation of the fundamental canon of interpretation that does not permit words to be wrested from their plain meaning except in cases of manifest absurdity, or where the plain interpretation would beyond all doubt defeat the legislative intention.

VI.

As to the contention that appellant's construction has no support of contemporaneous executive opinion.

Counsel for the defendants understand the fact to have been otherwise than as contended by the complainant As already stated, with the exception of a brief period when Commissioner Paine decided in *ex parte Mann* that the Act of 1870 did not apply where the foreign

patent was taken out subsequent to the application, the uniform practice of the office has been in accordance with defendants' interpretation of the statute. *Ex parte Mann* was soon overruled, and it appears that it was subsequently discredited by Commissioner Paine himself.

At the time when the Act of 1870 was prepared and passed, Mr. Fisher was Commissioner of Patents. He appeared before the House Committee on Patents (C. G., 2d Sess., 41st Cong., p. 2872), and was in a position to be thoroughly familiar with the changes effected by the law, both while the act was under discussion and after it went into effect.

In October, 1870, immediately after the passage of the act, Mr. Fisher, in *ex parte Smith and Skinner*, ruled that Section 25 of the Act of 1870 was not confined to patents issued on applications subsequent to the dates of the foreign patents. He says (italics ours) :

> "In the cases of Ward and Boyer I held that "the grant of a foreign patent before the issue of "an American Patent was fatal to the application "for the extension of the American patent if the "foreign patent expired before the original term "of the patent sought to be extended. *It is im-* "*material whether the American patent was applied* "*for before the foreign patent or not. This was* "*important under the first laws, but no such dis-* "*tinction exists under the Act of 1870.*
>
> "This invention was patented in England, "France and Belgium on October 17, 1856, *prior* "*to the grant of the American patent*, and the "English patent has already expired. This point "is fatal to the present application."
>
> Commissioners' Decisions, 1870, pp. 131, 132.

This was the *true contemporaneous construction* of the Act of 1870, promulgated by the head of the Patent Office, in pursuance of his official duty, and binding upon all practicing in the office until overruled.

What Mr. Fisher understood to be the purpose and policy of the act may be gathered from his opinion in *re Ward*, referred to in the above extract. He says:

> "In the case of Mushet it was a foreign inventor, and in the case of Ward an American inventor, who were seeking the extension; but in both cases letters patent were first obtained in the foreign country. Section 25 of the Act of July 3, 1870, is as follows [Section 25, quoted]:
>
> "I was, and am, of the opinion that the policy which Congress plainly declares in this section is that, if a foreigner obtain a patent in his own country and permits it to expire there, it shall also expire in this country, so that the right to use the invention without liability to the inventor shall be simultaneous in this and in the most favored foreign nation. * * *
>
> "It is urged, however, that Congress intended only to reach the case of the foreign inventor who first patented his invention in his own country, and that they did not intend to put the American inventor, who obtained a patent abroad, in a worse position than if he had obtained no patent at all in a foreign country. It is said with much force that, if the American patentee had not obtained an English or French patent, the invention would be free in those countries, even during the lifetime of his original patent, and that the fact that it was free there would be no bar to the grant of an extension.
>
> "This may be true, but we have no means of judging of the intention of Congress in this case, except by the language employed in the declaration of their will. The language of the statute is

'first patented, or caused to be patented, in a 'foreign country.' This, by its terms, includes American citizens as well as foreigners who *first* take out a patent abroad. The term 'patented' may well be construed as applying to foreigners obtaining patents in their own country, and the phrase, 'caused to be patented,' to such persons not citizens of the same country, including Americans, as should cause their inventions to be introduced or patented there. It does not include either foreigners or citizens who first obtain their patents in this country. It was supposed that American inventors would first obtain their patents here, in which case they would not have been within the terms of the section, but if, on the other hand, they chose to obtain patents abroad before doing so in their own country, they were to be placed upon the same platform as the foreign patentee."

Com. Dec., 1870, pp. 30, *etc.*

This construction of the Act of 1870 was prior to the passage of the Revised Statutes in 1874, and must have been known to the Revisers and to Congress; yet the language adopted in the Revised Statutes is, if anything, more favorable to appellees' contention. If Congress had not been satisfied with this construction, it would certainly have used language sufficient to make the contrary meaning plain.

Complainant's counsel referred to certain rules of the Patent Office, requiring the applicant whose invention has been patented abroad to state that fact, and to take an oath with reference to the introduction of the invention into the United States; but these rules do not support complainant's contention. The rules were perfectly proper under either interpretation of the statute. It was advisable to obtain all the information bearing upon the point which the applicant could offer

at the time he filed his specifications; especially as applications where a foreign patent had already been granted were privileged as to the order of examination (Patent Office, Rule 29, Edition 1877; Rule 63, Edition of 1888).

So far as concerns the interpretation of the act as to the point under discussion, the rules prove nothing. The only decision of the Patent Office adopting complainants' construction is that already referred to, of Commissioner Paine in *ex parte Mann*, decided in 1880. But it appears by the correspondence between Commissioner of Patents Marble and Mr. Kirkwood, the Secretary of the Interior, in 1882, that the construction adopted by Commissioner Paine was speedily abandoned by the Office, and, with a short interval, the construction of the act by the executive department has been that contended for by defendants from the time of its passage down to the present time.

The correspondence in question appears in the files of the Department of the Interior, and a copy of the whole of it was filed as an appendix to one of the briefs submitted in the case of *Bate Refrigerating Company against Hammond* in the Supreme Court. According to that correspondence, Commissioner Marble, then in office, writes to the Secretary of the Interior, under date of March 17, 1882, as follows:

"As will be seen by Col. Mason's communication, "the construction now put upon the statute is the con- "struction which it has received since it was enacted, "except during a short interval of the term of my "predecessor, Mr. Commissioner Paine. I may state, "however, that Mr. Commissioner Paine addressed to "me a letter within one month after he had retired "from office, stating that he believed his construction "of Section 4887 was erroneous."

It will, therefore, be seen that contemporaneous construction of the Act of 1870 by the executive department was just the contrary to what complainant's counsel

has supposed. Such construction, therefore, instead of making in favor of the complainant, makes strongly in favor of the defendants.

Reference is made to some conversational remarks made by the late Mr. Justice BRADLEY during the argument before him in the Bate case (31 Fed. Rep., 809) above referred to, and which were taken down by the stenographer. These remarks merely indicate a passing doubt in the mind of Judge BRADLEY raised by the word "previously," which is found in the Revised Statutes, but not in the Act of 1870. It is scarcely necessary to say that it would do great injustice to that distinguished jurist to assume that such an expression should be taken as indicating the deliberate opinion he might form upon full argument and consideration of the matter, or as indicating any opinion he had in fact formed.

VII.

As to complainant's point, that the inventor's right to a patent is complete when his application is filed, and that the word "patented" has been used in judicial opinions, and by counsel in argument, to express the date of application.

We have shown elsewhere the incorrectness of complainant's assumption that the inventor's right to a patent rests upon the application, and is complete, so far as concerns any act of the inventor, when the application is filed, and our discussion of this point need not be repeated here.

The suggested analogy between the proceedings in the Patent Office relating to the granting of patents and suits in the Courts, has no sound or proper basis in the nature of the two things compared, and should not be regarded as affording any rule for interpreting the

statute now under consideration as meaning one thing when it plainly says another.

The instances of the use of the word "patented," upon which complainant relies in support of its contention, will be found on examination not to sustain the position, that the term "patented" in the statute under consideration was used to express the date of filing the application, in support of which they are cited.

Complainants cite only two instances in which alleged ambiguities of this character are to be found in the *statutes* relating to patents. Neither one of them supports complainant's contention.

It is contended that in Section 4926, relating to extensions, the phrase "when the original patent was granted" obviously and necessarily refers, not to the date of the grant, but either to the date of the application, or to the date of the invention.

In the first place, if the date here referred to is not the date of the grant, it cannot possibly be taken to be the date of the *application*, but must be the date of the *invention*, since the date of the application has nothing whatever to do with the matter. Whatever ambiguity there may be, therefore, in this expression, it is not a confusion of the date of the grant with the date of the *application*.

But there is no ambiguity in the phrase. It means just what it says. It provides that the Examiner is to report, for the information of the Commissioner, among other things, "whether the invention or discovery was "new and patentable when the original patent was "granted." Manifestly, there are two things in regard to which the Examiner is required to report: the *novelty* of the invention, and whether it was *in other respects* patentable. The concluding phrase, "when "the original patent was granted," qualifies the immediate antecedent, "patentable," and does not necessarily or naturally qualify the term "new," which is further

back in the sentence. When correctly construed, the direction manifestly is that the Examiner shall report whether the invention or discovery was new with the patentee—that is to say, whether he was the first inventor, and *also* whether it was *patentable in other respects at the date of the original grant.* The period of time to be covered in the latter case was brought down to the date of the grant, and advisedly so, because *patentability* might be negatived by certain facts intervening between the date of the invention and date of the grant, or even between the date of the application and the date of the grant. The patentee of the original patent might, for instance, even if he was the first and original inventor, have abandoned his invention prior to the original grant even after his application was filed, by acts amounting to a dedication to the public, which had not been called to the attention of the Patent Office when the original patent was granted. Or he might have taken out a prior foreign patent for the same invention, and, to remove all question, we will assume that this foreign patent had been granted prior to the filing of the application here. After the expiration of the term of the prior foreign patent, his invention would not be patentable in this country, and the term of the foreign patent might have expired after the filing of the application here and prior to the grant. In the case of *Huber vs. Nelson* (148 U. S., 270) this Court held that the lapsing of a prior English patent for the same invention was a bar to the subsequent granting of any patent for the invention in this country. It is true that the English patent in this case had lapsed prior to the filing of the application here, but that is manifestly an immaterial consideration for the present purpose; and, even if it were material, it is obvious that upon the reasoning of this Court, the expiration of the full term of the prior English patent in any event would be a complete bar to patenting in this country.

It is, therefore, submitted that this statute, so far

from supporting complainant's view, strongly supports our view that the words of the statute now under consideration mean just what they say.

The second reference to another section of the statute is not a fortunate one. It is contended that there is a similar ambiguity in Section 4892 relating to the oath required of the applicant. As the language of the statute was quoted in complainant's brief below, such an ambiguity would seem to exist, but, upon reference to the statute itself, it will be seen that the ambiguity is created wholly by omitting a part of the context, and replacing such context with stars. On supplying the context omitted (which is indicated below in italics) the section reads as follows:

> "The applicant shall make oath *that he does*
> " *verily believe himself to be the original and first*
> " *inventor or discoverer of the art, machine, manu-*
> " *facture, composition or improvement for which he*
> " *solicits a patent;* that he does not know and does
> " not believe that the same was ever before known
> " or used."

It will be seen at a glance that the word "before" obviously and naturally refers to this immediate antecedent: that the applicant believes himself to be the original and first inventor, and plainly means that the applicant is required to make oath that he does not know and does not believe that his invention was ever known or used before the time at which he was the inventor of it.

The relevancy of the quotation from *Kendall vs. Winsor* (21 How., 322), is not perceived. Judge CURTIS, in the bill of exceptions, states as follows:

> "That if the jury should find that the plaintiff's
> " declaration and conduct were such as to justify
> " the defendants in believing he did not intend to

> "*take letters patent*, but to rely on the difficulty "of imitating his machine and the means he took "to keep it secret, this would be a defense to the "action."

The phrase "take letters patent" in this quotation, manifestly does not apply to the date of the application, nor is it equivalent to the phrase "to apply for "letters patent." It simply means that if the plaintiff represented that he did not intend to patent his invention at all, and to rely upon secrecy, that circumstance might constitute a defense.

The other instances of the use of the word "patented," "taking out a patent," etc., collected upon complainant's briefs, are taken from the cases of *Peacock vs. Dialogue* (2 Pet., 1) and *Shaw vs. Cooper* (7 Pet., 292), the first decided in 1829 and the second in 1833. Both cases, therefore, were decided before the Act of 1836, when application and issue were practically co temporaneous.

As the law stood, by virtue of the statutes in force at the time of these decisions and prior thereto, the petitioner for a patent filed his application, paid his full fee, and was entitled to his patent forthwith and as a matter of course, and the date of the patent also might be that of filing the application. There was no examination and no act to be performed by the inventor after his application was filed, except the giving a full description on receiving the letters patent, and the whole transaction of petitioning for, and receiving, the patent might practically be regarded as one act. In referring, therefore, to the date of application and the date of obtaining the patent, under this condition of the law, it was entirely natural that the distinction between applying for a patent and patenting should not be observed. It was a distinction not important to be observed, especially in the cases in which it was used in the opinions cited, as a reference to the context will show.

The Act of 1836 first introduced the examination system. Under that law and the subsequent statutes, the fee paid upon filing the application is not the fee for granting a patent, but entitles the applicant to an *examination*. The Patent Office will not receive, and has no authority to receive, a full fee upon the filing of the application. It does not follow that the applicant, after the examination, will take out a patent at all, and the interval between the application and the grant of a patent is necessarily longer where an examination must be had than where the one immediately follows the other.

Consequently, since the Act of 1836, the distinction between *applying* and *patenting* becomes important, and is constantly referred to in numerous decisions of the Courts and in the statutes. Having regard to the subject matter of the section of the Act of 1870 now in controversy, and the change of phraseology of that section as compared with prior legislation upon that subject, it is impossible to draw any inference from the ancient instances of the use of the word "patented" cited by complainant's counsel in support of the contention that it did not in fact, in the act in question, express the well-defined distinction which *at that time* existed between the application and the grant.

It is difficult to see what support is to be derived for appellant's contention from the language used by Judge NIXON in *Bate vs. Gillett*. There can be no doubt whatever from the paragraph as a whole as to just what Judge NIXON meant, nor will it be claimed that he in fact for a moment regarded the date of the grant as substantially the same thing as the date of the application, since he was drawing a sharp distinction between the two in this part of his opinion. The particular expression which is criticised is so obviously incomplete, and, on complainant's construction of it, so repugnant, to the other parts of the same sentence as to suggest at once that there must have been a clerical

error in it. At the most, it is merely a loose and inaccurate expression in a part of the opinion not forming any part of the *decision*, and the meaning of which is clearly explained by the context.

Nor does the Patent Office Rule of 1869, cited by complainant, serve as an instance of the use of the term patenting or an equivalent expression in the sense of filing the application. The crucial date under the legislation then in force was not, as complainant assumes, the date of the application, but a date six months prior to that date, or to the date of the filing of the specifications and drawings. If the rule, as appellant assumes, but which is obviously not the case, was intended for a precise statement of the law as it then existed on this subject, the expressions used must be taken as meaning a date six months prior to the application or drawings, and not the date of the application.

At the most, this rule is merely an example of general loose use of language, of which instances are not rare in the Rules of the Patent Office, and not of the special confusion of terms now under discussion.

Nor would it be material, if it were a fact, that the Courts and counsel had used these terms loosely as interchangeable, where the distinction between them was not the point under discussion or material to the question involved; such use would not tend to show that Congress, in an Act passing the scrutiny of so many eminent jurists in both Houses, and intended to put the law in unambiguous terms, had also used the terms loosely and adopted the term which did not express its intention instead of the term customarily used in the prior legislation which did clearly and accurately express its intention.

Lastly.

It is respectfully submitted that this Court should answer the question of the Court below that the invention for which the United States Patent sued on was issued had been previously patented in a foreign country within the meaning of those words in Section 4887 of the Revised Statutes, and that said patent expired under the terms of said section before the expiration of seventeen years from its date.

WHEELER H. PECKHAM,
EDMUND WETMORE,
LEONARD E. CURTIS.

APPENDIX.

Comments on Appellant's Citations.

An examination of the cases cited by the appellant shows that they depended upon special circumstances, and that the meaning of the statutes was not clear without resort to prior legislation, or that there were ambiguities in the statutes themselves, or that any other decision would lead to an absurdity.

In *U. S. vs. U. P. R. R. Co.* 91 (U. S., 72) the Court said: "In construing an Act of Congress we are not at "liberty to recur to the views of individual members "in debate, nor to consider the motives which influ- "enced them to vote for or against its "passage. The act speaks the will of Congress, "and this is to be ascertained from the "language used. But Courts, in construing a statute, "may with propriety recur to the history of the times "when it was passed, and this is frequently necessary, "in order to ascertain the reason as well as the mean- "ing of particular provisions in it (*Aldridge vs. Williams*, 3 How., 24; *Preston vs. Browder*, 1 Wheat., "120)." In this case it was sought to give the word "maturity" a double meaning. Certain grants were on condition that certain bonds of the railroad company be paid at maturity. The Government contended that "maturity" applied to the payment of interest as it fell due. The Court (pp. 85 and 86) said: "But this "is extending contrary to all legal rules the operation "of words by a forced construction beyond their real "and ordinary meaning. Courts cannot supply omis-

" sions in legislation nor afford relief because they are " supposed to exist."

In *Andrews vs. Hovey* (123 U. S., 267), the Court refused to interpolate in Section 7 of the Act of March 3, 1839 (5 Stat., 354), the words " with the consent or allowance of the inventor," after the words " such purchase, sale or use prior to application," although such words were in somewhat similar provisions of the Act of 1836. It is to be observed that the Act of 1839 does not repeal the Act of 1836, but purports to be " An Act in Addition to ' An Act to Promote the Progress of Useful Arts,' " while the Act of 1870 repealed the Acts of 1836 and 1839.

In *Blake vs. National Banks* (23 Wall., 307), a statute imposing a tax on individuals did not, during the whole of the same period, cover a tax on dividends of corporations, but left a hiatus between August, 1870, and January 1, 1871. It did, however, use, with reference to the dividend tax, the expression " hereafter declared," thus making the statute ambiguous on its face. The Court, therefore, examined the journals and records of Congress to ascertain the intent.

Nash vs. Towne (5 Wall, 689, 699) and *Mobile R. R. Co. vs. Jurey* (111 U. S., 584) are not in point, as they merely reaffirm the old rule that in construing contracts the Court can look at the surrounding circumstances and the purpose, in order to ascertain the intention of the parties.

In *Gandy vs. Main Belting Co.* (143 U. S., 587) the question arose under Section 4886, R. S., whether two years' public use in a foreign country prior to application here would defeat a patent. This case is not against the defendants' contention, as other sections of the Revised Statutes show that " public use " and " on sale " in Section 4886, meant " public use " or " on sale " in this country. Section 4887 provides that no

person be debarred from receiving a patent by reason of the invention being first patented abroad, unless the same has been introduced into public use in the United States for more than two years prior to application. Section 4923 provides for patenting here if the applicant believes himself to be the original inventor, and also provides that the patent shall not be void on account of the invention or discovery thereof having been known or used in a foreign country before his invention or discovery, if it had not been patented or described in a printed publication. Here there are three sections in the revising act itself, which were to be construed together, and which showed clearly enough that Section 4886 referred only to "public use" and "on sale" in this country.

Shaw vs. Cooper (7 Pet., 292) merely held that a defective patent may be surrendered and a new one taken out, having relation to the first, the Court saying that "the application may be considered as appended to "the application for the original patent."

Adams vs. Jones (1 Fish., 527) and *Planing Machine Co vs. Keith* (101 U. S., 479) were merely to the effect that involuntary delays after application did not constitute an abandonment.

Root vs. Ball (4 McLean, 179) held bad a plea that the invention was in use or for sale before application. It should have alleged an abandonment, or use or sale for over two years prior to application.

Canda vs. Pound Mfg. Co. (23 Fed. Rep., 185) held that the patent was not void because not limited on its face to expire with a foreign patent. Judge WALLACE read in connection with Section 4887, R. S., Sections 4883, 4884 and 4885, and said that resort may be had for interpretation to the pre-existing statutes. He also said: "When the meaning of the Revised Statutes "is plain, the Court cannot recur to the original stat-

" utes to see if errors were committed in revising them " but it may do so when necessary to construe doubtful " language used in the revision (*U. S. vs. Bowen*, 100 " U. S., 508)." He thought that the language in the Act of 1870 to the effect, " the patent shall expire at the " same time with the foreign patent," was not materially changed by the phrase " shall be so limited as to " expire at the same time, etc.," contained in Section 4887 of the Revised Statutes, especially when read in connection with other sections of the Revised Statutes. In this case there was a plain ambiguity on the face of the Revised Statutes. A similar phrase had been employed in Section 6 of the Act of 1839, where it was declared that " every such patent shall be lim- " ited to the term of fourteen years from the date or " publication of such foreign letters patent." The Supreme Court had held in *O'Reilly vs. Morse* (15 How., 62) that the American patent was not void, because on its face it ran fourteen years from the date of its issue, instead of that length of time from the date of the prior French patent. Judge WALLACE was, therefore, practically following a decision of the Supreme Court on the effect of similar language. *Bate vs. Hammond*, 123 U. S., 151, decided the point the same as Judge WALLACE in the *Canan* case, and approved of his decision.

The case of *U. S. vs. Bowen* (100 U. S., 508) has already been commented upon. It merely states the rule that where there is a substantial doubt as to the language used in a revision, the old law may be resorted to for information; but that the Revised Statutes must be treated as the legislative declaration of the law, and where the meaning is plain, Courts cannot look to the the prior statutes. This is precisely the rule that we contend for.

This case is cited with approval in *Arthur vs. Dodge* (101 U. S., 34, 36), *Myer vs. Car Company* (102 U. S., 1, 11), *Victor vs. Arthur* (104 U. S., 498,

499, 500), *Deffebach vs. Hawke* (115 U. S., 392, 402), *Viterbo vs. Friedlander* (120 U. S., 707, 726); *U. S. vs. Sixty-five Terra Cotta Vases* (18 Fed. Rep., 508, 600), *Pentlarge vs. Kirby* (20 Fed. Rep., 898, 900), and *Gwathmay vs. Clisby* (31 Fed. Rep., 220, 221).

In the case of *Myer vs. Car Company (supra)*, it is to be noted that the Iowa Code of 1873, which was being construed, *incorporated verbatim the language of a prior act* gave certain rights to "any creditor," but its title showed that only certain purchasers and execution and attaching creditors were entitled to its provisions. A statute of Iowa, in order to be valid, must state in its title the objects of the act; hence, the expression, "any creditor," used in the act was necessarily controlled by the title. Although, ordinarily, titles are not of much importance in construing acts, the phrase "any creditor" was impressed by the legislature with a certain meaning when the body of the act was incorporated *verbatim* in the Code. Mr. Mitchell speaks of the earlier statute as containing a clause which limited its scope to attaching or execution creditors, and says that that clause was omitted in the Code. The fact is, however, that the statute was incorporated *verbatim*, and only the title omitted—that is, there was no change of language.

In *U. S. vs. Sixty-five Terra Cotta Vases (supra)*, Judge WALLACE refused to look into the prior statutes, holding that there was no ambiguity in the law, and said, "The Revised Statutes must be considered as the legislative declaration of the statute law on the subjects which they embrace on the 1st day of December, 1873, and it is only when the language employed in the revision is doubtful that resort can be had to the pre-existing laws to ascertain its meaning (*U. S. vs. Bowen*, 100 U. S., 508; *Victor vs. Arthur*, 104 U. S., 498). It cannot be had to see if Congress erred in the revision (Arthur vs. Dodge, 101 U. S., 34, 36)."

In Pentlarge vs. Kirby *(supra)* Judge WALLACE examined prior statutes to ascertain whether the provisions of the Revised Statutes would make any change in them upon the subject of costs, and decided that they had not, but the contrary construction was not fairly to be deduced from the Revised Statutes. He ssys, reviewing Sections 822 and 983 together: "They "are not fairly susceptible of the construction which "changes the pre-existing law. The intention to make a "radical change is not to be employed in a revision, and "if there is any fair room for doubt the original acts "may be resorted to in aid of interpretation. *U. S. vs.* "*Bowen* (100 U. S., 513)."

In *Grathmay vs. Clisby (supra)*, there was an ambiguity on the face of Section 2094 of the Alabama Code of 1876, which said: "Bills of exchange and promissory "notes, payable in money at a bank or private banking "house, or at a certain place of payment therein desig- "nated are governed by the commercial law." The question was whether bills of exchange are also "governed by the commercial law" within the meaning of this section, when they are not by their terms payable at a certain place designated. In view of this ambiguity and of the rule that the common law is not changed by a statute unless clearly changed, Judge WALLACE sought the assistance of other provisions of the laws of Alabama *in pari materia* and of antecedent legislation upon the subject. He also followed the rule that Courts disregard punctuation, it being no part of the statute. The plaintiff also invoked the rule of construction that a relative word ordinarily relates to its next antecedent. The decision therefore might well have been the same without any examination of prior legislation.

In *Siemens vs. Sellers* (123 U. S., 276), there was an ambiguity on the face of the statute in regard to the meaning of the term "the date of issue." One con-

struction of this term would, as it was shown, lead to an anomaly in the law and an evident absurdity, and the Supreme Court therefore adopted the other meaning of the term. Prior to the Act of 1861 some patents ran from the date of issue of the American patent, and other patents from the date of issue of a prior foreign patent. The Supreme Court held that the term "the date of issue" was as applicable to the date of issue of the foreign patent as to the date of issue of the American patent, and the Act of 1861, which had merely extended the terms of all patents, was not a repealing act and did not make any change in the date from which each patent was to run. This was still left to be determined by the prior legislation on the subject.

Butterworth vs. Hoe (112 U. S., 50) merely held that the Secretary of the Interior has no power by law to revise the action of the Commissioner of Patents in awarding to an applicant priority of invention and adjudging him entitled to a patent. The Court, in coming to this decision, examined existing legislation, and said (p. 64): "The conclusion is confirmed by a review of "the history of legislation on the point."

In *ex parte Crow Dog* (109 U. S., 556) the Court thought that both the old law and the new could stand, as, (unlike the Act of 1870) the new did not expressly repeal the old.

Taylor vs. Delancy (2 Cai. Cas. in Error, 143) merely decided that the Surrogate has power to elect out of the next of kin of an intestate, any one of those in an equal degree, and to grant to such person sole administration. There were two laws on the subject. The Act of February 14, 1787, directed "that, where "any person dieth intestate, the widow, or next of kin, "*or any of them*, of the deceased person, if they, or "either of them, will accept the same, &c., shall be

"deputed." The Act of March 27th, 1801, provided "that administration * * * of any person dying "intestate, shall be granted to the widow, or next of "kin, of the intestate, or some of them, if they, or any "of them, will accept the same." The Court says that, so far from finding any expression in the Act of 1787 negativing the discretion the Surrogate formerly had, it appeared to it "that the words 'or any of them,' in "the Act of 1787, if they were now to receive a con- "struction for the first time, confer a discretion on the "Surrogate." The Court also makes the same observation with reference to the use of the words "or any of them" in the Act of 1801, and says that the contrary construction would lead to an absurdity (pp. 150, 151).

In *U. S. vs. Lacher* (134 U. S., 624), the Court, in construing Section 5467 of the Revised Statutes, said: "But we do not think the supplying of any word is necessary. If the comma after the word 'directed,' in the third line from the close of the section, as it appears in the Revised Statutes, be treated as a semicolon, the result is the same [as supplying 'and' or 'or'], and obviates any uncertainty in the matter. For the purpose of arriving at the true meaning of a statute, courts read with such stops as are manifestly required."

In *Holtse vs. Robertson*, L. R., 4 Ch. Div., 9, the facts were that the plaintiff applied for his patent on the 17th of September, 1867, and at the same time filed his provisional specification and obtained provisional protection. Letters patent were sealed December 17, 1867, but dated September 17, 1867. On December 13, 1867, the plaintiff obtained a patent for the same invention in Austria, which expired in 1870. Statute 15 and 16 Vict., C. 83, Section 25, provides that where letters patent are granted in the United Kingdom for an invention first invented in a foreign

country, or by the subject of a foreign power, and a patent for such invention in any foreign country is there obtained before the grant of said letters patent in the United Kingdom, then the rights under the British letters patent shall cease upon the expiration or other determination of the term of the foreign patent. Section 24 of the same act is as follows: "Any letters patent issued under this act, sealed and bearing date as of any day prior to the day of actual sealing thereof, shall be of the same force and validity as if they had been sealed on the day as of which the same are expressed to be sealed and their date. Provided always, that save where said letters patent are granted for any invention in respect whereof a complete specification has been deposited upon the application for the same under this act, no proceedings at law or in equity shall be had upon said letters patent in respect of any infringement committed before the same were actually granted." Reading the two sections together, JESSEL, M. R., said: "I have no doubt that the word 'grant' in this section (25) refers to the date. This appears from Section 24, which shows that for the purposes of the act the patent is to be read as if sealed on the date which it bears, and is to be taken then granted." On appeal, JAMES, L. J., said: "The grant of the patent takes effect from the day on which it is dated." And after stating the effect of Section 24, says: "Therefore they must be held to have been granted on that day for all the purposes of the act."

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Supreme Court of the United States.

No. 687.

BATE REFRIGERATING CO., COMPLAINANT,

vs.

FERDINAND SULZBERGER ET AL., DEFENDANTS.

Answer to Appellant's Last Brief, Called "Memorandum," etc.

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IN THE

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Answer to Appellant's Last Brief, Called "Memorandum," etc.

We do not care to discuss the points of this brief in detail, as we have already dealt with most of them sufficiently in our main brief, but will confine our attention to a few errors which seem to need correction.

1. At the foot of page 2 the memorandum says that "it is settled by more than thirty precedents that the courts and Congress have used exactly those words to signify date of application and date of issue," and reference is made to complainant's general brief (p. 139) for the said "thirty precedents."

On pages 113–118 of our main brief we have shown how completely without value are most of these so-called precedents. The others since cited are of the same character;

they merely show that judges, when not considering the precise point now in controversy, but speaking upon other points raised in the cases in which the opinions are delivered, sometimes use language which, if applied to other cases, is loose and inaccurate. This, however, is the first time that we have heard of such loose and inaccurate expressions being cited as evidence that accurate and precise expressions must lose their meaning when properly applied. In drafting the Statute of 1870, the precise question had to be met, viz., what rule shall be prescribed for the effect of a foreign patent? The inconsistencies and incongruities of the old law prescribed, as we have shown, several different rules. Plainly it was the duty of the revisers to eliminate these inconsistencies and incongruities; and they did it by leaving out the words which, in the old statutes, in terms referred to the application, and by inserting apt words which refer to the issue of the patent. Surely there is no relation between the use of language by Judge Bradley, accurate enough for the case before him, but wholly inaccurate when applied to this case, and the use by trained and skillful men of words to express the very point in question.

As shown at pp. 113–115 of our brief, the two instances in which complainant claims to find similar ambiguities in acts of Congress are not borne out by an examination of the statutes.

2. In the statement on page 3, under the second point, the complainant fails to comprehend our position. It is not that the act was not the work of the revisers, but it is that it is wholly unimportant whether it was the work of the revisers or of the committee to whom the revision was referred. It is, that, as a matter of fact, the House bill, in that very portion of it which was the work of the revisers themselves, was *an amendment*, and not a *mere* revision of the law. It is that the law there-

tofore existing consisted of several incongruous and somewhat inconsistent provisions, and that the Act of the revisers was an amendment, inasmuch as it made one simple and precise provision which covered all cases and repealed the several different provisions theretofore made for the different cases.

Our position is that it makes no difference whether that is *called* a revision or *called* an amendment; it *is* an amendment—quite as much an amendment as another section of the statute which increases a salary from $1,000 to $2,500. As a consequence of the fact that the "revision" reported by the revisers really is an amendment and not a revision, the rule for its construction is, as substantially stated by Mr. Carter on page 47 of his brief, that a change of language implies a corresponding change in the law.

Our claim is, also, that this conclusion is rendered more emphatic, and really a necessary conclusion, by the fact that the operative words in the old statute, namely, "prior to the application," have been omitted in the new, and words put in which we claim plainly establish and constitute another date, to wit, the issue of the home patent, as the time prior to which the existence of a foreign patent will limit the home patent.

The appellant admits that *one* change, *viz.*, the omission of the six-months limitation of the act of 1839, was in fact made by the so-called "revision." What we claim is that the *full* change necessarily implied by the change in the phraseology was also in fact made.

3. On page 4, the memorandum, under point 3, speaking of our brief, says, "On page 32 their brief says, 'it must be remembered that, from the inauguration of our patent system, a foreign patent was a bar to a home patent, unless and by virtue of some exception to that rule affirmatively stated by the

acts of 1836 and 1839,'" and the memorandum then goes on to say that that is exactly the position of the complainant.

Our brief is perhaps in that respect, and also in respect to the statement that, under the law of 1836, a disclosure by a printed publication or foreign patent during the pendency of the American application might constitute a bar, a not quite accurate statement of the law. Prior to the act of 1836, no doubt, the existenceof a foreign patent prior to the application for a home patent was a bar to the issue of a home patent. Under the act of 1790, it was at least open to be claimed that the time referred to when the existence of a foreign publication or patent would bar the issue of a home patent was the time of the invention by the applicant. Under the act of 1793 no such doubt could arise, for it was provided that the new or useful art invented should not have been known *before the application*.

In the act of 1836 Congress changed the law and adopted what was probably the intent of the act of 1790, and provided that a patent should issue, unless the invention or discovery had been known by other persons, or described in a printed publication or patented prior to the *invention* by the applicant. There was, in sections 6 and 7 of the law of 1836, no other limit to the right of an inventor to the patent for his invention than that it should not have been known to other persons or patented or described in a printed publication prior to the *invention* thereof by the applicant. It is thus plain that no foreign patent to the applicant could have been a bar to his right to a patent in this country, so far as sections 6 and 7 are concerned, because he could not have described or patented his invention, either here or in any other country, prior to his invention thereof.

We, therefore, differ with the complainant in this assumption that, from the inauguration of our patent system, a foreign patent was a bar to a home patent, unless and by virtue

of some exception to the rule affirmatively stated in the acts of 1836 and 1839.

There was a bar stated in the act of 1836, but it was a bar enacted by that statute, and is found in section 8; it is awkwardly expressed, but it is impossible otherwise to construe this section than as we claim. The section says:

"But nothing in this act contained shall be construed to deprive an original and true inventor of the right to a patent for his invention, by reason of his having previously taken out letters patent therefor in a foreign country, and the same having been published, at any time within six months next preceding the filing of his specification and drawings."

That section gives a particular exception or instance wherein the previous issuing of letters patent on his invention in a foreign country will not deprive the inventor of a patent in this country, and inferentially enacts that in every other case it will deprive the inventor of his right to a patent in this country. Unless we give section 8 that meaning, it is without any meaning whatever, for, as we have seen, the other sections of the statute did not prevent the inventor from taking out his patent in a foreign country, and he consequently, but for this section, would have a right to take out such letters patent without affecting his right to a patent here. That right would cover all cases—as well the six months next preceding the filing of his specification and drawings as any other time.

The effect, therefore, of section 8 is to provide that the original and true inventor cannot take out a patent for his invention in a foreign country without the same being a bar to his right to take out a patent in this country, unless such letters in a foreign country shall have been taken out within six months next preceding the filing of his specification and drawings.

The act of 1836 thus repealed the old acts of 1790 and 1793 and the intermediate amendatory acts, and put in place of those acts sections 6 and 7, under which the taking out of a foreign patent had no effect upon the right of the inventor to a patent in this country, and thereupon enacted section 8, which forbade his taking a prior patent in a foreign country for the same invention under penalty of its being a bar to a patent in this country, unless such foreign patent should have been taken out within the six months next preceding the filing of his specification and drawings.

When the law of 1839 was enacted the exception to the general bar thus provided by section 8 of the law of 1836 was extended to all cases where the patent has been taken out more than six months prior to the application; and the bar referred to in the opening words of section 6 of the law of 1839, viz., "That no person shall be debarred from receiving a patent," etc., referred to the bar created and enacted by section 8 of the law of 1836, with the exception therein expressed, if the foreign patent had been taken out within the six months next preceding the filing of the specification and drawings.

When the law of 1870 was enacted section 24 thereof performed the same function that in the act of 1836 was performed by section 7, and our view of the effect of that act and of the survival in section 25 of it, of the old phraseology, is set forth in our brief on page 81 *et seq.*, to which we respectfully refer.

In support of our claim that section 7 of the law of 1836 must be construed as providing that the patent should issue if it should not appear to the Commissioner that the invention had been invented or discovered by any other person in this country, or that it had not been patented or described in any printed publication in this or any foreign country, prior to the invention or discovery thereof by

the applicant, we would refer to the case of *Bartholomew vs. Sawyer* (4 Blatchford, 347), in which it is held that the time referred to by the words that it had not been patented or described in any printed publication in this or any foreign country, in section 7 of the act of 1836, is the time of the *invention or discovery* thereof by the applicant and not any later time. That this is the true construction of those words in section 7, is also stated in the general brief of the complainant's counsel, beginning at the bottom of page 107 and covering half of page 108, wherein they say (on page 108), "But the courts have always referred this first qualification" (that it had not been patented or described in any printed publication in this or any foreign country) "to the *invention* date."

On page 5 of the memorandum, counsel, after criticising our position, state that under the law of 1836 the *application date* is the critical date for the purpose of determining whether a foreign patent or printed publication constitutes a bar to a home patent, and various cases cited in their main brief are referred to in support of this claim.

No error can be more plain. We have already shown that the only time or date referred to on this point in the act of 1836, so far as sections 6 and 7 are concerned, was the time of the invention, and in no case the time of the application. Section 8, by inference, made the existence of a prior foreign patent to the same inventor a bar in all cases, unless the foreign patent had been issued within six months prior to the filing of the specification and drawings. Such specification and drawings might, or might not, have been filed at the time of the application.

The cases cited in the main brief of the complainant do not support this claim in the memorandum. It is sufficient to refer to two such cases, the rest being manifestly irrelevant.

In the case of *O'Reilly vs. Morse*, the opinion quoted from, is the dissenting opinion of Mr. Justice Grier, and even this, at the most, merely holds that the act of 1836, *as a whole*, gave an inventor who had obtained a patent abroad a right to have a patent here, provided he made his application here within six months after the date of his foreign patent. It does not specify which section of the act gave this right, and it is our view, as before expressed, that the act, *as a whole*, did confer this right.

In the case of *Siemens vs. Sellers*, Mr. Justice Bradley, in incidentally summarizing the provisions of the act of 1836 with reference to a point wholly distinct from that now in controversy, did state inferentially that section 7 provided that, if an invention for which a patent was sought had been patented in a foreign country before the application for a patent here, it was a bar to obtaining a patent in this country. It is clear from the context that this statement was intended to apply to all foreign patents, whether to the same inventor or not, and this was manifestly a wholly inaccurate statement of the provisions of section 7 of the act of 1836, so far as the point now in controversy is concerned, although it was sufficiently accurate for the purposes of the point the court then decided. It was, in any event, not a *decision* on this point, because this point was not in controversy in that case.

Nor is there any warrant in any of the cases cited by complainant that it was thought or supposed at the time when the act of 1836 was passed that a prior foreign patent to the same inventor did, or might, constitute a bar under the general provisions of sections 6 and 7 of that act or that taking out a prior foreign patent would constitute an abandonment of the invention in this country. It is to be observed that in these general provisions prior patents and prior publications are, in all respects, put upon exactly the

same basis. Both must precede the *invention* in order to affect the right to a patent here.

4. The fourth point of the memorandum is based entirely upon an error in our brief, which is obviously, from the context, only a printer's error, and one upon which no part of our argument was founded. The words in the House bill referred to under this point of the memorandum should not have been italicized, as printed in our brief, but should have been printed in Roman type.

We do not consider it material to discuss the points of this memorandum further, as they have been sufficiently discussed in our brief, to which we refer.

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